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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92025859
Party	Plaintiff Empresa Cubana Del Tabaco d.b.a Cubatabaco
Correspondence Address	MICHAEL R. KRINSKY RABINOWITZ BOUDIN STANDARD KRINSKY & LIEBERMAN PC 14 WALL ST, STE 3002 NEW YORK, NY 10005 UNITED STATES Primary Email: mkrinsky@rbskl.com Secondary Email(s): dgoldstein@rbskl.com, lfrank@rbskl.com 212-254-1111
Submission	Testimony For Plaintiff
Filer's Name	Lindsey Frank
Filer's email	lfrank@rbskl.com, mkrinsky@rbskl.com, dgoldstein@rbskl.com
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1 APPEARANCES OF COUNSEL:

2  
3 FOR THE PETITIONER:

4 RABINOWITZ, BOUDIN, STANDARD, KRINSKY & LIEBERMAN  
5 BY: LINDSEY FRANK, ESQ.  
14 Wall Street  
6 30th Floor  
New York, New York 10005  
7 (212) 254-1111  
mkrinsky@rbskl.com

8  
9  
10 FOR THE RESPONDENTS:

11 DLA PIPER, LLP  
12 BY: JOAQUIN GALLASTEGUI, ESQ.  
2000 Avenue of the Stars  
13 Suite 400  
Los Angeles, California 90067  
14 212.335.4500  
joaquin.gallastegui@dlapiper.com

15  
16  
17 Marc Friedman, Videographer  
18 Eduardo Welter, Spanish Interpreter  
19  
20  
21  
22  
23  
24  
25

## I N D E X

## EXAMINATIONS

CROSS-EXAMINATION	PAGE
By Respondent	11
REDIRECT EXAMINATION	
By Petitioner	76
RE CROSS-EXAMINATION	
By Respondent	97

## E X H I B I T S

## RESPONDENT'S

EXHIBIT	DESCRIPTION	PAGE
Respondent's 1	Ms. Garcia's declaration	16
Respondent's 2	U.S. Trademark Registration Number 1,147,309	28
Respondent's 3	U.S. Trademark Registration Number 1,898,273	35
Respondent's 4	U.S. Trademark Registration Number 2,145,804	43
Respondent's 5	U.S. Trademark Registration Number 4,988,587	44
Respondent's 6	U.S. Trademark Registration Number 1,557,163	45



## E X H I B I T S

RESPONDENT'S EXHIBIT	DESCRIPTION	PAGE
Respondent's 7	U.S. Trademark Registration Number 3,402,158	46
Respondent's 8	U.S. Trademark Registration Number 4,244,461	47
Respondent's 9	U.S. Trademark Registration Number 1,970,911	48
Respondent's 10	U.S. Trademark Registration Number 2,212,119	49
Respondent's 11	U.S. Trademark Registration Number 2,128,050	50
Respondent's 12	U.S. Trademark Registration Number 1,653,845	52
Respondent's 13	Media Note dated June 4, 2019	57
Respondent's 14	Second Circuit's February 24, 2005 opinion	61
Respondent's 20	Cubatabaco's Amended Petition in the instant cancellation proceeding	98
PETITIONER'S EXHIBIT	DESCRIPTION	PAGE
Petitioner's 1	Notice of Opposition of Kris I. Khachaturian	88
Petitioner's 2	Notice of Opposition of Reel Smokers Cigar Distributors	91
Petitioner's 3	Notice of opposition of Anthony P. Serino	92
Petitioner's 4	Notice of Opposition of Kretek International, Inc.	94

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3  
4  
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6  
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10  
11  
12  
13  
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E X H I B I T S

PETITIONER'S		
EXHIBIT	DESCRIPTION	PAGE
Petitioner's 5	Complaint against Santa Clara Cigar Manufacturer	96

1 MEXICO CITY, MEXICO, FRIDAY, OCTOBER 25, 2019

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THE VIDEOGRAPHER: Good morning. We are going on the record at 9:02 a.m. on Friday, October 25th, 2019.

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Please note the microphones are sensitive and may pick up whispering, private conversations and cellular interference. Please turn off all cell phones or place them away from the microphones as they can interfere with deposition audio.

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Audio and video recording will continue to take place unless all parties agree to go off the record.

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This is Media Unit Number 1 of the audio recorded deposition of Lisset Fernandez Garcia in the matter of Empresa Cubana Del Tabaco, d.b.a. Cubatabaco, versus General Cigar Company, Incorporated and Culbro Corporation.

22

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24

25

This case is filed in United States Patent and Trademark Office, before the Trademark and Trial Appeal Board, Cancellation Number 920258859. This meeting or hearing is being held at

1 the office of DLA Piper, located in Mexico City,  
2 Mexico.

3 My name is Marc Friedman. I'm your  
4 certified legal video specialist. Your court  
5 reporter today is Ruben Garcia, and we're both from  
6 the firm of Veritext Legal Solutions. I'm not  
7 related to any parties in this action or financially  
8 interested in the outcome.

9 Counsel and all present will now  
10 state their appearances and affiliations for the  
11 record. If there are any objections to the  
12 proceedings, please state them at the time of your  
13 appearance, beginning with the noticing attorney.

14 MR. GALLASTEGUI: Joaquin Gallastegui from  
15 DLA Piper Mexico.

16 MR. FRANK: Lindsey Frank, from  
17 Rabinowitz, Boudin, Standard, Krinsky & Lieberman,  
18 P.C. for Petitioner Empresa Cubana Del Tabaco,  
19 d.b.a. Cubatabaco.

20 I'll just note for the record, in the  
21 reading of the caption, the cancellation number, I  
22 think there was an extra 8 stated.

23

24

25

1 Eduardo Welter,  
2 having been first duly sworn,  
3 was examined and testified as follows:  
4

5 LISSET FERNANDEZ GARCIA,  
6 having been first duly sworn by the reporter, was  
7 examined and testified as follows:

8 THE WITNESS: Yes, I do.

9 THE VIDEOGRAPHER: As agreed by the  
10 attorneys, this will be an audio only recording.

11 MR. FRANK: I'd just like to state for the  
12 record, as Petitioner previously informed  
13 Respondent, Petitioner reserves its right to object,  
14 after the deposition is complete, to the translation  
15 of the questions and/or responses made during this  
16 deposition.

17 I'll also note for the record that  
18 Respondent has forbidden the witness from being  
19 shown a printed copy of the written questions for  
20 her to refer to and review during the examination.

21 Should we go off record for a moment?

22 THE VIDEOGRAPHER: Stand by. The time is  
23 9:06. We are going off the record.

24 (Recess.)

25 THE VIDEOGRAPHER: The time is 9:08. We

1 are back on the record.

2 MR. FRANK: Will the interpreter please  
3 state his credentials for the record.

4 THE INTERPRETER: Yes, Counsel. I'm  
5 Eduardo Welter. I'm a court-certified Spanish  
6 interpreter by the State of California, and I'm also  
7 federally certified.

8 MR. FRANK: Approximately how many  
9 depositions have you provided interpretation  
10 services, between the English and Spanish languages?

11 THE INTERPRETER: We spoke briefly about  
12 it, and instead of hundreds, as I did mention  
13 yesterday, I would like to point out that I thought  
14 about it further, and in reality it's been thousands  
15 of depositions.

16 MR. FRANK: And have you ever provided  
17 interpretation services in a trial examination upon  
18 written questions?

19 THE INTERPRETER: No, I don't think so.

20 MR. FRANK: Have you ever provided  
21 interpretation services in a trial examination in a  
22 proceeding before the U.S. Trademark Trial and  
23 Appeal Board?

24 THE INTERPRETER: No, I don't think so.

25 MR. FRANK: And to your knowledge, have

1 you ever conducted interpretation services or  
2 provided interpretation services in any deposition  
3 concerning a trademark dispute?

4 THE INTERPRETER: I don't remember.

5 MR. FRANK: Thank you.

6 THE INTERPRETER: Thank you.

7 "Schedule A. Questions for  
8 cross-examination and recross-examination and  
9 redirect examination by written questions of Lisset  
10 Fernandez Garcia and objections thereto.

11 "General objections: Petitioner  
12 objects to all questions on the ground that  
13 Respondent does not advise the witness that the  
14 witness need not answer a question to the extent the  
15 witness does not understand it, and that the witness  
16 should not speculate.

17 "Even though Petitioner may make an  
18 objection to a question, the witness is permitted to  
19 answer it, unless counsel also specifically  
20 instructs the witness not to answer the question.

21 "Petitioner objects to Respondent's  
22 instructions not to refer back to the previous  
23 answers that the witness provided in response to a  
24 previous question unless specifically directed to do  
25 so.

1                   "Petitioner instructs witness not to  
2     answer regarding confidential communications,  
3     including reports made by any employee of Cubatabaco  
4     or Habanos of confidential communications, related  
5     to either legal services or an opinion on law or  
6     assistance in some legal proceeding, in which any  
7     legal counsel for Cubatabaco or Habanos, S.A.,  
8     whether in-house or outside counsel, (legal  
9     counsel), (A) was a party to the communication; or  
10    (B) was present during the communication. Otherwise  
11    witness may respond.

12                   "Questions. General Cigar Co. Inc.,  
13    General Cigar, submits the following questions" --

14                   MR. FRANK: Can you translate that first  
15    part, please?

16                   THE INTERPRETER: You want me to do that  
17    first?

18                   MR. GALLASTEGUI: Yes. Thank you,  
19    Eduardo.

20    (Interpreter reads instruction to witness in Spanish.)  
21

22                   CROSS-EXAMINATION

23                   THE INTERPRETER: "Questions. General  
24    Cigar Co. Inc., General Cigar, submits the following  
25    questions for the cross-examination by written



1 questions of Lisset Fernandez Garcia."

2 So I'll then continue reading?

3 MR. FRANK: I would say until the first  
4 question mark.

5 MR. GALLASTEGUI: Correct.

6 THE INTERPRETER: "For the purposes of  
7 these questions, Empresa Cubana del Tabaco will be  
8 referred to as 'Cubatabaco.' Habanos, S.A. will be  
9 referred to as 'Habanos.' And General Cigar Co.  
10 Inc. will be referred to as 'General Cigar.'

11 "Where necessary for clarity, the  
12 Cohiba cigar that is made in Cuba will be called the  
13 'Cuban Cohiba Cigar,' and the Cohiba cigar that is  
14 sold in the United States will be called the  
15 'General Cigar Cohiba Cigar.' Otherwise, when the  
16 'Cohiba Cigar' is used in a question, it means the  
17 Cohiba cigar made in Cuba.

18 "Do you understand?"

19 MR. FRANK: I think you have to start with  
20 "preguntas."

21 THE WITNESS: Yes.

22 THE INTERPRETER: "When answering  
23 questions today, please answer every question, even  
24 if you think you have answered a similar question  
25 previously. Please do not refer to an answer that

1 you provided in response to a previous question  
2 unless you are specifically directed to do so.

3 "Do you understand?"

4 THE WITNESS: Yes.

5 THE INTERPRETER: "Number 1. Please state  
6 your name for the record."

7 THE WITNESS: Lisset Fernandez Garcia.

8 THE INTERPRETER: "Number 2. Is there any  
9 reason you cannot testify truthfully today?"

10 THE WITNESS: No.

11 THE INTERPRETER: "Number 3. Are you  
12 currently taking any medication which would affect  
13 your ability to testify fully and truthfully today?"

14 THE WITNESS: No.

15 THE INTERPRETER: "4. Are you currently  
16 subject to any medical condition that would affect  
17 your ability to testify truthfully and fully today?"

18 THE WITNESS: No.

19 THE INTERPRETER: "5. Have you spoken to  
20 any person about your testimony today, other than  
21 your lawyer or lawyers for Cubatabaco?"

22 THE WITNESS: No.

23 THE INTERPRETER: "12-A. Have you been  
24 shown any of the redirect questions prepared by  
25 Cubatabaco's counsel that you will be asked in

1 today's examination?"

2 "Objection."

3 THE WITNESS: No.

4 THE INTERPRETER: "Have you been shown any  
5 of the cross-examination or recross-examination  
6 questions prepared by General Cigar's counsel that  
7 you will be asked in today's examination?"

8 "Objection."

9 THE WITNESS: No.

10 THE INTERPRETER: "13-A."

11 MR. FRANK: No.

12 MR. GALLASTEGUI: Go to 20.

13 THE INTERPRETER: "20-A. Has anyone told  
14 you any of the redirect questions prepared by  
15 Cubatabaco's counsel that you will be asked in  
16 today's examination?"

17 "Objection."

18 THE WITNESS: No.

19 THE INTERPRETER: "Number 20-B. Has  
20 anyone told you any of the cross-examination or  
21 recross-examination questions prepared by General  
22 Cigar's counsel that you will be asked in today's  
23 examination?"

24 "Objection."

25 THE WITNESS: No.

1 THE INTERPRETER: Exhibit 1 for the  
2 witness? Before 30 then, I'm guessing that that  
3 will be the case; is that correct?

4 MR. FRANK: Is that correct, Joaquin?  
5 We're going to 30 and introducing 1?

6 MR. GALLASTEGUI: Yes, we're starting at  
7 30. But before starting Question 30, let's mark  
8 Exhibit 1 for the witness, please.

9 THE REPORTER: They'll have the same exact  
10 stickers as Mr. Babot's had. There will be no  
11 differentiation.

12 MR. GALLASTEGUI: It says "Respondent's."

13 THE REPORTER: They will be the exact  
14 stickers as Mr. Babot's had.

15 MR. GALLASTEGUI: Is there an issue with  
16 that?

17 MR. FRANK: All of these questions have  
18 been drafted with Respondent's Exhibit 1 -- assuming  
19 it's Respondent's Exhibit 1. So I don't think we  
20 can go sequentially from yesterdays because the  
21 questions refer to "Respondent's Exhibit 1." So I  
22 think we have to use Respondent's Exhibit 1.

23 THE REPORTER: I could put "Respondent's"  
24 on a separate sticker, Exhibit 1, "Garcia," just so  
25 later on --

1 MR. FRANK: Yeah, I have no problem with  
2 that if you want to put "Garcia" on that.

3 THE REPORTER: I'll do that after.

4 MR. FRANK: Go ahead.

5 (Respondent's Exhibit 1 was marked for  
6 identification by the court reporter.)

7 THE INTERPRETER: "30. The exhibit that  
8 has just been marked Respondent's Exhibit 1 is  
9 titled 'Declaracion de Lisset Fernandez Garcia.'

10 "Do you see that?"

11 THE WITNESS: Yes.

12 THE INTERPRETER: "31. Do you recognize  
13 this document?"

14 THE WITNESS: Yes.

15 THE INTERPRETER: "32. What is this  
16 document?"

17 THE WITNESS: It's my declaration.

18 THE INTERPRETER: "33. For the purposes  
19 of this cross-examination, we will refer to this  
20 document as your declaration.

21 "Do you understand?"

22 THE WITNESS: Yes.

23 THE INTERPRETER: "34. We will represent  
24 that counsel to Cubatabaco has submitted  
25 Respondent's Exhibit 1 as trial evidence in the

1 proceedings pending before the Trademark Trial and  
2 Appeal Board of the USPTO between Cubatabaco and  
3 General Cigar.

4 "Do you understand?"

5 THE WITNESS: Yes.

6 THE INTERPRETER: "35. Please turn to  
7 page 20 of your declaration. Is that your signature  
8 on the page?"

9 THE WITNESS: Yes.

10 THE INTERPRETER: "36. Did you write all  
11 of your declaration?"

12 "Objection."

13 THE WITNESS: Well, the draft was written  
14 by the attorneys based on my declaration and the  
15 conversations we had, in other words, based on the  
16 prior testimony.

17 Then I reviewed it. So we exchanged  
18 information. And then we made changes. And I  
19 reviewed the final draft. I approved it, and I  
20 signed it.

21 THE INTERPRETER: "37. If your answer to  
22 Question 36 was no, that you did not write all of  
23 your declaration, which paragraphs of your  
24 declaration did you write?"

25 "Objection."

1           THE WITNESS: So as I said before, the  
2 draft was written by my attorneys. And then I  
3 reviewed it. We had some exchanges. And I approved  
4 the final draft, and I signed it.

5           THE INTERPRETER: "38. Other than  
6 yourself, did any lawyer representing Cubatabaco or  
7 Habanos write any portion of your declaration?"

8                       "Objection."

9           THE WITNESS: The attorneys who represent  
10 Cubatabaco, yes, they wrote the draft.

11          THE INTERPRETER: "39. If your answer to  
12 Question 38 was yes, that a lawyer other than  
13 yourself representing Cubatabaco or Habanos wrote  
14 any portion of your declaration, please identify the  
15 paragraphs or portions of paragraphs written by such  
16 lawyer or lawyers."

17                       "Objection."

18          THE WITNESS: Well, as I said before, the  
19 draft was written by the Cubatabaco attorneys, based  
20 on my prior testimony. We made some changes. I  
21 reviewed it. And I approved the final draft and I  
22 signed it.

23          THE INTERPRETER: "40. If your answer to  
24 Question 38 was yes, that a lawyer other than  
25 yourself representing Cubatabaco or Habanos wrote

1 any portion of your declaration, please identify the  
2 lawyer or lawyers who wrote the paragraphs you  
3 identified in response to the previous question."

4 "Objection."

5 THE WITNESS: Well, based on my  
6 understanding, Lindsey Frank. But I couldn't tell  
7 you if any other lawyer from Lindsey Frank's firm  
8 participated.

9 THE INTERPRETER: "41. Did anyone other  
10 than yourself or another lawyer representing  
11 Cubatabaco or Habanos write any portion of your  
12 declaration?"

13 "Objection."

14 THE WITNESS: As I said, only the lawyers  
15 for Cubatabaco and I participated in writing this  
16 declaration.

17 THE INTERPRETER: "42. If your answer to  
18 Question 41 was yes, that someone other than  
19 yourself or another lawyer representing Cubatabaco  
20 or Habanos wrote any portion of your declaration,  
21 what portions of your declaration did that person or  
22 persons write?"

23 "Objection."

24 THE WITNESS: Well, I'll repeat. Only the  
25 attorneys for Cubatabaco and I participated in



1 writing this declaration.

2 THE INTERPRETER: "43. If your answer to  
3 Question 41 was yes, that someone other than  
4 yourself or another lawyer representing Cubatabaco  
5 or Habanos wrote any portion of your declaration,  
6 please identify such person or persons."

7 "Objection."

8 THE WITNESS: Just the attorneys for  
9 Cubatabaco and I participated in writing this  
10 declaration.

11 THE INTERPRETER: "44. If you identified  
12 a person or persons in response to Question 43,  
13 please identify the title of each person or  
14 persons."

15 "Objection."

16 THE WITNESS: I didn't identify any person  
17 in paragraph 43. The paragraph or question,  
18 actually.

19 THE INTERPRETER: "45-A. Please review  
20 paragraph 2 of the Spanish version of your  
21 declaration. Do you see where you have stated:  
22 'Estudie ingles en la escuela secundaria,  
23 preuniversitario y en el Instituto de Comercio  
24 Exterior en Cuba, y puedo leer Y comprender  
25 materiales escritos en ingles'?"

1 THE WITNESS: Yes.

2 THE INTERPRETER: "45-B. Isn't it true  
3 that you can read and comprehend materials written  
4 in English?"

5 THE WITNESS: I can read and comprehend  
6 materials written in English.

7 THE INTERPRETER: "45-C. Other than the  
8 English language education that you describe in your  
9 declaration in paragraph 2, have you had any other  
10 education in the English language?"

11 THE WITNESS: No.

12 THE INTERPRETER: "45-D. Have you  
13 corresponded in English for business purposes?"

14 THE WITNESS: So as part of my job, I do  
15 correspond in English.

16 THE INTERPRETER: "45-E. Have you read  
17 English-language magazines for business purposes?"

18 THE WITNESS: As part of my job, yes, I  
19 read materials or magazines in English.

20 THE INTERPRETER: "45-F. If your answer  
21 to the previous question was yes, which  
22 English-language magazines have you read?"

23 THE WITNESS: For example, "Cigar  
24 Aficionado," "Halfwheel." And I don't remember any  
25 others right now.

1           THE INTERPRETER: "45-G. Have you read  
2 English-language newspapers for business purposes?"

3           THE WITNESS: At some point, an article, a  
4 newspaper article, yes.

5           THE INTERPRETER: "45-H. If your answer  
6 to the previous question was yes, which  
7 English-language newspapers have you read?"

8           THE WITNESS: Well, it could be the  
9 New York Times. But right now I don't remember any  
10 others.

11          THE INTERPRETER: "45-I. Have you read  
12 English-language websites for business purposes?"

13          THE WITNESS: Yes, during the course of my  
14 work, I do read websites in English.

15          THE INTERPRETER: "45-J. If your answer  
16 to the previous question was yes, which  
17 English-language websites have you read?"

18          THE WITNESS: That I remember, the actual  
19 website for "Cigar Aficionado," the "Halfwheel" one.  
20 And they're the ones that come to mind right now the  
21 most.

22          THE INTERPRETER: "45-K. For purposes of  
23 today's cross-examination, we may ask you to refer  
24 to certain paragraphs in the English translation of  
25 your declaration. If you need, you can review and

1 refer to the Spanish version of your declaration  
2 before responding to the question.

3 "Do you understand?"

4 "Objection. Witness should only  
5 refer to Spanish."

6 THE WITNESS: Understood.

7 THE INTERPRETER: "46. Did you have  
8 personal knowledge of all the statements you  
9 provided in paragraphs 1 through 36 of your  
10 declaration at the time you signed your declaration  
11 on October 2, 2018? For" --

12 Should I stop there?

13 MR. FRANK: I think you should read the  
14 whole paragraph.

15 Do you agree?

16 MR. GALLASTEGUI: What do you mean?

17 MR. FRANK: He's stopping at the question  
18 mark, and I think he should read the whole Question  
19 46 and the objection before the witness responds.

20 MR. GALLASTEGUI: Yeah.

21 THE INTERPRETER: Okay. For technical  
22 purposes, I stopped at a question mark, but let's  
23 read the whole thing.

24 "46. Did you have personal knowledge  
25 of all the statements you provided in paragraphs 1

1 through 36 of your declaration at the time you  
2 signed your declaration on October 22nd of 2018?

3 "For purposes of Questions 46 through  
4 47, 'personal knowledge' means knowledge of facts or  
5 information gained through firsthand experience as  
6 opposed to knowledge or information obtained from  
7 review of business records that you were not  
8 directly involved in preparing or approving or from  
9 conversations with present or former employees."

10 "Objection. Advises witness that she  
11 can answer paragraph by paragraph."

12 THE WITNESS: So the question is very  
13 long, right? So the first thing is that I'm being  
14 asked if I have knowledge, right? And then it  
15 defines "personal knowledge" as firsthand knowledge?  
16 Isn't that the case?

17 If it's defining knowledge, that  
18 personal knowledge that I obtained through my  
19 personal firsthand experience, then in my  
20 declaration there are parts that were not obtained  
21 through my personal firsthand experience. But yes,  
22 as part of my review during the course of my work,  
23 from business records of the case and all the  
24 documentation related to the case, and for me that's  
25 what I have testified to here as "personal

1 knowledge."

2 THE INTERPRETER: "47. If your answer to  
3 Question 46 is no, what are those facts in your  
4 declaration not made on your personal knowledge?"

5 "Objection. Advises witness that she  
6 can answer paragraph by paragraph."

7 THE WITNESS: Well, I assume that  
8 everything that I testified to is based on my  
9 personal knowledge. Based on the understanding that  
10 my personal knowledge is not just my experience or  
11 my personal experience, but also everything that I  
12 was able to come to know based on my revision of  
13 records and documentation regarding the case, the  
14 one that I have access to because of the fact that  
15 I'm general counsel of Habanos.

16 So based on the question before, I  
17 think that the answer then to the previous question  
18 should be that everything is based on my personal  
19 knowledge.

20 THE INTERPRETER: "48. Did you review any  
21 documents, other than those attached to your  
22 declaration as annexes, to prepare for your  
23 cross-examination today?"

24 THE WITNESS: No.

25 THE INTERPRETER: "49. If your answer to

1 Question 48 is yes, which additional documents did  
2 you review to prepare for your cross-examination  
3 today?"

4 "Objection."

5 Should we read the objection?

6 MR. FRANK: Yes.

7 THE INTERPRETER: "Petitioner instructs  
8 witness not to answer regarding confidential  
9 communications, including reports made by any  
10 employee of Cubatabaco or Habanos of confidential  
11 communications related to either legal services or  
12 an opinion on law or assistance in some legal  
13 proceeding, in which any legal counsel for  
14 Cubatabaco or Habanos, S.A., whether in-house or  
15 outside counsel, (legal counsel), (A) was a party to  
16 the communication; or, (B) was present during the  
17 communication. Otherwise witness may answer the  
18 question."

19 THE WITNESS: So the answer to Question 48  
20 was no.

21 THE INTERPRETER: "50. Isn't it true that  
22 Habanos owns trademark registrations for Cohiba in  
23 every country in which Cohiba is registered as a  
24 trademark, other than in the United States and  
25 Cuba?"

1 THE WITNESS: It is true.

2 THE INTERPRETER: "51. I direct your

3 attention to the [REDACTED]

4 [REDACTED] in paragraph 15  
5 of your declaration. You are familiar with that  
6 document?"

7 THE WITNESS: Yes.

8 THE INTERPRETER: "52. Under the [REDACTED]  
9 [REDACTED] CTED

10 [REDACTED]

11 [REDACTED]

12 [REDACTED]

13 [REDACTED]

14 [REDACTED]

15 THE WITNESS: [REDACTED]

16 [REDACTED]

17 [REDACTED]

18 THE INTERPRETER: "53. Is it your  
19 understanding that the United States embargo against  
20 Cuba prohibit Cubatabaco or Habanos from applying to  
21 register trademarks in the United States?"

22 MR. FRANK: Can you read the objection,  
23 too?

24 THE INTERPRETER: "Objection."

25 THE WITNESS: No, as far as I know, it



1 doesn't prohibit it.

2 THE INTERPRETER: "54. Is it your  
3 understanding that the United States embargo against  
4 Cuba does not prohibit Cubatabaco" -- I'm sorry. I  
5 read that already. Is that the case?

6 MR. GALLASTEGUI: We're on 54.

7 THE INTERPRETER: 54. Thank you.

8 "Is it your understanding that the  
9 United States embargo against Cuba does not prohibit  
10 Cubatabaco or Habanos from applying to register  
11 trademarks in the United States?"

12 "Objection."

13 THE WITNESS: Based on my understanding,  
14 it does not prohibit to apply or register trademarks  
15 in the United States.

16 (Respondent's Exhibit 2 was marked for  
17 identification by the court reporter.)

18 THE INTERPRETER: "55. The document that  
19 has just been marked as Respondent's Exhibit 2 is a  
20 true and correct copy of a trademark registration  
21 certificate obtained from the USPTO's website at  
22 [www.uspto.gov](http://www.uspto.gov) for the United States Trademark  
23 Registration Number 1,147,309 for General Cigar's  
24 Cohiba trademark.

25 "Do you see where we have highlighted

1 the entry on the certificate that states that  
2 February 17th, 1981 was the registration date for  
3 General Cigar's Cohiba trademark?"

4 THE WITNESS: Yes.

5 THE INTERPRETER: "56. Do you have any  
6 reason to doubt the veracity of the February 17th,  
7 1981 registration date identified in Respondent's  
8 Exhibit 2?"

9 "Objection."

10 THE WITNESS: No.

11 THE INTERPRETER: "57-A. To the best of  
12 your knowledge, when did Cubatabaco first become  
13 aware that the USPTO had issued the registration to  
14 General Cigar for the Cohiba mark shown in  
15 Respondent's Exhibit 2?"

16 "Objection."

17 THE WITNESS: I'm not sure. I suppose  
18 that it would have been when they tried to register  
19 the trademark Cohiba mark in the United States.

20 THE INTERPRETER: "57-B."

21 There's one -- I was taking one  
22 second to think about this. I'm going to confer  
23 with the witness about a word, and I'm going to  
24 search my materials.

25 Is that okay by counsel?

1 MR. GALLASTEGUI: Yes.

2 MR. FRANK: That's fine.

3 (Interpreter conferred with witness in Spanish.)

4 MR. FRANK: "Word mark" I think would be  
5 the translation.

6 MR. GALLASTEGUI: I will defer to you.

7 THE INTERPRETER: "Word mark," then.

8 Thank you for everyone's assistance.

9 Shall we then -- is it understood the  
10 way it's now been responded to?

11 MR. GALLASTEGUI: Yes.

12 THE INTERPRETER: Thank you.

13 "57-B. Isn't it true that by  
14 August 1984 Cubatabaco knew that the USPTO had  
15 issued the registration to General Cigar for the  
16 Cohiba mark shown in Respondent's Exhibit 2?"

17 "Objection."

18 THE WITNESS: I don't know.

19 THE INTERPRETER: "68. Isn't it true that  
20 Cubatabaco" --

21 MR. GALLASTEGUI: No, no. 58.

22 THE INTERPRETER: "58. Do you know, or  
23 know of, an individual named Adargelio Garrido de la  
24 Grana?"

25 MR. FRANK: Just read the objection.

1 THE INTERPRETER: "Objection."

2 THE WITNESS: Yes.

3 THE INTERPRETER: "59. If your answer to  
4 Question 58 is yes, who is he or was he?"

5 "Objection."

6 THE WITNESS: He was general counsel for  
7 Habanos, S.A. I'm sorry.

8 MR. GALLASTEGUI: I'm fine with any of  
9 both, if she refers to "legal director," let's  
10 just --

11 MR. FRANK: We're reserving also -- as I  
12 stated in the beginning, we're reserving our right  
13 to object to the translation until after the fact.  
14 We have a lot of questions to get through today, so  
15 I think --

16 THE INTERPRETER: All right. "General  
17 counsel" and "legal director" are one and the same;  
18 but if we can stipulate to using "legal director" as  
19 a better one for this situation, then shall we do  
20 that?

21 MR. GALLASTEGUI: All right. Let's just  
22 state that for the record, that for such purposes,  
23 we will use "legal director" today instead of  
24 "general counsel," in the understanding that both  
25 terms have the same meanings, right?

1 MR. FRANK: For the record, we're not  
2 stipulating -- Petitioner is not stipulating to  
3 that. As I've said at the beginning of this  
4 deposition, we're reserving our right to object to  
5 the translation until after we've had an opportunity  
6 to review it.

7 MR. GALLASTEGUI: Then let's move forward.

8 THE INTERPRETER: Not to belabor the  
9 point, but I'll just use "legal director."

10 MR. GALLASTEGUI: We'll move forward.

11 THE INTERPRETER: "60. Isn't it true that  
12 Mr. Adargelio Garrido de la Grana was one of your  
13 predecessors in the legal department?"

14 "Objection."

15 THE WITNESS: Yes.

16 THE INTERPRETER: "61. Isn't it true that  
17 Mr. Adargelio Garrido de la Grana was one of your  
18 predecessors **REDACTED**

**REDACTED**?"

20 "Objection."

21 THE WITNESS: Yes, he was.

22 THE INTERPRETER: "62. Are you aware that  
23 on June 6, 2000, Mr. Adargelio Garrido de la Grana  
24 provided sworn testimony as a corporate  
25 representative on behalf of Cubatabaco in the United

1 States federal litigation proceeding?"

2 "Objection."

3 THE WITNESS: I know there's testimony  
4 that he provided, but I'm not sure if it was on that  
5 date or on another date.

6 THE INTERPRETER: "63. Did you know that  
7 Mr. Adargelio Garrido de la Grana testified in the  
8 United States federal litigation proceeding that  
9 Cubatabaco was aware in 1984 that General Cigar  
10 owned the United States registration for the Cohiba  
11 trademark for cigars?"

12 "Objection."

13 THE WITNESS: No, I did not know.

14 THE INTERPRETER: "64. Did you or do you  
15 know Mr. Adargelio Garrido de la Grana?"

16 "Objection."

17 THE WITNESS: Yes, I do know him.

18 THE INTERPRETER: "65. Is he or was he a  
19 truthful man?"

20 "Objection."

21 THE WITNESS: Based on the knowledge I  
22 have of him, I couldn't tell you though if he is a  
23 truthful man or a man who is sincere.

24 THE INTERPRETER: "66. Do you have any  
25 reason to believe that he testified falsely as a

1 witness in the United States federal litigation  
2 proceeding?"

3 "Objection."

4 THE WITNESS: I don't have any reason to  
5 believe that.

6 THE INTERPRETER: "67. So if Mr. Garrido  
7 de la Grana testified that Cubatabaco knew about  
8 General Cigar's United States registration for the  
9 Cohiba trademark as of August 1984, that was the  
10 truth, correct?"

11 "Objection."

12 THE WITNESS: I suppose so, that he had  
13 truthful information.

14 THE INTERPRETER: "68. Isn't it true that  
15 Cubatabaco did not file an application to register  
16 the Cubatabaco Cohiba mark with the USPTO until  
17 January 5th (sic) of 1997?"

18 THE WITNESS: As far as I know, yes,  
19 that's what it is.

20 MR. GALLASTEGUI: Proceed to 69.

21 THE INTERPRETER: "Paragraph 9 of your  
22 declaration identifies January 15, 1997 as the date  
23 on which Cubatabaco filed an application to register  
24 the Cubatabaco Cohiba mark with the USPTO, correct?"

25 THE WITNESS: Paragraph 9 you said?

1 Yes.

2 THE INTERPRETER: "70. So Cubatabaco did  
3 not file its application to register the Cohiba  
4 trademark in the United States until almost 13 years  
5 after Mr. Garrido testified that Cubatabaco learned  
6 about General Cigar's registration for the same  
7 mark, correct?"

8 "Objection."

9 THE WITNESS: Well, what I can say is that  
10 it was not filed, the application wasn't filed until  
11 January 15th, 1997.

12 (Respondent's Exhibit 3 was marked for  
13 identification by the court reporter.)

14 THE INTERPRETER: "71. The document that  
15 has just been marked as Respondent's Exhibit 3 is a  
16 true and correct copy of the trademark registration  
17 certificate obtained by the USPTO's website at  
18 www.uspto.gov which acknowledges that United States  
19 Trademark Registration Number 1,898,273 for the mark  
20 'Cohiba' has been granted to General Cigar.

21 "Do you see where we have highlighted  
22 the entry of the certificate that states that  
23 June 6th, 1995 was the registration date for General  
24 Cigar's 'Cohiba' trademark?"

25 THE WITNESS: Yes.



1 THE INTERPRETER: "72. Do you have any  
2 reason to doubt the veracity of the June 6, 1995  
3 registration date identified in Respondent's Exhibit  
4 3?"

5 "Objection."

6 THE WITNESS: No.

7 THE INTERPRETER: "73-A. To the best of  
8 your knowledge, when did Cubatabaco first become  
9 aware that the USPTO had issued the registration to  
10 General Cigar for the 'Cohiba' mark shown in  
11 Respondent's Exhibit 3?"

12 "Objection."

13 THE WITNESS: I do not know that  
14 information very well.

15 THE INTERPRETER: "73-B. Isn't it true  
16 that by at least June 2, 1994, Cubatabaco knew that  
17 General Cigar had applied to register a second  
18 Cohiba trademark with the USPTO shown in  
19 Respondent's Exhibit 3?"

20 "Objection."

21 THE WITNESS: I don't know.

22 THE INTERPRETER: "74. Do you know, or  
23 know of, an individual named Adargelio Garrido de la  
24 Grana?"

25 "Objection."

1 THE WITNESS: Yes, as I've said before.

2 MR. GALLASTEGUI: No, wait. Just wait a  
3 second. I think that we need to -- yeah, we should  
4 skip to Question 78.

5 THE INTERPRETER: Right.

6 MR. GALLASTEGUI: We should skip to 74,  
7 sorry. No, not 74. 78. Yeah, we should skip to  
8 78, please.

9 THE INTERPRETER: "78. Did you know that  
10 on March 14, 2001, Cubatabaco provided responses to  
11 General Cigar's second set of interrogatories served  
12 in the United States federal litigation proceeding,  
13 which responses were signed and verified by  
14 Mr. Adargelio Garrido de la Grana under penalty of  
15 perjury and which stated in response to General  
16 Cigar's interrogatory number 32(A) that Cubatabaco  
17 was aware of General Cigar's application to register  
18 the Cohiba trademark with the Registration Number  
19 1,898,273 after June 2, 1994, but before June 20 of  
20 1994?"

21 "Objection."

22 THE WITNESS: I don't know that  
23 information.

24 THE INTERPRETER: "79. Do you have any  
25 reason to doubt that Mr. Adargelio Garrido de la

1 Grana made on behalf of Cubatabaco" -- I'll repeat  
2 it.

3 "79. Do you have any reason to doubt  
4 the statement that Mr. Adargelio Garrido de la Grana  
5 made on behalf of Cubatabaco in the federal  
6 litigation proceeding?"

7 "Objection."

8 THE WITNESS: No.

9 THE INTERPRETER: "80. And Mr. Garrido de  
10 la Grana is, or was, a truthful man, correct?"

11 MR. FRANK: Objection.

12 THE INTERPRETER: "Objection."

13 THE WITNESS: I don't know him that well  
14 to be able to assert that or to doubt about that.

15 THE INTERPRETER: "81. Do you have any  
16 reason to believe that Mr. Garrido de la Grana would  
17 attest to and sign a document containing false  
18 statements in a United States federal litigation  
19 proceeding?"

20 "Objection."

21 THE WITNESS: Can the question be  
22 repeated?

23 (Interpreter read question to witness in Spanish.)

24 THE WITNESS: No, I don't have any reason  
25 to believe that.

1           THE INTERPRETER: "82. So if Mr. Garrido  
2 de la Grana attested to and signed a document  
3 stating that Cubatabaco knew about General Cigar's  
4 second United States trademark application for the  
5 Cohiba mark by at least June 2nd of 1994, that was  
6 the truth, correct?"

7           "Objection."

8           THE WITNESS: I don't have any reasons to  
9 doubt that.

10          THE INTERPRETER: Should I state "83  
11 omitted," as such, on the record?

12          MR. FRANK: Yes, please.

13          MR. GALLASTEGUI: Yes, please.

14          THE INTERPRETER: "83 omitted."

15                 "84. Isn't it true that Cubatabaco  
16 was aware of General Cigar's application to register  
17 the trademark that became United States Registration  
18 Number 1,898,273 for the Cohiba trademark between  
19 June 2nd, 1994 and June 20, 1994?"

20                 "Objection."

21          THE WITNESS: I don't know.

22          THE INTERPRETER: "85. Isn't it true that  
23 Cubatabaco did not file an application to register  
24 the Cubatabaco Cohiba mark with the USPTO until  
25 January 15th of 1997?"

1 "Objection."

2 THE WITNESS: As far as I know, that's  
3 what it is.

4 THE INTERPRETER: "86. Paragraph 9 of  
5 your declaration identifies January 15, 1997 as the  
6 date on which Cubatabaco filed an application to  
7 register the Cubatabaco Cohiba mark with the USPTO,  
8 correct?"

9 MR. FRANK: And if you could read the  
10 objection into the record.

11 THE INTERPRETER: "Objection."

12 THE WITNESS: Correct.

13 THE INTERPRETER: "87. Isn't it true that  
14 even though Cubatabaco was aware in June 1994 that  
15 General Cigar had applied to register the trademark  
16 that became United States Registration Number  
17 1,898,273 for the Cohiba trademark, Cubatabaco did  
18 not file an application to register the Cubatabaco  
19 Cohiba mark until January 15, 1997?"

20 "Objection."

21 THE WITNESS: I cannot say for sure when  
22 they had knowledge, if they had knowledge on that  
23 date, but what I can say is that the date of the  
24 application is January 15th of 1997.

25 THE INTERPRETER: "88. So Cubatabaco did

1 not file its application to register the Cubatabaco  
2 Cohiba trademark in the United States until over two  
3 and one-half years after Mr. Garrido testified that  
4 Cubatabaco learned about General Cigar's application  
5 to register the trademark that became United States  
6 Registration Number 1,898,273, correct?"

7 "Objection."

8 THE WITNESS: What I can say is that I  
9 know that the application was filed on January 15,  
10 1997.

11 THE INTERPRETER: "89. Isn't it also true  
12 that Cubatabaco did not file the current opposition  
13 proceeding against General Cigar until January 15,  
14 1997?"

15 "Objection."

16 THE WITNESS: It's true.

17 THE INTERPRETER: "90. If your response  
18 to the previous question is no, please turn to  
19 paragraph 28 of your declaration, subparagraph A.  
20 Please indicate for the record when you are there."

21 Should we stop there?

22 MR. GALLASTEGUI: Just read the question  
23 for the record.

24 THE INTERPRETER: I'll repeat it again.

25 "If your response to the previous

1 question is no, please turn to paragraph 28 of your  
2 declaration to subparagraph A. Please indicate for  
3 the record when you are there. You state  
4 'Cubatabaco has initiated and has proceeded with the  
5 instant cancellation proceeding which was filed in  
6 1997.'

7 "Do you see that?"

8 THE WITNESS: Yes.

9 THE INTERPRETER: "91. So Cubatabaco did  
10 not file the instant cancellation proceeding until  
11 over two and a half years after Mr. Garrido  
12 testified that Cubatabaco learned about General  
13 Cigar's June 1994 application to register the  
14 trademark that became United States Registration  
15 Number 1,898,273, correct?"

16 "Objection."

17 THE WITNESS: As I said before, it was  
18 filed in 1997, the cancellation process.

19 MR. FRANK: Can we take a break for five  
20 minutes?

21 THE VIDEOGRAPHER: Stand by. The time is  
22 10:31. We're going off the record. This will end  
23 Media Unit Number 1.

24 (Recess.)

25 THE VIDEOGRAPHER: The time is 10:44. We

1 are back on the record. This will be start of Media  
2 Unit Number 2.

3 THE INTERPRETER: "92. Please turn to  
4 paragraph 10 of Respondent's Exhibit 1 and review  
5 statements you provided therein. Please state for  
6 the record when you have completed your review."

7 THE WITNESS: I'm done.

8 (Respondent's Exhibit 4 was marked for  
9 identification by the court reporter.)

10 THE INTERPRETER: "93. The document that  
11 has just been marked Respondent's Exhibit 4 is a  
12 true and correct copy of the trademark registration  
13 certificate obtained from the USPTO's website at  
14 www.uspto.gov for United States Trademark  
15 Registration Number 2,145,804.

16 "I direct your attention to paragraph  
17 10 of your declaration, which is the document marked  
18 as Respondent's Exhibit 1, United States Trademark  
19 Registration Number 2,145,804, is the first of  
20 Cubatabaco's United States trademark registrations  
21 that you identify in that paragraph, correct?"

22 THE WITNESS: Correct.

23 THE INTERPRETER: "94. Have you seen the  
24 USPTO certificate of registration before?"

25 THE WITNESS: Yes.



1           THE INTERPRETER: "95. Isn't it true that  
2     the trademark registered as United States Trademark  
3     Registration Number 2,145,804 does not contain the  
4     word 'Cohiba'?"

5           THE WITNESS: It is true.

6           MR. GALLASTEGUI: Okay. So then let's  
7     mark Exhibit 5, please, and skip to Question 100.

8           (Respondent's Exhibit 5 was marked for  
9     identification by the court reporter.)

10          THE INTERPRETER: "100. The document that  
11     has just been marked Respondent's Exhibit 5 is a  
12     true and correct copy of a trademark registration  
13     certification obtained from the USPTO's website at  
14     www.uspto.gov for United States Trademark  
15     Registration Number 4,988,587.

16                 "Direct your attention to paragraph  
17     10 of your declaration, which is the document marked  
18     as Respondent's Exhibit 1. United States Trademark  
19     Registration Number 4,988,587 is the second of  
20     Cubatabaco's United States trademark registrations  
21     that you identify in that paragraph, correct?"

22          THE WITNESS: Correct.

23          THE INTERPRETER: "101. Have you seen the  
24     USPTO certificate of registration before?"

25          THE WITNESS: Yes.

1           THE INTERPRETER: "102. Isn't it true  
2       that the trademark registered as United States  
3       Trademark Registration Number 4,988,587 does not  
4       contain the word 'Cohiba'?"

5           THE WITNESS: It is true.

6           MR. GALLASTEGUI: Let's mark Exhibit 6,  
7       please, and proceed to Question 107.

8                       (Respondent's Exhibit 6 was marked for  
9                       identification by the court reporter.)

10          THE INTERPRETER: "107. The document that  
11       has just been marked Respondent's Exhibit 6 is a  
12       true and correct copy of a trademark registration  
13       certificate obtained from the USPTO's website at  
14       www.uspto.gov for United States Trademark  
15       Registration Number 1,557,163.

16                       "Direct your attention to paragraph  
17       10 of your declaration, which is the document marked  
18       Respondent's Exhibit 1, United States Trademark  
19       Registration Number 1,557,163 is the third of  
20       Cubatabaco's United States trademark registrations  
21       that you identify in that paragraph, correct?"

22          THE WITNESS: Correct.

23          THE INTERPRETER: "108. Have you seen the  
24       USPTO certificate of registration before?"

25          THE WITNESS: Yes.

1           THE INTERPRETER: "109. Isn't it true  
2     that the trademark registered United States  
3     Trademark Registration Number 1,557,163 does not  
4     contain the word 'Cohiba'?"

5           THE WITNESS: It's true.

6           MR. GALLASTEGUI: Let's mark Exhibit 7,  
7     please, and skip to Question 114.

8           (Respondent's Exhibit 7 was marked for  
9     identification by the court reporter.)

10          THE INTERPRETER: "114. The document that  
11     has just been marked Respondent's Exhibit 7 is a  
12     true and correct copy of a trademark registration  
13     certificate obtained from the USPTO's website at  
14     www.uspto.gov for United States Trademark  
15     Registration Number 3,402,158.

16                 "Direct your attention to paragraph  
17     10 of your declaration, which is the document marked  
18     Respondent's Exhibit 1. United States Trademark  
19     Registration Number 3,402,158 is the fourth of  
20     Cubatabaco's United States trademark registrations  
21     that you identify in that paragraph, correct?"

22          THE WITNESS: Correct.

23          THE INTERPRETER: "115. Have you seen the  
24     USPTO certificate of registration before?"

25          THE WITNESS: Yes.

1           THE INTERPRETER: "116. Isn't it true  
2     that the trademark registered as Cubatabaco's United  
3     States Trademark Registration Number 3,402,158 does  
4     not contain the word 'Cohiba'?"

5           THE WITNESS: It is true.

6           MR. GALLASTEGUI: Let's mark Exhibit 8,  
7     please, and proceed to Question 122.

8           (Respondent's Exhibit 8 was marked for  
9     identification by the court reporter.)

10          THE INTERPRETER: "122. The document that  
11     has just been marked as Respondent's Exhibit 8 is a  
12     true and correct copy of a trademark registration  
13     certificate obtained from the USPTO website at  
14     www.uspto.gov for the United States Trademark  
15     Registration Number 4,244,461.

16                 "Direct your attention to paragraph  
17     10 of your declaration, which is the document marked  
18     Respondent's Exhibit 1. United States Trademark  
19     Registration Number 4,244,461 is the fifth of  
20     Cubatabaco's trademark registrations that you  
21     identify in that paragraph, correct?"

22          THE WITNESS: Correct.

23          THE INTERPRETER: "123. Have you seen the  
24     USPTO certificate of registration before?"

25          THE WITNESS: Yes.

1 THE INTERPRETER: "124. Isn't it true  
2 that Cubatabaco's United States Trademark  
3 Registration Number 4,244,461 does not contain the  
4 word 'Cohiba'?"

5 THE WITNESS: It's true.

6 MR. GALLASTEGUI: Let's mark Exhibit 9,  
7 please, and skip to Question 130.

8 (Respondent's Exhibit 9 was marked for  
9 identification by the court reporter.)

10 THE INTERPRETER: "130. Please turn to  
11 paragraph 11 of the document marked as Respondent's  
12 Exhibit 1 and review the statements you provided  
13 therein. Please indicate for the record when you  
14 have completed your review."

15 THE WITNESS: Ready.

16 THE INTERPRETER: "131. The document that  
17 has just been marked Respondent's Exhibit 9 is a  
18 true and correct copy of a trademark registration  
19 certificate obtained by the USPTO's website at  
20 [www.uspto.gov](http://www.uspto.gov) for United States Trademark  
21 Registration Number 1,970,911.

22 "Direct your attention to paragraph  
23 11 of your declaration, which is the document marked  
24 Respondent's Exhibit 1. United States Trademark  
25 Registration Number 1,970,911 is the first of

1 Cubatabaco's United States trademark registrations  
2 you identify in that paragraph, correct?"

3 THE WITNESS: Correct.

4 THE INTERPRETER: "132. Have you seen the  
5 USPTO certificate of registration before?"

6 THE WITNESS: Yes.

7 THE INTERPRETER: "133. Isn't it true  
8 that the mark shown in Cubatabaco's United States  
9 Trademark Registration Number 1,970,911 does not  
10 contain the word 'Cohiba'?"

11 THE WITNESS: It's true.

12 THE INTERPRETER: "134. Isn't it true  
13 that the term 'La Casa Del Habano' are the only  
14 words shown in the certificate of registration for  
15 United States Trademark Registration Number  
16 1,970,911?"

17 THE WITNESS: It's true.

18 MR. GALLASTEGUI: Please mark Exhibit 10.

19 (Respondent's Exhibit 10 was marked  
20 for identification by the court  
21 reporter.)

22 THE INTERPRETER: "135. The document that  
23 has just been marked Respondent's Exhibit 10 is a  
24 true and correct copy of a trademark registration  
25 certificate obtained from the USPTO's website at

1     www.uspto.gov for United States Registration Number  
2     2,212,119.

3                     "Direct your attention to paragraph  
4     11 of your declaration, which is the document marked  
5     Respondent's Exhibit 1, United States Registration  
6     Number 2,212,119 is the second of Cubatabaco's  
7     United States trademark registrations that you  
8     identify in that paragraph, correct?"

9                     THE WITNESS:   Correct.

10                    THE INTERPRETER:  "136.  Have you seen the  
11     USPTO certificate of registration before?"

12                    THE WITNESS:   Yes.

13                    THE INTERPRETER:  "137.  Isn't it true  
14     that the trademark registered as United States  
15     Registration Number 2,212,119 does not contain the  
16     word 'Cohiba'?"

17                    THE WITNESS:   It's true.

18                    THE INTERPRETER:  "138.  Isn't it true  
19     that the term 'La Casa Del Habano' are the only  
20     words shown in the certificate of registration of  
21     United States Registration Number 2,212,119?"

22                    THE WITNESS:   It's true.

23                    MR. GALLASTEGUI:  Mark Exhibit 11.

24                    (Respondent's Exhibit 11 was marked  
25     for identification by the court

1 reporter.)

2 THE INTERPRETER: "139. The document that  
3 has just been marked Respondent's Exhibit 11 is a  
4 true and correct copy of a trademark registration  
5 certificate obtained from the USPTO's website at  
6 www.uspto.gov for United States Registration Number  
7 2,128,050.

8 "Direct your attention to paragraph  
9 11 of your declaration, which is the document marked  
10 Respondent's Exhibit 1. United States Registration  
11 Number 2,128,050 is the third of Cubatabaco's United  
12 States trademark registrations that you identify in  
13 that paragraph, correct?"

14 THE WITNESS: Correct.

15 THE INTERPRETER: "140. Have you seen the  
16 USPTO certificate of registration before?"

17 THE WITNESS: Yes.

18 THE INTERPRETER: "141. Isn't it true  
19 that the trademark registered as United States  
20 Registration Number 2,128,050 does not contain the  
21 word 'Cohiba'?"

22 THE WITNESS: It's true.

23 THE INTERPRETER: "141 (sic). Isn't it  
24 true that the term 'La Perla' are the only words  
25 shown in the certificate of registration for United



1 States Registration Number 2,128,050?"

2 THE WITNESS: It's true.

3 MR. GALLASTEGUI: Please mark Exhibit 12.  
4 (Respondent's Exhibit 12 was marked  
5 for identification by the court  
6 reporter.)

7 THE INTERPRETER: "143. The document that  
8 has just been marked Respondent's Exhibit 12 is a  
9 true and correct copy of a trademark registration  
10 certificate obtained from the USPTO's website at  
11 www.uspto.gov for United States Trademark  
12 Registration Number 1,653,845.

13 "Direct your attention to paragraph  
14 11 of your declaration, which is the document marked  
15 Respondent's Exhibit 1. United States Trademark  
16 Registration Number 1,653,845 is the fourth of  
17 Cubatabaco's United States trademark registrations  
18 that you identify in that paragraph, correct?"

19 THE WITNESS: Correct.

20 THE INTERPRETER: "144. Have you seen the  
21 USPTO certificate of registration before?"

22 THE WITNESS: Yes.

23 THE INTERPRETER: "145. Isn't it true  
24 that the trademark registered as United States  
25 Trademark Registration Number 1,653,845 does not

1 contain the word 'Cohiba'?"

2 THE WITNESS: It's true.

3 THE INTERPRETER: "146. Isn't it true  
4 that the term "Quai D'Orsay" are the only words  
5 shown in the certificate of the registration for  
6 United States Trademark Registration Number  
7 1,653,845?"

8 THE WITNESS: It's true.

9 THE INTERPRETER: "147. Please review the  
10 statements you attested to in paragraphs 12 and 13  
11 of your declaration previously marked as  
12 Respondent's Exhibit 1. Please indicate for the  
13 record when you have completed your review."

14 THE WITNESS: Ready.

15 THE INTERPRETER: "148. Isn't it true  
16 that Cubatabaco did not export Cuban Cohiba cigars  
17 for sales outside of Cuba prior to 1982?"

18 THE WITNESS: It's true.

19 THE INTERPRETER: "149. Paragraph 13 of  
20 your declaration states that by 1992, Cuban Cohiba  
21 cigars were 'sold and promoted in numerous countries  
22 throughout the world, including the majority of  
23 European countries and Canada'; isn't that correct?"

24 THE WITNESS: Correct.

25 THE INTERPRETER: "150. Isn't it true

1 that Cubatabaco applied to register the Cohiba  
2 trademark in many countries before Cubatabaco  
3 actually exported Cuban Cohiba cigars to those  
4 countries for sale?"

5 THE WITNESS: It's true, in some cases,  
6 yes.

7 THE INTERPRETER: [REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]

12 "Objection."

13 THE WITNESS: [REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]

19 MR. GALLASTEGUI: Objection. The witness  
20 is attempting to change her sworn declaration answer  
21 with information that was requested by General Cigar  
22 and available to Cubatabaco during the discovery  
23 period but was not provided. Ms. Fernandez cannot  
24 supplement her trial testimony.

25 For the record, let's just remove the

1 objection, for the record. There is no objection.

2 THE INTERPRETER: Very well, Counsel.

3 "152-A. In paragraph 13 of your  
4 declaration marked Respondent's Exhibit 1, you also  
5 state that the trademark registrations you identify  
6 in paragraph 12 of your declaration 'have been used  
7 in association with these sales and related  
8 promotions of Cuban Cohiba cigars throughout the  
9 world'; isn't that correct?"

10 "Objection."

11 THE WITNESS: Correct.

12 THE INTERPRETER: [REDACTED] [REDACTED]

[REDACTED]  
[REDACTED]  
[REDACTED]  
[REDACTED]

17 THE WITNESS: [REDACTED]

[REDACTED].

19 THE INTERPRETER: "153. Habanos owns the  
20 trademark registrations for the Cuban Cohiba  
21 referenced in paragraph 12 of your declaration  
22 marked Respondent's Exhibit 1, including in Spain,  
23 Canada and all European countries; isn't that  
24 correct?"

25 THE WITNESS: It is correct.

1 THE INTERPRETER: "154. Isn't it true  
2 that today Habanos alone sells Cuban Cohiba cigars  
3 through distributors in Spain, Canada and all  
4 European countries?"

5 THE WITNESS: It's true.

6 THE INTERPRETER: "155. Isn't it true  
7 that today, Habanos alone promotes Cuban Cohiba  
8 cigars around the world, including in Spain, Canada  
9 and other European countries?"

10 THE WITNESS: It's true.

11 THE INTERPRETER: "156. Is it your  
12 understanding that the United States Cuban embargo  
13 laws and regulations prevent Cubatabaco from  
14 selling, either directly or through a licensee,  
15 Cuban Cohiba cigars in the United States?"

16 "Objection."

17 THE WITNESS: As far as I know, yes.

18 THE INTERPRETER: "157. Is it your  
19 understanding that the United States Cuban embargo  
20 laws and regulations prohibit Habanos from selling,  
21 either directly or through a licensee, Cuban Cohiba  
22 cigars in the United States?"

23 "Objection."

24 THE WITNESS: As far as I know, yes.

25 MR. GALLASTEGUI: Exhibit 13.

1 (Respondent's Exhibit 13 was marked  
2 for identification by the court  
3 reporter.)

4 THE INTERPRETER: "158. The document that  
5 has just been marked as Respondent's Exhibit 13 is a  
6 media note from the office of the spokesman from the  
7 United States Department of State, dated June 4th,  
8 2019, titled 'United States restricts travel and  
9 vessels to Cuba,' which was obtained from the United  
10 States Department of State website at www.state.gov.

11 "Do you understand?"

12 "Objection."

13 THE WITNESS: Yes.

14 THE INTERPRETER: "159. Does the State  
15 Department note state the following: 'Going forward  
16 the United States will prohibit U.S. travelers from  
17 going to Cuba under the previous "group  
18 people-to-people educational travel authorization."  
19 In addition, the United States will no longer permit  
20 visits to Cuba via passenger and recreational  
21 vessels, including cruise ships and yachts and  
22 private and corporate aircraft'?"

23 "Objection."

24 THE WITNESS: Is that what the media note  
25 says?

1                   May the question be repeated?

2       (Question reread to witness by interpreter.)

3                   THE WITNESS:   That's what it says.   That's  
4       what I've read that the media note says.   I can't  
5       really say more than that.

6                   THE INTERPRETER:   "160-A.   Do you have any  
7       understanding as to whether under this policy, there  
8       will be fewer United States visitors to Cuba than  
9       before?"

10                          "Objection."

11                   THE WITNESS:   I couldn't tell you.

12                   THE INTERPRETER:   "160-B.   What is that  
13       understanding?"

14                          "Objection."

15                   THE WITNESS:   No, I didn't say I have any  
16       understanding.

17                   THE INTERPRETER:   "160-C.   So isn't it  
18       correct that under this policy, there will be fewer  
19       United States visitors to Cuba than before?"

20                          "Objection."

21                   THE WITNESS:   I couldn't say that for  
22       sure.

23                   THE INTERPRETER:   "161-A.   Do you have any  
24       understanding as to whether the State Department's  
25       restrictions will mean that fewer U.S. tourists will

1 be exposed to the Cuban Cohiba cigar in Cuba?"

2 "Objection."

3 THE WITNESS: I couldn't tell.

4 THE INTERPRETER: "161-B. What is that  
5 understanding?"

6 "Objection."

7 THE WITNESS: I don't know. As I said, I  
8 didn't say I had any understanding.

9 THE INTERPRETER: "161-C. So isn't it  
10 correct that the State Department's restriction will  
11 mean that fewer U.S. tourists will be exposed to the  
12 Cuban Cohiba cigar in Cuba?"

13 "Objection."

14 THE WITNESS: I couldn't affirm.

15 THE INTERPRETER: "162. Please review the  
16 statements you attested to in paragraph 28 of your  
17 declaration marked Respondent's Exhibit 1. Please  
18 indicate for the record when you have completed your  
19 review."

20 THE WITNESS: Ready.

21 THE INTERPRETER: "163. Are you familiar  
22 with each of the legal proceedings you identify in  
23 sub-paragraphs A through I of paragraph 28 of your  
24 declaration?"

25 THE WITNESS: Yes.



1           THE INTERPRETER: "164. The legal  
2 proceeding identified in paragraph 28-A of your  
3 declaration is the current trademark cancellation  
4 proceeding between Cubatabaco and General Cigar for  
5 which you are here providing testimony today; isn't  
6 that correct?"

7           THE WITNESS: Correct.

8           THE INTERPRETER: "165. As of today,  
9 there has been no final decision in the trademark  
10 cancellation proceeding between Cubatabaco and  
11 General Cigar; is that correct?"

12          THE WITNESS: It is correct.

13          THE INTERPRETER: "166. The action  
14 identified in paragraph 28-B of your declaration is  
15 the federal lawsuit in the Southern District of  
16 New York filed by Cubatabaco against General Cigar,  
17 correct?"

18          THE WITNESS: Correct.

19          THE INTERPRETER: "167. In paragraph 28-B  
20 of your declaration, you mention three appeals to  
21 the Second Circuit, correct?"

22          THE WITNESS: Correct.

23          THE INTERPRETER: "168. Are you familiar  
24 with the results of the various appeals in the  
25 federal action referenced in paragraph 28-B of your

1 declaration?"

2 THE WITNESS: Yes, I've read the synopsis.

3 THE INTERPRETER: "Summaries."

4 Interpreter's correction.

5 (Respondent's Exhibit 14 was marked  
6 for identification by the court  
7 reporter.)

8 THE INTERPRETER: "169. The document  
9 which has just been marked Respondent's Exhibit 14  
10 is a true and correct copy of the Second Circuit's  
11 February 24, 2005 opinion related to the federal  
12 action you reference in paragraph 28-B of your  
13 declaration obtained from Westlaw.com.

14 "Do you understand that?"

15 THE WITNESS: Yes.

16 THE INTERPRETER: "170. Are you aware  
17 that the Second Circuit's decision stated, 'We  
18 cannot sanction a grant of injunctive remedy to  
19 Cubatabaco in the form of the right, privilege and  
20 power to exclude General Cigar from using its duly  
21 registered mark'?"

22 MR. FRANK: I would just point out for the  
23 record that part of that question was in quotation  
24 marks. I don't know if you want to reread it with  
25 the quotation marks indicated, for the record.

1 THE INTERPRETER: Sure.

2 "170. Are you aware that the Second  
3 Circuit's decision stated, 'We cannot sanction a  
4 grant of injunctive remedy to Cubatabaco in the form  
5 of the right, privilege and power to exclude General  
6 Cigar from using its duly registered mark'?"

7 THE WITNESS: I don't have that  
8 information.

9 Can you repeat the question, last  
10 part, the quote.

11 (Interpreter reread question to witness.)

12 THE WITNESS: I'll just sustain my  
13 response.

14 THE INTERPRETER: "171. Are you aware  
15 that the Second Circuit's decision vacated the  
16 District Court's order canceling General Cigar's  
17 Cohiba registration?"

18 "Objection. Petitioner instructs  
19 witness not to answer to the extent her  
20 understanding is based on confidential  
21 communications, including reports made by any  
22 employee of Cubatabaco or Habanos of confidential  
23 communications related to either legal services or  
24 an opinion on law or assistance in some legal  
25 proceeding, in which any legal counsel for

1 Cubatabaco or Habanos, S.A., whether in-house or  
2 outside counsel, (legal counsel), (A) was a party to  
3 the communications; or (B) was present during the  
4 communication. Otherwise, witness may answer the  
5 question."

6 THE WITNESS: I don't have that  
7 information.

8 THE INTERPRETER: "172. Are you aware  
9 that the Second Circuit's decision vacated the  
10 District Court's order enjoining General Cigar from  
11 use of the Cohiba mark in the United States?"

12 "Objection. Petitioner instructs  
13 witness not to answer to the extent her  
14 understanding is based on confidential  
15 communications, including reports made by any  
16 employee of Cubatabaco or Habanos of confidential  
17 communications, related to either legal services or  
18 an opinion on law or assistance in some legal  
19 proceeding, in which any legal counsel for  
20 Cubatabaco or Habanos, S.A., whether in-house or  
21 outside counsel, (legal counsel), (A) was a party to  
22 the communications; or (B) was present during the  
23 communication. Otherwise, witness may answer the  
24 question."

25 I'm sorry. I think I read 171 in

1 Spanish. I'll read 172. I apologize.

2 (Interpreter reads question to witness in Spanish.)

3 THE WITNESS: I don't have that piece of  
4 information.

5 THE INTERPRETER: "173. Are you aware  
6 that the Second Circuit's decision vacated the  
7 District Court's order directing General Cigar to  
8 remove its Cohiba cigars from retailers and  
9 distributors?"

10 "Objection. Petitioner instructs  
11 witness not to answer to the extent her  
12 understanding is based on confidential  
13 communications, including reports made by any  
14 employee of Cubatabaco or Habanos of confidential  
15 communications, related to either legal services or  
16 an opinion on law or assistance in some legal  
17 proceeding, in which any legal counsel for  
18 Cubatabaco or Habanos, S.A., whether in-house or  
19 outside counsel, (legal counsel), (A) was a party to  
20 the communications; or (B) was present during the  
21 communication. Otherwise, witness may answer the  
22 question."

23 THE WITNESS: I don't have that  
24 information.

25 THE INTERPRETER: "174. Are you aware

1 that the Second Circuit's decision directed the  
2 District Court to dismiss Cubatabaco's claims in the  
3 federal action?"

4 "Objection. Petitioner instructs  
5 witness not to answer to the extent her  
6 understanding is based on confidential  
7 communications, including reports made by any  
8 employee of Cubatabaco or Habanos of confidential  
9 communications, related to either legal services or  
10 an opinion on law or assistance in some legal  
11 proceeding, in which any legal counsel for  
12 Cubatabaco or Habanos, S.A., whether in-house or  
13 outside counsel, (legal counsel), (A) was a party to  
14 the communications; or (B) was present during the  
15 communication. Otherwise, witness may answer the  
16 question."

17 THE WITNESS: I don't know details for the  
18 proceedings, for that proceeding.

19 THE INTERPRETER: Counsel, gentlemen, when  
20 we see fit for a break, whenever it's proper.

21 MR. FRANK: Would you like to take a  
22 break?

23 THE INTERPRETER: Please.

24 MR. GALLASTEGUI: [REDACTED]

[REDACTED]

1

[REDACTED]

21

MR. FRANK: Petitioner disagrees with

22

Respondent's objection and the substance therein.

23

THE VIDEOGRAPHER: The time is 11:56. We

24

are going off the record. This will end Media Unit

25

Number 2.

1 (Recess.)

2 THE VIDEOGRAPHER: The time is 12:10. We  
3 are back on the record. This will be the start of  
4 Media Unit Number 3.

5 THE INTERPRETER: "175. Are you aware  
6 that after the Second Circuit issued its decision,  
7 the District Court did dismiss all of Cubatabaco's  
8 remaining claims in the federal action?"

9 "Objection. Petitioner instructs  
10 witness not to answer to the extent her  
11 understanding is based on confidential  
12 communications, including reports made by any  
13 employee of Cubatabaco or Habanos of confidential  
14 communications, related to either legal services or  
15 an opinion on law or assistance in some legal  
16 proceeding, in which any legal counsel for  
17 Cubatabaco or Habanos, S.A., whether in-house or  
18 outside counsel, (legal counsel), (A) was a party to  
19 the communications; or (B) was present during the  
20 communication. Otherwise, witness may answer the  
21 question."

22 THE WITNESS: I don't know that  
23 information.

24 THE INTERPRETER: "176. Are you aware  
25 that Cubatabaco sought review of the Second



1 Circuit's decision from the United States Supreme  
2 Court through a petition for writ of certiorari?"

3 THE WITNESS: I don't know that  
4 information.

5 THE INTERPRETER: "177. Are you aware  
6 that the United States Supreme Court denied the  
7 petition for writ of certiorari?"

8 THE WITNESS: I don't know that.

9 THE INTERPRETER: "178-A. Do you have any  
10 understanding of the effect of the United States  
11 Supreme Court's denial of a petition for writ of  
12 certiorari on the decision of the appellate court  
13 below?"

14 "Objection. Petitioner instructs the  
15 witness not to answer to the extent her  
16 understanding is based on confidential  
17 communications, including reports made by any  
18 employee of Cubatabaco or Habanos of confidential  
19 communications, related to either legal services or  
20 an opinion on law or assistance in some legal  
21 proceeding, in which any legal counsel for  
22 Cubatabaco or Habanos, S.A., whether in-house or  
23 outside counsel, (legal counsel), (A) was a party to  
24 the communications; or (B) was present during the  
25 communication. Otherwise, witness may answer the

1 question."

2 THE WITNESS: I don't have that  
3 information.

4 THE INTERPRETER: "178-B. What is that  
5 understanding?"

6 "Objection. Petitioner instructs  
7 witness not to answer to the extent her  
8 understanding is based on confidential  
9 communications, including reports made by any  
10 employee of Cubatabaco or Habanos of confidential  
11 communications, related to either legal services or  
12 an opinion on law or assistance in some legal  
13 proceeding, in which any legal counsel for  
14 Cubatabaco or Habanos, S.A., whether in-house or  
15 outside counsel, (legal counsel), (A) was a party to  
16 the communications; or (B) was present during the  
17 communication. Otherwise, witness may answer the  
18 question."

19 THE WITNESS: No, I don't have any  
20 understanding in regards to that.

21 THE INTERPRETER: "178-C. Are you aware  
22 that the effect of the United States Supreme Court's  
23 denial of Cubatabaco's petition for writ of  
24 certiorari was to leave the Second Circuit decision  
25 as a final decision?"

1                   "Objection. Petitioner instructs  
2     witness not to answer to the extent her  
3     understanding is based on confidential  
4     communications, including reports made by any  
5     employee of Cubatabaco or Habanos of confidential  
6     communications, related to either legal services or  
7     an opinion on law or assistance in some legal  
8     proceeding, in which any legal counsel for  
9     Cubatabaco or Habanos, S.A., whether in-house or  
10    outside counsel, (legal counsel), (A) was a party to  
11    the communications; or (B) was present during the  
12    communication. Otherwise, witness may answer the  
13    question."

14                THE WITNESS: I don't know that  
15    information.

16                THE INTERPRETER: "179. In this  
17    cancellation proceeding, isn't it true that  
18    Cubatabaco seeks to cancel two United States  
19    trademark registrations granted to General Cigar for  
20    the mark 'Cohiba' for cigars?"

21                THE WITNESS: Yes, it is true.

22                THE INTERPRETER: "180. In this  
23    cancellation proceeding, Cubatabaco is not seeking  
24    to cancel any design mark registration owned by  
25    General Cigar, correct?"

1 THE WITNESS: I'm not very sure. I don't  
2 believe so, but I'm not very sure.

3 THE INTERPRETER: "181. Paragraph 28-D of  
4 your declaration references an opposition proceeding  
5 that Cubatabaco brought against Khachaturian, Kris 1  
6 in the U.S. Trademark Trial and Appeal Board of the  
7 USPTO, under Opposition Number 91157163, correct?"

8 THE WITNESS: Correct.

9 THE INTERPRETER: "182. In the  
10 Khachaturian opposition proceeding, the applicant  
11 was not seeking to register a mark incorporating the  
12 word 'Cohiba,' correct?"

13 THE WITNESS: Correct.

14 MR. GALLASTEGUI: Let's skip to Question  
15 191.

16 THE INTERPRETER: "191. Isn't it correct  
17 that the Khachaturian opposition proceeding did not  
18 involve any rights in the United States Cohiba word  
19 mark?"

20 THE WITNESS: I'm sorry. Word mark?  
21 "Cohiba" in the United States? May the question be  
22 repeated.

23 (Interpreter reread question to the witness.)

24 THE WITNESS: No. No.

25 THE INTERPRETER: "192. Paragraph 28-E of

1 your declaration references an opposition proceeding  
2 that Cubatabaco brought against Reel Smokers Cigar  
3 Distributors in the U.S. Trademark Trial and Appeal  
4 Board of the USPTO, under the Opposition Number  
5 91158932, correct?"

6 THE WITNESS: Correct.

7 THE INTERPRETER: "193. In the Reel  
8 opposition proceeding, the applicant was not seeking  
9 to register a mark incorporating the word 'Cohiba,'  
10 correct?"

11 THE WITNESS: Correct.

12 MR. GALLASTEGUI: Let's please mark  
13 Exhibit 16, and I move to --

14 MR. FRANK: Wait. Her answer was  
15 "correct."

16 MR. GALLASTEGUI: Yeah, that's right. So  
17 then let's not mark Exhibit 16, and just move to  
18 Question 202, please.

19 THE REPORTER: So for now, we skipped  
20 Exhibits 15 and 16, right?

21 MR. FRANK: Some exhibits may not be  
22 introduced.

23 MR. GALLASTEGUI: Yeah, 15 and 16, we  
24 skipped them.

25 THE INTERPRETER: So we continue?

1 MR. GALLASTEGUI: Yes, with 202, please.

2 THE INTERPRETER: "202. Isn't it correct  
3 that the Reel opposition proceeding did not involve  
4 the Cohiba word mark in any way?"

5 THE WITNESS: No, it did not involve that.

6 THE INTERPRETER: "203. Paragraph 28-F of  
7 your declaration references an opposition proceeding  
8 that Cubatabaco brought against Anthony P. Serino in  
9 the U.S. Trademark Trial and Appeals Board of the  
10 USPTO, under Opposition Number 91164141, correct?"

11 THE WITNESS: Correct.

12 THE INTERPRETER: "204. In the Serino  
13 opposition proceeding, the applicant was not seeking  
14 to register a mark incorporating the word 'Cohiba,'  
15 correct?"

16 THE WITNESS: Correct.

17 MR. GALLASTEGUI: Let's skip to Question  
18 214, please.

19 THE INTERPRETER: "214. Isn't it correct  
20 that the Serino opposition proceeding did not  
21 involve any rights in the United States Cohiba word  
22 mark?"

23 THE WITNESS: It doesn't have to do with  
24 the word mark Cohiba.

25 THE INTERPRETER: "215. Paragraph 28-G of

1 your declaration references a federal trademark  
2 litigation that Cubatabaco brought against Santa  
3 Clara Cigar Manufacturer, Inc., a/k/a STC Cigar  
4 Manufacturers, Inc., correct?"

5 THE WITNESS: Correct.

6 THE INTERPRETER: "216. In the Santa  
7 Clara litigation, the defendant was not using a mark  
8 incorporating the word 'Cohiba,' correct?"

9 THE WITNESS: Correct.

10 MR. GALLASTEGUI: Then we'll go to  
11 Question 225.

12 THE INTERPRETER: "225. Paragraph 28-H of  
13 your declaration references an opposition proceeding  
14 that Cubatabaco brought against Kretek  
15 International, Incorporated in the U.S. Trademark  
16 Trial and Appeal Board of the USPTO, under  
17 Opposition Number 91237938, correct?"

18 THE WITNESS: Correct.

19 THE INTERPRETER: "226. In the Kretek  
20 opposition proceeding, the applicant was not seeking  
21 to register a mark incorporating the word 'Cohiba,'  
22 correct?"

23 THE WITNESS: Correct.

24 MR. GALLASTEGUI: Then we should skip to  
25 Question 240, please.

1           THE INTERPRETER: "240. Isn't it correct  
2     that the Kretek opposition proceeding did not  
3     involve the United States 'Cohiba' word mark in any  
4     way?"

5           THE WITNESS: It is correct.

6           MR. FRANK: We're done with the  
7     cross-examination questions, and we can take a break  
8     now, or if you would prefer, we can continue. It's  
9     up to you.

10          THE WITNESS: (In English:) It's up to me?

11          MR. FRANK: Yeah.

12          THE WITNESS: (In English:) I prefer until  
13     1:00 o'clock.

14          MR. GALLASTEGUI: Whatever you say.

15          MR. FRANK: We can go off the record.

16          THE VIDEOGRAPHER: The time is 12:34. We  
17     are going off the record.

18                 (Discussion off the record.)

19          THE VIDEOGRAPHER: The time is 1:54. We  
20     are back on the record.

21          THE INTERPRETER: Should I start reading?

22          MR. FRANK: Yeah, you can start with the  
23     redirect examination questions.

24

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REDIRECT EXAMINATION

THE INTERPRETER: "Redirect Examination by  
written questions of Lisset Fernandez Garcia.

"Please turn to Exhibit 1 that  
Respondent has introduced today.

"Number 1. Do you recall Respondent  
asking you questions about your declaration that  
Respondent has marked as Exhibit 1?"

THE WITNESS: Yes.

THE INTERPRETER: "2-A. Do you know how  
this declaration was prepared?"

THE WITNESS: Yes, as I've already said  
before, a draft was prepared by the attorneys, and  
then it was reviewed, there was some exchanges with  
them, some things were modified, and I reviewed the  
final draft, I approved it, and I signed it.

THE INTERPRETER: "2-B. If your answer to  
Question 2-A was yes, was there any draft or drafts  
of your declaration prior to your signing this  
declaration?"

"Objection."

THE WITNESS: Yes, there were drafts.

THE INTERPRETER: "2-C. If your answer to  
Question 2-A was yes, at any point did counsel  
provide you with a draft of your declaration, in

1 whole or in part?"

2 "Objection."

3 THE WITNESS: Yes, the attorneys provided  
4 me with a draft.

5 THE INTERPRETER: "3. If your answer to  
6 Question 2 was yes, did you have any communications  
7 with counsel concerning your declaration prior to  
8 receiving a draft of your declaration from counsel?"

9 "Objection."

10 THE WITNESS: Yes, there was some  
11 exchanges with the attorney, yes, before receiving  
12 the draft.

13 THE INTERPRETER: "4. If your answer to  
14 Question 2 was yes to receiving a draft, after  
15 receiving a draft of your declaration from counsel,  
16 did you modify it in any way?"

17 "Objection."

18 THE WITNESS: Yes, it was modified in some  
19 way, the draft that I received.

20 THE INTERPRETER: "6. If your answer is  
21 yes to receiving a draft after receiving a draft of  
22 your declaration from counsel, did you have any  
23 communications with counsel?"

24 "Objection."

25 MR. GALLASTEGUI: I think you skipped 5.

1 THE INTERPRETER: Did I?

2 MR. GALLASTEGUI: Yeah.

3 THE INTERPRETER: I'm so sorry.

4 "5. If your answer is yes to  
5 receiving a draft, after receiving a draft of your  
6 declaration from counsel, did you modify it in any  
7 way?"

8 "Objection."

9 THE WITNESS: Yes, I did modify the draft  
10 that I received.

11 THE INTERPRETER: "6. If your answer is  
12 yes to receiving a draft, after receiving a draft of  
13 your declaration from counsel, did you have any  
14 communications with counsel?"

15 "Objection."

16 THE WITNESS: Yes, I did have  
17 communications with the attorney.

18 THE INTERPRETER: "7. If your answer to  
19 the previous question was yes, were there more than  
20 one communication with counsel about the draft of  
21 your declaration?"

22 "Objection."

23 THE WITNESS: Yes.

24 THE INTERPRETER: "8. If your answer was  
25 that you had communications with counsel after

1 receiving a draft of your declaration from counsel,  
2 was the draft of your declaration modified in any  
3 way after the communications?"

4 "Objection."

5 THE WITNESS: It was modified to the  
6 extent that I requested it.

7 THE INTERPRETER: "9. Before signing your  
8 declaration, did you review each and every statement  
9 contained in the draft of your declaration?"

10 "Objection."

11 THE WITNESS: Yes.

12 THE INTERPRETER: "10. Did you review  
13 each and every statement in the draft of your  
14 declaration carefully?"

15 "Objection."

16 THE WITNESS: Yes.

17 THE INTERPRETER: "11. Did you believe  
18 that the draft of your declaration stated the facts  
19 accurately and honestly?"

20 "Objection."

21 THE WITNESS: Yes.

22 THE INTERPRETER: "12. Did you believe  
23 that the draft of your declaration accurately  
24 represented your knowledge?"

25 "Objection."

1 THE WITNESS: Yes.

2 THE INTERPRETER: "13. Is each and every  
3 statement in your declaration true and correct to  
4 the best of your knowledge?"

5 THE WITNESS: Yes, that's right.

6 THE INTERPRETER: "14. Did you adopt or  
7 subscribe the draft of your dec-" --

8 MR. FRANK: It says "adopt and subscribe."

9 THE INTERPRETER: Did I not say that?  
10 "Did you adopt and subscribe the  
11 draft of your declaration as your own statement?"

12 "Objection."

13 THE WITNESS: Yes.

14 THE INTERPRETER: "15. Prior to signing  
15 your declaration, did you do anything in connection  
16 with the statements in your declaration about the  
17 period prior to your employment at Habanos, S.A.?"

18 "Objection."

19 THE WITNESS: Yeah, I reviewed the records  
20 and the files that I have in my possession from the  
21 Legal Department, from the Legal Direction  
22 Department of Habanos, S.A.

23 THE INTERPRETER: One second. I'm sorry.  
24 "Direction's Department," apostrophe S.

25 "16. If your answer to the preceding

1 question was yes, what did that consist of?"

2 "Objection."

3 THE WITNESS: As I said before, yes, I  
4 reviewed the files with the documentation related to  
5 this case, the files that the Legal Department has,  
6 the direction of the Legal Department, that they  
7 have.

8 THE INTERPRETER: This is the interpreter.  
9 I just want to -- because instead of saying "general  
10 counsel," I'm trying to then apply it to the Legal  
11 Direction Department that we have. I'm just making  
12 that note as to, could be "General Counsel's  
13 Office."

14 We can proceed.

15 "17. Omitted."

16 "18. Did you believe that these  
17 preparations gave you an adequate basis for your  
18 statements that concern the period prior to your  
19 employment at Habanos, S.A.?"

20 "Objection."

21 THE WITNESS: Yes, as far as I understand,  
22 yes.

23 THE INTERPRETER: "19. If your answer to  
24 the preceding question was yes, why?"

25 THE WITNESS: Yes, because it allowed me

1 to have knowledge about what I testified to.

2 THE INTERPRETER: "20. Did you believe  
3 that your statements that concerned the period prior  
4 to your employment at Habanos, S.A. are true and  
5 accurate?"

6 "Objection."

7 THE WITNESS: Yes.

8 THE INTERPRETER: "21. If your answer to  
9 the preceding question was yes, why?"

10 THE WITNESS: Yes, because it is truthful  
11 to what I was able to verify in my files.

12 THE INTERPRETER: "22-A. Do you recall  
13 Respondent's counsel asking you questions concerning  
14 United States Trademark Registration Number  
15 2,145,804 that you referenced in paragraph 10 of  
16 your declaration?"

17 THE WITNESS: Yes.

18 THE INTERPRETER: "22-B. Are you familiar  
19 with the trademark registered under United States  
20 Trademark Registration Number 2,145,804?"

21 "Objection."

22 THE WITNESS: Yes.

23 THE INTERPRETER: "23. To your knowledge,  
24 is the design mark registered as United States  
25 Trademark Registration Number 2,145,804 associated

1 with the Cuban Cohiba cigar?"

2 "Objection."

3 THE WITNESS: Yes.

4 THE INTERPRETER: "24. If your answer to  
5 the preceding question was yes, what is your  
6 understanding of the association?"

7 "Objection."

8 THE WITNESS: Because the design that the  
9 Cohiba trademark uses has the attributes, the colors  
10 and the design of the Cuban Cohiba trademark.

11 THE INTERPRETER: "25-A. Do you recall  
12 Respondent's counsel asking you questions concerning  
13 United States Trademark Registration Number  
14 4,988,587 that you referenced in paragraph 10 of  
15 your declaration?"

16 THE WITNESS: Yes.

17 THE INTERPRETER: "25-B. Are you familiar  
18 with the trademark registered under United States  
19 Trademark Registration Number 4,988,587?"

20 "Objection."

21 THE WITNESS: Yes.

22 THE INTERPRETER: "To your knowledge, is  
23 the design mark registered as United States  
24 Trademark Registration Number 4,988,587 associated  
25 with the Cuban Cohiba cigar?"



1 "Objection."

2 THE WITNESS: Yes.

3 THE INTERPRETER: "27. If your answer to  
4 the preceding question was yes, what is your  
5 understanding of the association?"

6 "Objection."

7 THE WITNESS: So in this case, it's talked  
8 about the Behike register.

9 THE REPORTER: The what?

10 THE INTERPRETER: "Behike." Can we state  
11 that for the record?

12 MR. GALLASTEGUI: Yeah, it's a proper  
13 name, right?

14 THE INTERPRETER: Yeah.

15 MR. GALLASTEGUI: Yeah, please do. Spell  
16 it. It's okay.

17 THE INTERPRETER: B-e-h-i-k-e.

18 THE WITNESS: Behike is a line of the  
19 Cohiba mark and uses the same attributes and design,  
20 like everything, the design of the Cohiba trademark.

21 THE INTERPRETER: "28-A. Do you recall  
22 Respondent's counsel asking you questions concerning  
23 United States Trademark Registration Number  
24 1,557,168 that you referenced in paragraph 10 of  
25 your declaration?"

1 THE WITNESS: Yes.

2 THE INTERPRETER: "28-B. Are you familiar  
3 with the trademark registered under United States  
4 Trademark Registration Number 1,557,163?"

5 "Objection."

6 THE WITNESS: Yes.

7 THE INTERPRETER: "29. To your knowledge,  
8 is the design mark registered as United States  
9 Trademark Registration Number 1,557,163 associated  
10 with the Cuban Cohiba cigar?"

11 "Objection."

12 THE WITNESS: Yes.

13 THE INTERPRETER: "30. If your answer to  
14 the preceding question was yes, what is your  
15 understanding of the association?"

16 "Objection."

17 There's one thing I would like to  
18 clarify. When the witness is say saying "registro,"  
19 so I'm guessing if it's registered by such, I know  
20 that you cannot comment upon it many things, but the  
21 registration is the trademark registration. Can I  
22 confer with the witness? I cannot?

23 MR. FRANK: Just translate to the best of  
24 your ability.

25 THE WITNESS: So the register that this

1 question is referencing to corresponds to a vitola  
2 from the Cohiba trademark. And it has the same  
3 attributes of the design of the Cohiba trademark.  
4 So I'm saying, the head of the Indian, like the  
5 design, and the colors, the pattern.

6 THE INTERPRETER: "31-A. Do you recall  
7 Respondent's counsel asking you questions concerning  
8 United States Trademark Registration Number  
9 3,402,158 that you referenced in paragraph 10 of  
10 your declaration?"

11 THE WITNESS: Yes.

12 THE INTERPRETER: "31-B. Are you familiar  
13 with the trademark registered under the United  
14 States Trademark Registration Number 3,402,158?"

15 "Objection."

16 THE WITNESS: Yes.

17 THE INTERPRETER: "32. To your knowledge,  
18 is the design mark registered as United States  
19 Trademark Registration Number 3,402,158 associated  
20 with the Cuban Cohiba cigar?"

21 "Objection."

22 THE WITNESS: Yes, it is associated.

23 THE INTERPRETER: "33. If your answer to  
24 the preceding question was yes, what is your  
25 understanding of the association?"

1 "Objection."

2 THE WITNESS: Yes, in this case, as the  
3 ones before, the registration of this mark has the  
4 design, so in other words, the attributes and colors  
5 of the design mark of Cohiba, Cuban Cohiba.

6 THE INTERPRETER: "33. No, 34. 34-A.

7 "Do you recall Respondent's counsel  
8 asking you questions concerning United States  
9 Trademark Registration Number 4,244,461 that you  
10 referenced in paragraph 10 of your declaration?"

11 THE WITNESS: Yes.

12 THE INTERPRETER: "34-B. Are you familiar  
13 with the trademark registered under United States  
14 Trademark Registration Number 4,244,461?"

15 "Objection."

16 THE WITNESS: Yes.

17 THE INTERPRETER: "35. To your knowledge,  
18 is the design mark registered as United States  
19 Trademark Registration Number 4,244,461 associated  
20 with the Cuban Cohiba cigar?"

21 "Objection."

22 THE WITNESS: Yes.

23 THE INTERPRETER: "36. If your answer to  
24 the preceding question was yes, what is your  
25 understanding of the association?"

1 "Objection."

2 Gentlemen, should I stop at that or  
3 should I keep reading after the objection?

4 MR. FRANK: You can stop there and wait  
5 for the answer.

6 Do you agree?

7 MR. GALLASTEGUI: Yeah.

8 THE INTERPRETER: So I said "objection" in  
9 Spanish.

10 THE WITNESS: As the ones before, this  
11 one, too, uses the same attributes, colors of the  
12 Cuban Cohiba mark. In addition to being a vitola of  
13 the Cohiba mark.

14 THE INTERPRETER: "Please turn to  
15 paragraph 28-D of your declaration.

16 "37. Do you recall that Respondent  
17 asked you questions about an opposition proceeding  
18 that Cubatabaco brought against Khachaturian, Kris 1  
19 in the U.S. Trademark Trial and Appeal Board of  
20 USPTO under Opposition Number 91157163?"

21 THE WITNESS: Yes.

22 (Petitioner's Exhibit 1 was marked for  
23 identification by the court reporter.)

24 THE INTERPRETER: "38. The document that  
25 has just been marked Petitioner's Exhibit 1 is a

1 true and correct copy of Cubatabaco's Notice of  
2 Opposition filed on July 11, 2003 with the Trademark  
3 Trial and Appeals board of the USPTO in its  
4 opposition proceeding against Khachaturian, Kris 1.

5 "Please review the document marked  
6 Petitioner's Exhibit 1. Is it correct that  
7 Cubatabaco filed this Notice of Opposition in the  
8 Khachaturian opposition proceeding?"

9 THE WITNESS: Correct.

10 THE INTERPRETER: "39. Can you please  
11 review paragraph 1 of the Notice of Opposition in  
12 the Khachaturian opposition proceeding?"

13 THE WITNESS: Yes.

14 THE INTERPRETER: "40. Does it include an  
15 image of a design mark that the applicant,  
16 Khachaturian, Kris I, applied for?"

17 "Objection."

18 I'm sorry, one more time: Is it "I?"  
19 Is it "1"? Because I'm trying to ascertain. Can I  
20 have that information? Is it possible?

21 MR. FRANK: It looks like it's an "I" to  
22 me.

23 THE INTERPRETER: It looks like an "I."  
24 I'm trying to assess what it is.

25 Thank you very much.

1 MR. GALLASTEGUI: I don't know.

2 THE INTERPRETER: I'll repeat it.

3 "40. Does it include an image of a  
4 design mark that the applicant, Khachaturian, Kris  
5 I., applied for?"

6 "Objection."

7 THE WITNESS: Yes, it does include it.

8 THE INTERPRETER: "41. Does that design  
9 mark look like any design mark used in connection  
10 with the Cuban Cohiba cigar?"

11 "Objection."

12 THE WITNESS: It's the same Indian head  
13 that the Cohiba design mark uses; that it is  
14 contained in the Cohiba design mark.

15 THE INTERPRETER: "Please turn to page  
16 28-E of your declaration."

17 MR. FRANK: Paragraph 28-E.

18 THE INTERPRETER: "Please turn to  
19 paragraph 28-E of your declaration.

20 "42. Do you recall that Respondent  
21 asked you questions about an opposition proceeding  
22 that Cubatabaco brought against Reel Smokers Cigar  
23 distributors in the U.S. trademark Trial and Appeal  
24 Board of the USPTO under the Opposition Number  
25 91158932?"

1 THE WITNESS: Yes.

2 (Petitioner's Exhibit 2 was marked for  
3 identification by the court reporter.)

4 THE INTERPRETER: "43. The document that  
5 has just been marked Petitioner's Exhibit 2 is a  
6 true and correct copy of Cubatabaco's Notice of  
7 Opposition filed on December 19, 2003 with the  
8 Trademark Trial and Appeal Board of the USPTO in its  
9 opposition proceeding against Reel Smokers Cigar  
10 Distributors. Please review the document marked  
11 Petitioner's Exhibit 2.

12 "Is it correct that Cubatabaco filed  
13 this notice of opposition in the Reel opposition  
14 proceeding?"

15 THE WITNESS: Yes, correct.

16 THE INTERPRETER: "44. Can you please  
17 review paragraphs 1 and 2 of the Notice of  
18 Opposition in the Reel opposition proceeding?"

19 THE WITNESS: Yes.

20 THE INTERPRETER: "45. Do they include  
21 images of a design mark that the applicant, Reel  
22 Smokers Cigar Distributors, applied for?"

23 "Objection."

24 THE WITNESS: Yes.

25 THE INTERPRETER: "46. Does the



1 applied-for design mark look like any design mark  
2 used in connection with the Cuban Cohiba cigar?"

3 "Objection."

4 THE WITNESS: Yes, it does look like it.

5 THE INTERPRETER: "Please turn to  
6 paragraph 28-F of your declaration.

7 "47. Do you recall that Respondent  
8 asked you questions about an opposition proceeding  
9 that Cubatabaco brought against Anthony P. Serino in  
10 the U.S. Trademark Trial and Appeal Board of the  
11 USPTO, under Opposition 91164141?

12 THE WITNESS: Yes.

13 (Petitioner's Exhibit 3 was marked for  
14 identification by the court reporter.)

15 THE INTERPRETER: "48. The document that  
16 has just been marked Petitioner's Exhibit 3 is a  
17 true and correct copy of Cubatabaco's Notice of  
18 Opposition filed on February 9, 2005 with the  
19 Trademark Trial and Appeal Board of the USPTO in its  
20 opposition proceeding against Anthony P. Serino.  
21 Please review the document marked Petitioner's  
22 Exhibit 3.

23 "Is it correct that Cubatabaco filed  
24 this Notice of Opposition in the Serino opposition  
25 proceeding?"

1 THE WITNESS: Correct.

2 THE INTERPRETER: "49. Can you please  
3 review paragraph 2 of the Notice of Opposition in  
4 the Serino opposition proceeding?"

5 THE WITNESS: Yes.

6 THE INTERPRETER: "50. Does it include an  
7 image of a design mark that the applicant, Anthony  
8 P. Serino, applied for?"

9 "Objection."

10 THE WITNESS: Yes.

11 THE INTERPRETER: "51. Does the  
12 applied-for design mark look like any design mark  
13 used in connection with the Cuban Cohiba cigar?"

14 "Objection."

15 THE WITNESS: Yes, it does look like it.

16 THE INTERPRETER: "52. Please turn to  
17 paragraph 4. Do the images shown there appear to be  
18 the Cohiba design marks that Cubatabaco has  
19 registered with the USPTO and having registration  
20 numbers 1,557,163, and 2,145,804?"

21 "Objection."

22 THE WITNESS: Yes, they are.

23 THE INTERPRETER: "Please turn to  
24 paragraph 28-H of your declaration.

25 "53. Do you recall that Respondent

1 asked you questions about an opposition proceeding  
2 that Cubatabaco brought against Kretek  
3 International, Inc. in the U.S. Trademark Trial and  
4 Appeal Board of the USPTO under Opposition  
5 91237938?"

6 THE WITNESS: Yes, but I need to go to the  
7 restroom.

8 THE VIDEOGRAPHER: Stand by. The time is  
9 2:45. We are going off the record. This will end  
10 Media Unit Number 3.

11 (Recess.)

12 THE VIDEOGRAPHER: The time is 2:58. We  
13 are back on the record. This will be the start of  
14 Media Unit Number 4.

15 THE INTERPRETER: Where were we?

16 MR. FRANK: I think we're on 54.

17 MR. GALLASTEGUI: Ruben, could you please  
18 mark Exhibit 4.

19 (Petitioner's Exhibit 4 was marked for  
20 identification by the court reporter.)

21 THE INTERPRETER: "54. The document that  
22 has just been marked Petitioner's Exhibit 4 is a  
23 true and correct copy of Cubatabaco's Notice of  
24 Opposition filed on November 21, 2017 with the  
25 Trademark Trial and Appeal Board of the USPTO in its

1 opposition proceeding against Kretek International,  
2 Inc. Please review the document marked Petitioner's  
3 Exhibit 4.

4 "Is it correct that Cubatabaco filed  
5 this Notice of Opposition in the Kretek opposition  
6 proceeding?"

7 THE WITNESS: Correct.

8 THE INTERPRETER: "55. Can you please  
9 review paragraph 16 of the Notice of Opposition?"

10 THE WITNESS: Yes.

11 THE INTERPRETER: "56. Does the  
12 applied-for design mark look like any design mark  
13 used in connection with the Cuban Cohiba cigar?"

14 "Objection."

15 THE REPORTER: I think you read 57 instead  
16 of 56.

17 THE INTERPRETER: I skipped it. Thank  
18 you.

19 "56. Does it include an image of a  
20 design mark that the applicant, Kretek  
21 International, Inc., applied for?"

22 "Objection."

23 THE WITNESS: Yes.

24 THE INTERPRETER: "57. Does the  
25 applied-for design mark look like any design mark

1       used in connection with the Cuban Cohiba cigar?"

2                       "Objection."

3               THE WITNESS:   Yes, it looks like it.

4               THE INTERPRETER:  "Please turn to  
5       paragraph 28-G of your declaration.

6                       "58.  Do you recall that Respondent's  
7       counsel asked you questions about a federal  
8       trademark litigation that Cubatabaco brought against  
9       Santa Clara Cigar Manufacturer, Inc., a/k/a STC  
10      Cigar Manufacturers, Inc.?"

11              THE WITNESS:   Yes.

12              THE REPORTER:  Here's Petitioner's 5.

13                       (Petitioner's Exhibit 5 was marked for  
14                       identification by the court reporter.)

15              THE INTERPRETER:  "59.  The document that  
16      has just been marked Petitioner's Exhibit 5 is a  
17      true and correct copy of Cubatabaco's Complaint for  
18      Trademark Infringement filed on May 26, 2005 in the  
19      Southern District of New York against Santa Clara  
20      Cigar Manufacturer, Inc., a/k/a STC Cigar  
21      Manufacturers, Inc.

22                       "Please review the document marked  
23      Petitioner's Exhibit 5.  Is it correct that  
24      Cubatabaco filed this complaint?"

25              THE WITNESS:   Correct.

1 THE INTERPRETER: "60. Can you please  
2 review paragraph 13 of the complaint?"

3 THE WITNESS: Yes.

4 THE INTERPRETER: "61. Does it include  
5 images of a design mark that the defendant, Santa  
6 Clara Cigar Manufacturer, Inc., a/k/a STC Cigar  
7 Manufacturers, Inc., ('Santa Clara Cigar'), was  
8 selling in the United States?"

9 "Objection."

10 THE WITNESS: Yes.

11 THE INTERPRETER: "62. Does the design  
12 mark that Santa Clara cigar used look like any  
13 design mark used in connection with the Cuban Cohiba  
14 cigar?"

15 "Objection."

16 THE WITNESS: Yes, they use the same  
17 designs and colors.

18 THE INTERPRETER: Should I continue  
19 reading?

20 MR. GALLASTEGUI: Yes, please.

21 MR. FRANK: Yes.

22

23 RECROSS-EXAMINATION

24 THE INTERPRETER: "Recross-examination by  
25 written questions of Lisset Fernandez Garcia."

1                   "Number 1. Do you recall that the  
2     redirect questions posed by Cubatabaco's attorney  
3     referred you to Cubatabaco's United States Trademark  
4     Registration Number 2,145,804?"

5                   THE WITNESS: Yes.

6                   THE INTERPRETER: "2. Do you recall that  
7     the redirect questions posed by Cubatabaco's  
8     attorney asked you questions about Cubatabaco's  
9     United States Trademark Registration Number  
10    2,145,804?"

11                  THE WITNESS: Yes.

12                  THE INTERPRETER: "Please review the  
13    document that has previously been marked  
14    Respondent's Exhibit 4. This exhibit is  
15    Cubatabaco's United States Trademark Registration  
16    Number 2,145,804, correct?"

17                  THE WITNESS: Correct.

18                  THE REPORTER: Respondent's 20.

19                   (Respondent's Exhibit 20 was marked  
20                   for identification by the court  
21                   reporter.)

22                  THE INTERPRETER: "4. The document that  
23    has just been marked Respondent's Exhibit 20 is a  
24    true and correct copy of Cubatabaco's Amended  
25    Petition in the instant cancellation proceeding.

1                   "Isn't it true that Cubatabaco does  
2 not assert any claims in the instant cancellation  
3 proceeding for cancellation of General Cigar's two  
4 United States trademark registrations for Cohiba  
5 based on similarity to Cubatabaco's design mark  
6 identified in Cubatabaco's United States Trademark  
7 Registration Number 2,145,804?"

8                   "Objection."

9                   THE WITNESS: It is true.

10                  MR. GALLASTEGUI: Next is 6.

11                  THE INTERPRETER: "6. Please turn to the  
12 document previously marked Respondent's Exhibit 4.  
13 Do you see the text below the image of the mark,  
14 which starts on the bottom left of the page and  
15 continues onto the top right of the page, which  
16 states: 'The mark is lined for the color gold. The  
17 boldly lined section of the drawing, however, does  
18 not indicate color, but it is a feature of the  
19 mark'?"

20                  THE WITNESS: Yes.

21                  THE INTERPRETER: "7. Please turn to the  
22 documents previously marked Respondent's Exhibit 2  
23 and 3.

24                         "Do you recall that these exhibits  
25 were previously identified as General Cigar's United



1 States Registration Numbers 1,147,309, and 1,898,273  
2 for the trademark Cohiba, which are the  
3 registrations that Cubatabaco seeks to cancel in the  
4 instant cancellation action obtained from the  
5 USPTO's website at [www.uspto.gov](http://www.uspto.gov)?"

6 THE WITNESS: Yes.

7 THE INTERPRETER: "8. Do either of  
8 General Cigar's registrations for the Cohiba  
9 trademark as set forth on the documents marked  
10 Respondent's Exhibits 2 and 3 have as an element or  
11 feature of the mark the color gold?"

12 THE WITNESS: No.

13 THE INTERPRETER: "9. On the document  
14 marked Respondent's Exhibit 4, do you see the text  
15 on the middle right-hand side of the page that  
16 states: 'The mark consists of a rectangular design  
17 with rounded corners, a gold outline, the silhouette  
18 of a head of an Indian against a black-and-white  
19 dotted background, a white rectangle and a gold  
20 rectangle'?"

21 THE WITNESS: Yes.

22 THE INTERPRETER: "10. Do either of  
23 General Cigar's registrations for the Cohiba  
24 trademark as set forth on the documents marked  
25 Respondent's Exhibits 2 and 3 have as an element or

1 feature of the marks a rectangular design with  
2 rounded corners?"

3 THE WITNESS: No.

4 THE INTERPRETER: "11. Do either of  
5 General Cigar's registration for the Cohiba  
6 trademark as set forth in the documents marked  
7 Respondent's Exhibit 2 and 3 have as an element or  
8 feature of the marks a gold outline?"

9 THE WITNESS: No.

10 THE INTERPRETER: "12. Do either of  
11 General Cigar's registrations for the Cohiba  
12 trademark as set forth on the documents marked  
13 Respondent's Exhibit 2 and 3 have as an element or  
14 feature of the mark a silhouette of a head of an  
15 Indian with a black-and-white dotted background?"

16 THE WITNESS: No.

17 THE INTERPRETER: "13. Do either of  
18 General Cigar's registrations for the Cohiba  
19 trademark as set forth on the documents marked  
20 Respondent's Exhibit 2 and 3 have as an element or  
21 feature of the mark a white rectangle and a gold  
22 rectangle?"

23 THE WITNESS: No.

24 THE INTERPRETER: "14. Do you recall that  
25 the redirect questions posed by Cubatabaco's

1 attorney referred you to the Cubatabaco's United  
2 States Trademark Registration Number 4,988,587?"

3 THE WITNESS: Yes.

4 THE INTERPRETER: "15. Do you recall that  
5 the redirect questions posed by Cubatabaco's  
6 attorney asked you questions about Cubatabaco's  
7 United States Trademark Registration Number  
8 4,988,587?"

9 THE WITNESS: Yes.

10 THE INTERPRETER: "16. Please review the  
11 document that has previously been marked  
12 Respondent's Exhibit 5. This exhibit is  
13 Cubatabaco's United States Trademark Registration  
14 Number 4,988,587, correct?"

15 THE WITNESS: Correct.

16 THE INTERPRETER: "17. Please turn back  
17 to the document marked Respondent's Exhibit 20,  
18 which is the Cubatabaco's amended petition in the  
19 instant cancellation proceeding.

20 "Isn't it true that Cubatabaco does  
21 not assert any claims in the instant cancellation  
22 proceeding for cancellation of General Cigar's two  
23 United States trademark registrations for Cohiba,  
24 which are the registrations set forth in the  
25 documents marked Exhibit 2 and 3, based on

1 Cubatabaco's design mark identified in Cubatabaco's  
2 United States Trademark Registration Number  
3 4,988,587?"

4 "Objection."

5 THE WITNESS: It's true, it's not based on  
6 that registration.

7 THE INTERPRETER: Okay. Where are we  
8 going?

9 MR. GALLASTEGUI: We're going to Question  
10 19.

11 THE INTERPRETER: "Please turn to the  
12 document previously marked Respondent's Exhibit 5.  
13 Do you see the text below the image of the mark,  
14 which starts on the bottom left of the page and  
15 continues on to the top right of the page, and which  
16 states: 'The mark consists of a silhouette of a head  
17 with a ponytail in profile'?"

18 THE WITNESS: Yes.

19 THE INTERPRETER: "20. Please turn back  
20 to the documents marked Respondent's Exhibit 2 and  
21 3. Do either of General Cigar's registrations for  
22 the Cohiba trademarks as set forth in Exhibits 2 and  
23 3 have as an element or feature of the mark a  
24 silhouette of a head with a ponytail in profile?"

25 THE WITNESS: Yes. No. So the question

1 is, if I see in the registrations? Better yet, can  
2 you repeat the question?

3 (Interpreter read question to witness.)

4 THE WITNESS: Oh, I remember now. No.

5 THE INTERPRETER: "21. Do you recall that  
6 the redirect questions posed by Cubatabaco's  
7 attorney referred you to Cubatabaco's United States  
8 Trademark Registration Number 1,557,163?"

9 THE WITNESS: Yes.

10 THE INTERPRETER: "22. Do you recall that  
11 the redirect questions posed by Cubatabaco's  
12 attorney asked you questions about Cubatabaco's  
13 United States Trademark Registration Number  
14 1,557,163?"

15 THE WITNESS: Yes.

16 THE INTERPRETER: "23. Please review the  
17 document that has been previously marked  
18 Respondent's Exhibit 6. This exhibit is  
19 Cubatabaco's United States Trademark Registration  
20 Number 1,557,163, correct?"

21 THE WITNESS: Correct.

22 THE INTERPRETER: "24. Please turn back  
23 to the document marked Respondent's Exhibit 20,  
24 which is Cubatabaco's Amended Petition in the  
25 instant cancellation proceeding.

1 "Isn't it true that Cubatabaco does  
2 not assert any claims in the instant cancellation  
3 proceeding for cancellation of General Cigar's two  
4 United States trademark registrations for Cohiba,  
5 which are the registrations set forth in the  
6 documents marked Respondent's Exhibits 2 and 3 based  
7 on Cubatabaco's design mark identified in  
8 Cubatabaco's United States Trademark Registrations  
9 Number 1,557,163?"

10 "Objection."

11 THE WITNESS: It's true, it is not based  
12 on those registrations for Cubatabaco.

13 MR. GALLASTEGUI: 26.

14 THE INTERPRETER: "26. Please turn to the  
15 document previously marked" --

16 THE WITNESS: Sorry.

17 So I said that it wasn't based on  
18 those registrations, it's actually that one, like  
19 single registration. Because it's referring to one  
20 registration of Cubatabaco, the question referred to  
21 that.

22 THE INTERPRETER: "26. Please turn to the  
23 document previously marked Respondent's Exhibit 6.  
24 Do you see on this document an image which includes  
25 the term 'Behike' twice?"

1 THE WITNESS: Yes.

2 THE INTERPRETER: "27. Please turn back  
3 to the documents marked Respondent's Exhibit 2 and  
4 3. Do either of those General Cigar's registrations  
5 for the Cohiba trademark as set forth in Exhibits 2  
6 and 3 use or include the term 'Behike'?"

7 THE WITNESS: No.

8 THE INTERPRETER: "28. On the document  
9 marked Respondent's Exhibit 6, do you see the text  
10 below the image in the middle of the right-hand side  
11 of the page that states, 'The drawing of the mark is  
12 lined for the colors yellow and gold'?"

13 THE WITNESS: Yes.

14 THE INTERPRETER: "29. Do either of  
15 General Cigar's registrations for the Cohiba  
16 trademark as set forth in the documents marked  
17 Respondent's Exhibit 2 and 3 have as an element or  
18 feature of the mark the colors yellow and gold?"

19 THE WITNESS: No.

20 THE INTERPRETER: "30. Do you recall that  
21 the redirect questions posed by Cubatabaco's  
22 attorney referred you to Cubatabaco's United States  
23 Trademark Registration Number 3,402,158?"

24 THE WITNESS: Yes.

25 THE INTERPRETER: "31. Do you recall that

1 the redirect questions posed by Cubatabaco's  
2 attorney asked you questions about Cubatabaco's  
3 United States Trademark Registration Number  
4 3,402,158?"

5 THE WITNESS: Yes.

6 THE INTERPRETER: "32. Please review the  
7 document that has been previously marked  
8 Respondent's Exhibit 7. This exhibit is  
9 Cubatabaco's United States Trademark Registration  
10 Number 3,402,158, correct?"

11 THE WITNESS: Correct.

12 THE INTERPRETER: "33. Please" --

13 THE VIDEOGRAPHER: The time 3:35. We are  
14 going off the record.

15 (Recess.)

16 THE VIDEOGRAPHER: The time is 3:41. We  
17 are back on the record.

18 THE INTERPRETER: "33. Please turn back  
19 to the document marked Respondent's Exhibit 20,  
20 which is Cubatabaco's amended petition in the  
21 instant cancellation proceeding.

22 "Isn't it true that Cubatabaco does  
23 not assert any claims in the instant cancellation  
24 proceeding for cancellation of General Cigar's two  
25 United States Trademark Registrations for Cohiba,



1     which are the registrations set forth in the  
2     documents marked Respondent's Exhibits numbers 2 and  
3     3, based on Cubatabaco's design mark identified in  
4     Cubatabaco's United States Trademark Registration  
5     Number 3,402,158?"

6                     "Objection."

7             THE WITNESS:   It's true that it's not  
8     based on that registration.

9             MR. GALLASTEGUI:   35.

10            THE INTERPRETER:   "Please turn to the  
11     document previously marked Respondent's Exhibit 7.  
12     Do you see the text below the image of Cubatabaco's  
13     design mark on the right side of the page that  
14     states: 'The color(s) gold, black, white,  
15     yellowish-orange is/are claimed as a feature of the  
16     mark'?"

17            THE WITNESS:   Yes, I do see it.

18            THE INTERPRETER:   "36.   Please turn back  
19     to the documents marked Respondent's Exhibits 2 and  
20     3.   Do either of General Cigar's registrations for  
21     the Cohiba trademark as set forth in Exhibits 2 and  
22     3 have as an element or feature of the mark the  
23     colors gold, black, white, and yellowish-orange?"

24            THE WITNESS:   No, it doesn't.

25            THE INTERPRETER:   "37.   On the document

1 marked Respondent's Exhibit 7, do you see the text  
2 below the image of Cubatabaco's design mark on the  
3 right-hand side of the page that states: 'The mark  
4 consists of a rectangular shape with curved corners,  
5 outlines in gold. The top half is black and white  
6 dots and contains the silhouette of a head of an  
7 Indian in gold, outlined in white. The bottom half  
8 is in yellowish-orange and contains the word  
9 'Esplendidos' in black. The rectangle is divided in  
10 half with a gold line and a white rectangle in the  
11 center of the mark'?"

12 THE WITNESS: Yes.

13 THE INTERPRETER: "38. Do either of  
14 General Cigar's registrations for the Cohiba  
15 trademark as set forth in the documents marked  
16 Respondent's Exhibit 2 and 3 have as an element or  
17 feature of the mark a rectangular shape with curved  
18 corners?"

19 THE WITNESS: No.

20 THE INTERPRETER: "39. Do either of  
21 General Cigar's registrations for the Cohiba  
22 trademark as set forth in the documents marked  
23 Respondent's Exhibit 2 and 3 have as an element or  
24 feature of the mark outlined in gold?"

25 THE WITNESS: No.

1           THE INTERPRETER: "Number 40. Do either  
2 of General Cigar's registrations for the Cohiba  
3 trademark as set forth in the documents marked  
4 Respondent's Exhibits 2 and 3 have as an element or  
5 feature of the mark a top half that is black and  
6 white dots and contains the silhouette of a head of  
7 an Indian in gold, outlined in white?"

8           THE WITNESS: No.

9           THE INTERPRETER: "41. Do either of  
10 General Cigar's registrations for the Cohiba  
11 trademark as set forth in the documents marked  
12 Respondent's Exhibit 2 and 3 have as an element or  
13 feature of the mark a bottom half that is in  
14 yellowish-orange and contains the word 'Esplendidos'  
15 in black?"

16          THE WITNESS: No.

17          THE INTERPRETER: "42. Do either of  
18 General Cigar's registrations for the Cohiba  
19 trademark as set forth on the documents marked  
20 Respondent's Exhibits 2 and 3 have as an element or  
21 feature of the mark a rectangle that is divided in  
22 half with a gold line, and a white rectangle in the  
23 center of the mark?"

24          THE WITNESS: No.

25          THE INTERPRETER: "43. Please turn to the

1 previously marked Respondent's Exhibit 8. This  
2 exhibit is Cubatabaco's United States Trademark  
3 Registration Number 4,244,461, correct?"

4 THE WITNESS: Correct.

5 THE INTERPRETER: "44. Please turn back  
6 to the document marked Respondent's Exhibit 20,  
7 which is Cubatabaco's amended petition in the  
8 instant cancellation proceeding.

9 "Isn't it true that Cubatabaco does  
10 not assert any claims in the instant cancellation  
11 proceeding for cancellation of General Cigar's two  
12 United States trademark registrations for Cohiba  
13 which are the registrations set forth in the  
14 documents marked Respondent's Exhibit 2 and 3, based  
15 on Cubatabaco's design mark identified in  
16 Cubatabaco's United States Trademark Registration  
17 Number 4,244,461?"

18 "Objection."

19 THE WITNESS: It's true that it's not  
20 based on that registration.

21 MR. FRANK: Can we go off the record for a  
22 second?

23 THE VIDEOGRAPHER: Stand by. The time is  
24 3:52. We are going off the record.

25 (Recess.)

1           THE VIDEOGRAPHER:   Time is 4:01 p.m.  
2   We're back on the record.

3           THE INTERPRETER:   "46.   On the document  
4   marked Respondent's Exhibit 8, do you see the text  
5   below the image of Cubatabaco's design mark on the  
6   right-hand side of the page that states: 'The mark  
7   consists of a rectangle, the top half of which is  
8   black and white dots, and contains the silhouette of  
9   a head an Indian in gold, outlined in white.   The  
10   bottom half is in yellowish-orange and contains the  
11   number "1966" in black.   The rectangle is divided in  
12   half with a gold line'?"

13          THE WITNESS:   Yes.

14          THE INTERPRETER:   "47.   Please turn back  
15   to the documents marked Respondent's Exhibits 2 and  
16   3.   Do either of the General Cigar's registrations  
17   for the Cohiba trademark as set forth in the  
18   documents marked Respondent's Exhibits 2 and 3 have  
19   as an element or feature of the mark a rectangle,  
20   the top half of which is black and white dots and  
21   contains the silhouette of a head of an Indian in  
22   gold, outlined in white, and the bottom half is  
23   yellowish-orange?"

24          THE WITNESS:   Yes.   I'm sorry.   No.   Well,  
25   the question is so long I get lost.

1                   No, no, no. The General Cigar marks  
2 don't have the design of the trademark for  
3 Cubatabaco that is described in the question.

4                   THE INTERPRETER: "48. Do either of  
5 General Cigar's registrations for the Cohiba  
6 trademark as set forth in the documents marked  
7 Respondent's Exhibits 2 and 3 contain the number  
8 "1966" '?"

9                   THE WITNESS: No.

10                  THE INTERPRETER: "49. Do either of  
11 General Cigar's registrations for the Cohiba  
12 trademark as set forth in the documents marked  
13 Respondent's Exhibit 2 and 3 have as an element or  
14 feature of the mark a rectangle that is divided in  
15 half with a gold line?"

16                  THE WITNESS: No.

17                  MR. FRANK: Witness does not waive  
18 signature. So the witness will review the  
19 transcript for accuracy and other issues.

20                  THE VIDEOGRAPHER: This concludes today's  
21 testimony given by Ms. Garcia. The number of media  
22 units used is four. They will be retained by  
23 Veritext Legal Solutions. We are off the record at  
24 4:06 p.m.

25                         (Deposition concluded at 4:06 p.m.)

CERTIFICATE OF READER-INTERPRETER

I, \_\_\_\_\_,  
whose address is \_\_\_\_\_  
\_\_\_\_\_,  
a person who speaks the language of the witness;  
namely, \_\_\_\_\_, do hereby certify that on  
the \_\_\_\_\_ day of \_\_\_\_\_, 20\_\_\_\_\_,  
I did translate the foregoing deposition from the  
\_\_\_\_\_ language into the \_\_\_\_\_  
language, reading same to the witness in his/her native  
tongue, to the best of my ability;

That all corrections and changes requested by  
the witness were made and initialed by the witness;

That upon completion of such reading, the  
witness did confirm to me that he/she had understood  
the reading.

\_\_\_\_\_  
Interpreter-Reader

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D E P O S I T I O N   S I G N A T U R E   P A G E

Case Caption: Cubatabaco v General Cigar

DECLARATION UNDER PENALTY OF PERJURY

I declare under penalty of perjury that I have read the entire transcript of my deposition taken in the above-captioned matter or the same has been read to me, and the same is true and accurate, except for changes and/or corrections, if any, as indicated by me on the DEPOSITION ERRATA SHEET hereof, with the understanding that I offer these changes as if still under oath.

Executed on this \_\_\_\_\_ day of \_\_\_\_\_, 2019,  
at \_\_\_\_\_,  
\_\_\_\_\_.  
(city) (state)

\_\_\_\_\_  
LISSET FERNANDEZ GARCIA



DEPOSITION ERRATA SHEET

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Page No. \_\_\_\_\_ Line No. \_\_\_\_\_ Change to:

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Reason for change:

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13 Page No. \_\_\_\_\_ Line No. \_\_\_\_\_ Change to:

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22 SIGNATURE \_\_\_\_\_ DATE \_\_\_\_\_

23 LISSET FERNANDEZ GARCIA

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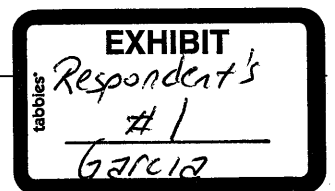








# EXHIBIT 1



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 1147309  
For the mark COHIBA  
Date registered: February 17, 1981

AND

In the matter of the Trademark Registration No. 1898273  
For the mark COHIBA  
Date registered: June 6, 1995

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EMPRESA CUBANA DEL TABACO, d.b.a.	:	
CUBATABACO,	:	
	:	
Petitioner,	:	Cancellation No. 92025859
v.	:	
GENERAL CIGAR CO., INC. and CULBRO	:	
CORP.	:	
	:	
Respondents.	:	
	:	
-----	X	

**DECLARACIÓN DE LISSET FERNÁNDEZ GARCÍA**

LISSET FERNÁNDEZ GARCÍA declara bajo pena de perjurio bajo las leyes de los Estados Unidos de América que lo siguiente es verdadero y correcto:

1. Mi nombre es Lisset Fernández García y resido en La Habana, Cuba.
2. Estudié inglés en la escuela secundaria, preuniversitario y en el *Instituto de Comercio Exterior* en Cuba y puedo leer y comprender materiales escritos en inglés.
3. Soy la Directora Jurídica de Corporación Habanos, S.A. ("Habanos, S.A.")

REDACTED

REDACTED

desde 12 de

REDACTED

julio, 2016.

REDACTED

4.

REDACTED

[REDACTED]

5.

REDACTED

[REDACTED]

6.

REDACTED

7. Cubatabaco es una empresa establecida por la Ley cubana No. 1191 de 1966, que sigue vigente, y está organizada bajo las leyes de Cuba con su sede principal en La Habana, Cuba. Adjunto al presente como Anexo A es una copia verdadera y correcta de la Ley cubana No. 1191 de 1966.

8. Cubatabaco es el propietario del registro de marca cubano para la marca denominativa COHIBA emitida por la Oficina Cubana de la Propiedad Industrial ("OCPI") en la Clase Internacional 34. El 29 de septiembre de 1969, Cubatabaco solicitó a OCPI para registrar la marca COHIBA (con diseño) en la Clase Internacional 34. El registro para la marca COHIBA (con diseño) en la Clase Internacional 34, Certificado No. 110,044, se emitió el 31 de mayo de 1972 para un término de quince (15) años. El 7 de marzo de 1972, Cubatabaco solicitó a OCPI registrar la marca denominativa COHIBA (sin diseño) en la Clase Internacional 34. El registro de la marca denominativa COHIBA (sin diseño) en la Clase Internacional 34, Certificado N ° 111.059, se emitió el 1 de julio, 1980, por un término de quince (15) años. Los Certificados de Renovación del Certificado de Registro No. 111,059 fueron emitidos el 5 de febrero de 1996 por un término que finaliza el 1 de julio de 2006, el 30 de noviembre de 2005 por un término que finaliza el 1 de julio de 2015 y el 3 de febrero de 2015 por un término que finaliza el 1 de julio de 2025. Certificado de Registro No. 111,059 para la marca denominativa COHIBA (sin diseño) en La Clase Internacional 34 para cigarros y otros productos de tabaco y accesorios para cigarros

especificados sigue vigente hoy. Entiendo que los documentos mencionados han sido presentados al Respondent.

9. Cubatabaco posee una solicitud pendiente en la Oficina de Patentes y Marcas de los Estados Unidos (“USPTO”) para registrar la marca denominativa COHIBA en los Estados Unidos, Serial No. 75/226002, de conformidad con la Sección 44 (e) en la Clase Internacional 34 para cigarros y otros productos de tabaco y accesorios para cigarros especificados sobre la base de ser propietario del registro cubano, Certificado No. 111,059, de la marca denominativa COHIBA en la Clase Internacional 34. Esta solicitud fue presentada ante la USPTO el 15 de enero de 1997. Entiendo que Petitioner presentará el archivo del USPTO para la solicitud pendiente Serial No. 75/226002 como prueba en este proceso.

10. Cubatabaco también es propietario de registros emitidos por la Oficina de Patentes y Marcas de los Estados Unidos (USPTO) para: una marca de diseño consistente en el diseño que utiliza para COHIBA (“marca de diseño COHIBA”) sin la palabra COHIBA, número de registro 2,145,804 , en la Clase Internacional 34 para “raw tobacco, cigars, cigarettes, cut tobacco, rappee, matches, tobacco, tobacco pipes, pipe-holders, ashtrays not of precious metal, match boxes, cigar cases not of precious metal, and humidors;” una marca de diseño consistente en la cabeza india que forma parte de su marca de diseño COHIBA, número de de Registro 4,988,587, en la Clase Internacional 34 para “cigars, cigarettes; cigarillos; ashtrays; cigar cases; cigar cutters; match boxes; matches; pipe tobacco;” BEHIKE y el diseño que incluye la marca de diseño COHIBA, número de registro 1,557,163 en la Clase Internacional 34 para “cigars, raw tobacco, cigarettes, cut tobacco, rappee, manufactured tobacco of all kinds, matches, tobacco-pipes, pipe holders, ashtrays, match boxes, cigar cases and humidors;” ESPLENDIDOS y diseño que incluye la marca de diseño COHIBA, número de registro 3,402,158 en la Clase Internacional



34 para “raw tobacco, processed tobacco for smoking, chewing or as snuff, cigarette, small cigars, fine-cut tobacco, smokers' articles, namely, ashtrays, cigar cutters, match boxes, cigar cases, and matches;” y 1966 y diseño que incluye la marca de diseño COHIBA, número de Registro No. 4,244,461 en la Clase Internacional 34 para “cigars, tobacco and cigarettes, ashtrays, cigar cases; cigar cutters; match boxes; matches; pipe tobacco,” todos los cuales siguen siendo válidos y vigentes. BEHIKE, ESPLENDIDOS y 1966 son *vitolas* de los cigarros COHIBA de Cubatabaco.

11. Cubatabaco también es el propietario de los registros emitidos por la USPTO para las siguientes marcas: LA CASA DEL HABANO y el diseño, número de Registro 1,970,911 en la Clase Internacional 34 para “raw tobacco; cigars; cigarettes; cut tobacco; rappee; manufactured tobacco of all kinds; matches; tobacco; smoking pipes; pipe-holders, not of precious metal; ashtrays, not of precious metal; match boxes, cigar cases and humidors, not of precious metal;” LA CASA DEL HABANO y su diseño, número de Registro 2,212,119 en Clase Internacional 35 para “retail store services featuring tobacco and smokers' accessories” y Clase Internacional 42 para “social club services, bar services, and restaurant services;” LA PERLA, número de Registro 2,128,050 en la Clase Internacional 34 para “cured and uncured tobacco for smoking, chewing, snuff or cigarettes;” y QUAI D'ORSAY, número de Registro 1,653,845 en la Clase Internacional 34 para “raw tobacco; cigars; cigarettes; cut tobacco; rappee; matches; tobacco pipes; pipe racks, ashtrays; match boxes, cigar cases and humidors, not of precious metal,” todos los cuales siguen siendo válidos y vigentes.

12. Durante la década de los 1970s, Cubatabaco presentó solicitudes para registrar COHIBA en la Clase Internacional 34 en diecisiete (17) países extranjeros de la siguiente manera: en 1971, en Gran Bretaña e Irlanda, los países del Benelux (Bélgica, Holanda y

Luxemburgo) y España; en 1972, en Francia, Dinamarca, Portugal, Australia, Egipto y Sudáfrica; y, entre 1974 y 1978, en Argentina en 1974, México en 1976, Suiza en 1977, Venezuela en 1977, Colombia en enero de 1978 e Italia en agosto de 1978. Cubatabaco solicitó el registro de COHIBA en los siguientes países durante la década de los 1980s: en 1982: Canadá; Líbano. En 1983: Austria; Liechtenstein; Alemania; Finlandia; Bulgaria; Hungría; Suecia; Mónaco; Polonia; Checoslovaquia; Túnez; Islandia; Noruega; Nueva Zelanda; Panamá; Jamaica; India; Israel. En 1984: *Organización Africana de la Propriété Intellectuelle* (Organización Africana de la Propiedad Intelectual o OAPI, cuya membresía en ese momento consistía en: Benin, Burkina Faso, Camerún, República Centroafricana, Congo, Costa de Marfil, Gabón, Malí, Mauritania, Níger, Senegal, Togo); Chipre; Grecia; Irán; Tanzania; Trinidad y Tobago; Ghana; Malawi; Suriname; Zambia; Zaire; Zimbabue; Méjico; Bahamas. En 1985: Bahrein; Marruecos; Ecuador; Honduras; Nicaragua. En 1986: Reino Unido; Liberia. En 1988: Uganda; Uruguay. Después de 1988, Cubatabaco solicitó el registro de COHIBA en 54 países adicionales. Cubatabaco registró la marca COHIBA en 115 países.

13. En 1982, los cigarros cubanos COHIBA se exportaron para su venta a España y, después de esta exportación inicial, a un número cada vez mayor de países. Por 1992, se vendía y promocionaba en numerosos países de todo el mundo, incluso en la mayoría de los países europeos y Canadá. Hoy en día, se vende y promociona en todo el mundo, excepto en los Estados Unidos. Las marcas registradas mencionadas arriba se han usado en asociación con estas ventas y promociones relacionadas en todo el mundo.

14.

REDACTED

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REDACTED



REDACTED

16. Desde 1999, Habanos, S.A. ha registrado la marca COHIBA en países además de aquellos en los que Cubatabaco había registrado la marca; de modo que, actualmente, la marca COHIBA está registrada en ciento ochenta y un (181) países y dieciséis (16) otros territorios. Los únicos países reconocidos por las Naciones Unidas en los que no se ha registrado la marca cubana COHIBA son: los Estados Unidos (solicitud pendiente), Micronesia, Nauru, Palau, Somalia, Sudán del Sur, Timor Oriental, Libia, Barbados, Eritrea e Islas Marshall.

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25. Desde la Revolución Cubana de 1959, numerosos cigarros cubanos como PARTAGAS, LA GLORIA CUBANA, HOYO DE MONTERREY, ROMEO Y JULIETA, PUNCH y MONTECRISTO, han sido comercializados y exportados internacionalmente bajo las mismas marcas de propiedad y utilizadas antes de la Revolución por compañías cubanas que fueron nacionalizadas en 1960. Los dueños de antes de la Revolución habían exportado sus cigarros a los Estados Unidos bajo estas marcas. Estas marcas de cigarros registradas antes de la Revolución están registradas en Cuba y en todo el mundo en nombre de entidades cubanas, excepto en los Estados Unidos, donde están registradas en nombre de otras partes, incluyendo General Cigar. Entiendo que General Cigar compró los derechos de marca en los Estados Unidos a numerosas marcas de cigarros prerevolucionarias, como PARTAGAS, LA GLORIA CUBANA y HOYO DE MONTERREY, de los propietarios prerevolucionarios que abandonaron Cuba después de la Revolución cubana y reanudaron la producción en el exterior de Cuba de cigarros que vendieron en los Estados Unidos, así como los cigarros producidos por ellos en Cuba se vendieron en los Estados Unidos bajo las mismas marcas antes de las nacionalizaciones.

26. A diferencia de otras marcas cubanas con las que General Cigar vende cigarros en los Estados Unidos, como PARTAGAS, LA GLORIA CUBANA y HOYO DE MONTERREY, COHIBA fue una marca establecida después de la Revolución Cubana; General Cigar nunca

compró ningún derecho a la marca COHIBA de personas en Cuba (o en otro lugar); y no hay patrimonio, historia u otra relación entre el producto etiquetado COHIBA de General Cigar y el COHIBA cubano o el país de Cuba.

27.

REDACTED



28. Aunque Cubatabaco actualmente no está permitido por la legislación de los EE.UU. vender sus cigarros en los Estados Unidos, Cubatabaco ha tomado las siguientes medidas, entre otras, para establecer y hacer cumplir los derechos de marca en preparación para el momento en que se le permita legalmente vender sus cigarros COHIBA en los Estados Unidos y en la implementación de esa intención:

a. Cubatabaco se presentó y ha cursado con el proceso de cancelación actual, que se presentó en 1997, incluso mediante una apelación exitosa ante el Tribunal de Apelaciones de los Estados Unidos para el Circuito Federal.

b. En 1997, Cubatabaco se presentó una acción federal en el Tribunal de Distrito de los Estados Unidos para el Distrito Sur de Nueva York con respecto a la misma marca COHIBA en cuestión aquí. El litigio de la acción federal, que incluyó tres apelaciones ante el

Tribunal de Apelaciones de los Estados Unidos para el Segundo Circuito y una petition for a writ of *certiorari* ante la Corte Suprema de los Estados Unidos, duró hasta 2010.

c. Cubatabaco se presentó un litigio en el Segundo Tribunal Colegiado de Santiago en la República Dominicana contra el General Cigar Dominicana, SA (Número de caso: 08-513-00181), una subsidiaria de la Respondent, en febrero de 2007 para cigarros producidos en la República Dominicana y enviados a la Estados Unidos para ser vendidos como cigarros COHIBA de General Cigar. Este caso duró aproximadamente diez (10) años.

d. En julio de 2003, Cubatabaco entabló un proceso de oposición contra Kachaturian, Kris I. (“Kachaturian”) en la Junta de Juicios y Apelaciones sobre Marcas (TTAB) (Oposición No. 91157163), oponiéndose a la solicitud de Kachaturian de registrar una marca de diseño en Clase Internacional 34 que era una copia virtualmente idéntica del diseño registrado de COHIBA de Cubatabaco. Frente a la oposición de Cubatabaco, Kachaturian abandonó expresamente su aplicación el 23 de marzo de 2004.

e. En diciembre de 2003, Cubatabaco presentó un proceso de oposición contra Reel Smokers Cigar Distributors (“Reel”) en el TTAB (Oposición No. 91158932), oponiéndose a la solicitud de Reel de registrar SIBONEY & Design en la Clase Internacional 34, presentando un diseño que era virtualmente idéntico del diseño registrado de COHIBA de Cubatabaco. El 24 de mayo de 2004, la TTAB otorgó la Moción de Juicio por Incumplimiento de Cubatabaco, lo que sustentó la oposición de Cubatabaco y rechazó el registro.

f. En febrero de 2005, Cubatabaco presentó un proceso de oposición contra Anthony P. Serino (“Serino”) en la TTAB (oposición No. 91164141), oponiéndose a la solicitud de Serino para registrar TAINO & Design en la Clase Internacional 34, presentando un diseño que era una copia virtualmente idéntica del diseño registrado de COHIBA de Cubatabaco. En



virtud de un acuerdo con Cubatabaco, Serino acordó, entre otras cosas, abandonar la aplicación de diseño y suspender todo uso comercial del diseño y no presentar ninguna solicitud nueva para diseños iguales o similares a los de la aplicación TAINO & Design, y Cubatabaco acordó no desafiar la marca solo denominativo TAINO.

g. El 26 de mayo de 2005, Cubatabaco inició una acción para la infracción de marca, competencia desleal, apropiación indebida y passing off/palming off contra Santa Clara Cigar Manufacturer, Inc. a / k / a STC Cigar Manufacturers, Inc. (“Santa Clara”) en el Tribunal de Distrito de los Estados Unidos para el Distrito Sur de Nueva York (Caso No. 05-cv-5041) basado en el uso por parte de Santa Clara de la marca HABANO y el diseño que era una copia virtualmente idéntica del diseño registrado de COHIBA de Cubatabaco. El 27 de septiembre de 2005, las partes en esta acción entraron en una Estipulación por la cual, entre otras cosas, Santa Clara reconoció que sus cigarros con HABANO y diseño infringieron el diseño registrado de COHIBA de Cubatabaco y acordó estar permanentemente prohibido, entre otros, de: (a) utilizar el diseño COHIBA infractor de Santa Clara, marca de diseño COHIBA, cualquier otra marca o imagen comercial que imita o es confusamente similar al marca de diseño COHIBA de Cubatabaco, o cualquier otra descripción o representación falsa o cualquier otra cosa calculada o que pueda causar confusión o error en la mente del público o engañar a la público en la creencia de que los productos de Santa Clara son los mismos o asociados con los productos de Cubatabaco que usan la marca de diseño COHIBA; y (b) representar por cualquier medio, directa o indirectamente, que cualquier producto vendido por Santa Clara sea patrocinado, aprobado o endosado por Cubatabaco o esté de alguna manera afiliado, conectados o asociados con los productos de Cubatabaco que usan la marca de diseño de COHIBA o que los productos de



Cubatabaco que usan la marca de diseño COHIBA y los productos de Santa Clara provienen de una fuente u origen común.

h. En noviembre de 2017, Cubatabaco presentó un proceso de oposición contra Kretek International, Inc. (“Kretek”) en la TTAB (oposición No. 91237938), oponiéndose a las dos solicitudes de Kretek para registrar CUBAN ROUNDS, una con diseño y el otro carácter estándar, en la Clase Internacional 34, con un diseño que era una copia virtualmente idéntica del diseño registrado de COHIBA de Cubatabaco. Este proceso sigue pendiente.

i. Cubatabaco ha solicitado y obtenido los registros de la marca registrada de la USPTO indicados en los Párrafos 9-11, más arriba.

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34. Me gradué de la Facultad de Derecho de la Universidad de La Habana en 1993 y desde entonces tengo licencia para ejercer el derecho en Cuba.

35. Después de graduarme en la Universidad de La Habana, completé mis obligaciones de servicio social trabajando como adiestrada, similar a un aprendiz de abogado, en Bufete Colectivo (bufete de abogados colectivo) en la provincia de La Habana, municipio de Batabano de 1993 a 1994 y luego durante tres (3) meses en 1994 como adiestrada en la Consultoría Jurídica en el municipio de Cerro en La Habana. Mis responsabilidades en la Consultoría Jurídica consistían en trabajo legal para empresas cubanas, principalmente trabajo relacionado con contratos y asuntos laborales. Mis responsabilidades en el Bufete Colectivo consistían en trabajo para individuos en asuntos civiles, administrativos y penales.

36. Mi primer trabajo después de completar mi servicio social fue como asesora jurídica en la empresa cubana de exportación, Cubaniquel, cargo que ocupé desde 1995 hasta 2001. Mis responsabilidades incluían, entre otras cosas, el trabajo legal relacionado con la asesoraría en materia de contrarros, legislacion o asuntos laborales y financieros. Después de uno o dos meses trabajando en una empresa cubana dedicada a temas relacionados con la exportación de productos y servicios culturales llamada Ficsene, abandoné voluntariamente ese trabajo y comencé a trabajar como especialista en política comercial en el Ministerio de Comercio Exterior de Cuba. Trabajé en ese puesto desde 2001 hasta 2003 y mis responsabilidades incluían el seguimiento y atención de la labor y de los temas de las organizaciones económicas internacionales, como la Organización Mundial del Comercio y la Conferencia de las Naciones Unidas sobre Comercio y Desarrollo (UNCTAD), y la elaboración de directivas para la participación de Cuba en estas organizaciones, entre otras. En 2003, dejé ese cargo para convertirme en Segunda Secretaria de la Misión Permanente de Cuba en Ginebra, cargo en el que

trabajé hasta 2007. Mis responsabilidades incluían la participación en las reuniones de los órganos de la Organización Mundial del Comercio y la Organización Mundial de la Propiedad Intelectual (OMPI), como representante de Cuba. En 2007, regresé a Cuba y retomé mi posición como especialista en política comercial en el Ministerio de Comercio Exterior de Cuba, que se convirtió en el Ministerio de Comercio Exterior y La Inversión Extranjera en 2009. Me quedé en ese cargo hasta 2012. Entre 2012-2014, fui nombrada Consejera Económica y Comercial en la Embajada de Cuba en Uruguay, donde atendí los asuntos comerciales bilaterales y me desempeñé como Representante Alterna de la Asociación Latinoamericana de Intergración (ALADI) en Montevideo. En 2014, regresé a Cuba y trabajé como especialista en política comercial en la Oficina del Director de Organismos Económicos Internacionales en el Ministerio de Comercio Exterior e Inversión Extranjera. Permanecí en este puesto hasta que comencé a trabajar en Corporación Habanos, S.A. como su Directora Jurídica el 12 de julio de 2016 fecha en que fui nombrada por la Junta de Accionistas.

Ejecutado en: octubre 2, 2018  
La Habana, Cuba

Por:  \_\_\_\_\_  
Lisset Fernández García

## **CERTIFICATE OF TRANSLATION**

**I, Nahum Hahn, am competent to translate from Spanish into English, and certify that the translation of the attached document, “Declaration of Lisset Fernández García”, is true and accurate to the best of my abilities.**

**October 6, 2018**

A handwritten signature in black ink, appearing to be 'Nahum Hahn', written over the printed name.

**Nahum Hahn**

**161 Gordonhurst Ave.**

**Montclair, NJ 07043**

**(917) 680-4699**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 1147309

For the mark COHIBA

Date registered: February 17, 1981

AND

In the matter of the Trademark Registration No. 1898273

For the mark COHIBA

Date registered: June 6, 1995

EMPRESA CUBANA DEL TABACO, d.b.a.	:	
CUBATABACO,	:	
	:	
Petitioner,	:	
	:	Cancellation No. 92025859
v.	:	
	:	
GENERAL CIGAR CO., INC. and CULBRO	:	
CORP.	:	
	:	
Respondents.	:	
	:	
	:	
	X	

**DECLARATION OF LISSET FERNÁNDEZ GARCÍA**

LISSET FERNÁNDEZ GARCÍA declares under penalty of perjury under the laws of the United States of America that the following is true and correct:

1. My name is Lisset Fernández García and I reside in Havana, Cuba.
2. I studied English in secondary school, pre-university and at the *Instituto de Comercio Exterior* in Cuba and I can read and understand materials written in English.
3. I am the Legal Director of Corporación Habanos, S.A. ("Habanos, S.A.") RED  
ACT  

REDACTED

REDACTED

 since July  
12, 2016. 

REDACTED

REDACTED

REDACTED

REDACTED

REDACTED



REDACTED

7. Cubatabaco is a company established by Cuban Law No. 1191 of 1966, which remains in effect, and is organized under the laws of Cuba with its principal place of business in Havana, Cuba. Attached hereto as Annex A is a true and correct copy of Cuban Law No. 1191 of 1966.

8. Cubatabaco is the owner of the Cuban trademark registration for the word mark COHIBA issued by the *Oficina Cubana de la Propiedad Industrial* (Cuban Office of Industrial Property) (“OCPI”) in International Class 34. On September 29, 1969, Cubatabaco applied to OCPI to register the mark COHIBA (with design) in International Class 34. The registration for the mark COHIBA (with design) in International Class 34, Certificate No. 110,044, issued on May 31, 1972 for a term of fifteen (15) years. On March 7, 1972, Cubatabaco applied to OCPI to register the word mark COHIBA (without design) in International Class 34. The registration for the word mark COHIBA (without design) in International Class 34, Certificate No. 111,059, issued on July 1, 1980, for a term of fifteen (15) years. Certificates of Renewal of Registration Certificate No. 111,059 were issued on February 5, 1996 for a term ending on July 1, 2006, on November 30, 2005 for a term ending on July 1, 2015 and on February 3, 2015 for a term ending on July 1, 2025. Registration Certificate No. 111,059 for the word mark COHIBA (without design) in International Class 34 for cigars and other specified tobacco products and cigar accessories remains in effect today. I understand that the foregoing documents have been produced to Respondent.

9. Cubatabaco owns a pending application in the United States Patent and Trademark Office (“USPTO”) to register the word mark COHIBA in the United States, Serial No. 75/226002, pursuant to Section 44(e) in International Class 34 for cigars and other specified tobacco products and cigar accessories on the basis of its ownership of the Cuban registration, Certificate No. 111,059, of the word mark COHIBA in International Class 34. This application was filed with the USPTO on January 15, 1997. I understand that Petitioner will be submitting the USPTO file for pending application Serial No. 75/226002 as evidence in this proceeding.

10. Cubatabaco is also the owner of registrations issued by the United States Patent and Trademark Office (USPTO) for: a design mark consisting of the design it uses for COHIBA (“COHIBA design mark”) without the word COHIBA, Registration No. 2,145,804, in International Class 34 for raw tobacco, cigars, cigarettes, cut tobacco, rappee, matches, tobacco, tobacco pipes, pipe-holders, ashtrays not of precious metal, match boxes, cigar cases not of precious metal, and humidors; a design mark consisting of the Indian head that forms part of its COHIBA design mark, Registration 4,988,587, in International Class 34 for cigars, cigarettes; cigarillos; ashtrays; cigar cases; cigar cutters; match boxes; matches; pipe tobacco; BEHIKE and design which includes the COHIBA design mark, Registration No. 1,557,163 in International Class 34 for cigars, raw tobacco, cigarettes, cut tobacco, rappee, manufactured tobacco of all kinds, matches, tobacco-pipes, pipe holders, ashtrays, match boxes, cigar cases and humidors; ESPLÉNDIDOS and design which includes the COHIBA design mark, Registration No. 3,402,158 in International Class 34 for raw tobacco, processed tobacco for smoking, chewing or as snuff, cigarette, small cigars, fine-cut tobacco, smokers' articles, namely, ashtrays, cigar cutters, match boxes, cigar cases, and matches; and 1966 and design which includes the COHIBA design mark, Registration No. 4,244,461 in International Class 34 for cigars, tobacco

and cigarettes, ashtrays, cigar cases; cigar cutters; match boxes; matches; pipe tobacco, all of which remain valid and in effect. BEHIKE, ESPLÉNDIDOS and 1966 are *vitolas* of Cubatabaco's COHIBA cigars.

11. Cubatabaco is also the owner of the registrations issued by the USPTO for the following trademarks: LA CASA DEL HABANO and design, Registration No. 1,970,911 in International Class 34 for raw tobacco; cigars; cigarettes; cut tobacco; rappee; manufactured tobacco of all kinds; matches; tobacco; smoking pipes; pipe-holders, not of precious metal; ashtrays, not of precious metal; match boxes, cigar cases and humidors, not of precious metal; LA CASA DEL HABANO and design, Registration No. 2,212,119 in International Class 35 for retail store services featuring tobacco and smokers' accessories and International Class 42 for social club services, bar services, and restaurant services; LA PERLA, Registration No. 2,128,050 in International Class 34 for cured and uncured tobacco for smoking, chewing, snuff or cigarettes; and QUAI D'ORSAY, Registration No. 1,653,845 in International Class 34 for raw tobacco; cigars; cigarettes; cut tobacco; rappee; matches; tobacco pipes; pipe racks, ashtrays; match boxes, cigar cases and humidors, not of precious metal, all of which remain valid and in effect.

12. During the 1970's, Cubatabaco filed applications to register COHIBA in International Class 34 in seventeen (17) foreign countries as follows: in 1971, in Great Britain and Ireland, the Benelux countries (Belgium, Netherlands and Luxembourg), and Spain; in 1972, in France, Denmark, Portugal, Australia, Egypt, and South Africa; and, between 1974 and 1978, in Argentina in 1974, Mexico in 1976, Switzerland in 1977, Venezuela in 1977, Colombia in January 1978, and Italy in August in 1978. Cubatabaco applied to register COHIBA in the following countries during the 1980's: In 1982: Canada; Lebanon. In 1983: Austria;

Liechtenstein; Germany; Finland; Bulgaria; Hungary; Sweden; Monaco; Poland; Czechoslovakia; Tunisia; Iceland; Norway; New Zealand; Panama; Jamaica; India; Israel. In 1984: *Organisation Africaine de la Propriété Intellectuelle* (African Intellectual Property Organization or OAPI, whose membership at the time consisted of: Benin, Burkina Faso, Cameroon, Central African Republic, Congo, Ivory Coast, Gabon, Mali, Mauritania, Niger, Senegal, Togo); Cyprus; Greece; Iran; Tanzania; Trinidad & Tobago; Ghana; Malawi; Suriname; Zambia; Zaire; Zimbabwe; Mexico; Bahamas. In 1985: Bahrain; Morocco; Ecuador; Honduras; Nicaragua. In 1986: United Kingdom; Liberia. In 1988: Uganda; Uruguay. After 1988, Cubatabaco applied for registration of COHIBA in 54 additional countries. Cubatabaco registered the mark COHIBA in 115 countries.

13. In 1982, Cuba's COHIBA cigars were exported for sale to Spain and, after this initial export, to an increasing number of countries. By 1992, they were sold and promoted in numerous countries throughout the world, including in the majority of European countries and Canada. Today, they are sold and promoted throughout the world, except the United States. The foregoing registered trademarks have been used in association with these sales and related promotions throughout the world.

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15. REDACTED

16. Since 1999, Habanos, S.A. has registered the COHIBA trademark in countries in addition to those in which Cubatabaco had registered the mark; so that, currently, the COHIBA

trademark is registered in one hundred eighty-one (181) countries and sixteen (16) other territories. The only countries recognized by the United Nations in which the Cuban COHIBA trademark is not registered are: the United States (application pending), Micronesia, Nauru, Palau, Somalia, South Sudan, East Timor, Libya, Barbados, Eritrea, and the Marshall Islands.

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25. Since the Cuban Revolution of 1959, numerous Cuban cigars, such as PARTAGÁS, LA GLORIA CUBANA, HOYO DE MONTERREY, ROMEO Y JULIETA, PUNCH and MONTECRISTO, have been marketed and exported internationally under the same

brand names owned and used prior to the Revolution by Cuban companies that were nationalized in 1960. The pre-Revolution owners had exported their cigars to the United States under these brand names. These pre-Revolution cigar trademarks are registered to Cuban entities in Cuba and throughout the world, except in the United States, where they are registered to other parties, including General Cigar. I understand that General Cigar purchased the trademark rights in the United States to numerous pre-Revolution cigar brands, such as PARTAGÁS, LA GLORIA CUBANA and HOYO DE MONTERREY, from the pre-Revolution owners who left Cuba after the Cuban Revolution and resumed production outside of Cuba of cigars that they sold in the U.S., just as the cigars produced by them in Cuba were sold in the U.S. under the same brand names before the nationalizations.

26. Unlike other Cuban brand names by which General Cigar sells cigars in the United States, such as PARTAGÁS, LA GLORIA CUBANA and HOYO DE MONTERREY, COHIBA was a brand established after the Cuban Revolution; General Cigar never purchased any rights to the COHIBA brand from persons in Cuba (or elsewhere); and there is no heritage, history or other relation between General Cigar COHIBA-labelled product and the Cuban COHIBA or the country of Cuba.

27. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

28. Although Cubatabaco currently is not permitted under U.S. law to sell its cigars in the United States, Cubatabaco has taken the following actions, among others, to establish and enforce trademark rights in preparation for the time when it will be legally permitted to sell its COHIBA cigars in the United States and in implementation of that intention:

a. Cubatabaco initiated and has proceeded with the instant cancellation proceeding, which was filed in 1997, including through a successful appeal to the United States Court of Appeals for the Federal Circuit.

b. In 1997, Cubatabaco initiated a federal action in the United States District Court for the Southern District of New York concerning the same COHIBA trademark at issue here. Litigation of the federal action, which included three appeals to the United States Court of Appeals for the Second Circuit and a petition for a writ of *certiorari* to the United States Supreme Court, lasted until 2010.

c. Cubatabaco initiated litigation in the *Segundo Tribunal Colegiado de Santiago* in the Dominican Republic against General Cigar Dominicana, S.A. (Case number: 08-513-00181), a subsidiary of Respondent, in February 2007 for cigars produced in the Dominican Republic and shipped to the United States to be sold as General Cigar COHIBA cigars. This case lasted approximately ten (10) years.

d. In July 2003, Cubatabaco brought opposition proceedings against Kachaturian, Kris I. (“Kachaturian”) in the U.S. Trademark Trial and Appeal Board (TTAB) (Opposition No. 91157163), opposing Kachaturian’s application to register a design mark in International Class 34 that was a virtually identical copy of Cubatabaco’s registered COHIBA design. In the face of

Cubatabaco's opposition, Kachaturian expressly abandoned its application on March 23, 2004.

e. In December 2003, Cubatabaco brought opposition proceedings against Reel Smokers Cigar Distributors ("Reel") in the TTAB (Opposition No. 91158932), opposing Reel's application to register SIBONEY & Design in International Class 34, featuring a design that was a virtually identical copy of Cubatabaco's registered COHIBA design. On May 24, 2004, the TTAB granted Cubatabaco's Motion for a Default Judgment, sustaining Cubatabaco's opposition and refusing registration.

f. In February 2005, Cubatabaco brought opposition proceedings against Anthony P. Serino ("Serino") in the TTAB (Opposition No. 91164141), opposing Serino's application to register TAINO & Design in International Class 34, featuring a design that was a virtually identical copy of Cubatabaco's registered COHIBA design. Under an agreement with Cubatabaco, Serino agreed, *inter alia*, to abandon the design application and cease all commercial use of the design and not to file any new applications for the same or similar designs to those in the TAINO & Design Application, and Cubatabaco agreed not to challenge the TAINO word mark only.

g. On May 26, 2005, Cubatabaco initiated a trademark infringement, unfair competition, misappropriation and passing off/palming off action against Santa Clara Cigar Manufacturer, Inc. a/k/a STC Cigar Manufacturers, Inc. ("Santa Clara") in the United States District Court for the Southern District of New York (Case No. 05-cv-5041) based on Santa Clara's use of the trademark HABANO and design that was a virtually identical copy of Cubatabaco's registered COHIBA design. On September 27, 2005, the parties in this action entered into a Stipulation by which, *inter alia*, Santa Clara acknowledged that its HABANO and design cigars infringed on Cubatabaco's registered COHIBA design and agreed to be

permanently enjoined, *inter alia*, from: (a) using the Santa Clara's infringing COHIBA design, COHIBA design mark, any other trademark or trade dress which imitates or is confusingly similar to Cubatabaco's COHIBA design mark, or any other false description or representation or any other thing calculated or likely to cause confusion or mistake in the mind of the public or to deceive the public into the belief that Santa Clara's products are the same as or associated with the Cubatabaco's products which use the COHIBA Design Marks; and (b) representing by any means whatsoever, directly or indirectly, that any products sold by Santa Clara are sponsored, approved, or endorsed by Cubatabaco or are in any way affiliated, connected or associated with the Cubatabaco's products which use the COHIBA design mark or that the Cubatabaco's products which use the COHIBA Design Marks and Santa Clara's products derive from a common source or origin.

h. In November 2017, Cubatabaco brought opposition proceedings against Kretek International, Inc. ("Kretek") in the TTAB (Opposition No. 91237938), opposing Kretek's two applications to register CUBAN ROUNDS, one with design and the other standard character, in International Class 34, featuring a design that was a virtually identical copy of Cubatabaco's registered COHIBA design. This proceeding remains pending.

i. Cubatabaco has applied for and obtained the USPTO trademark registrations noted in Paragraphs 9-11, above.

29. [REDACTED]

[REDACTED]

[REDACTED]

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REDACTED

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33. REDACTED

REDACTED

REDACTED

REDACTED

REDACTED

REDACTED

34. I graduated from the Faculty of Law of the University of Havana in 1993 and have been licensed to practice law in Cuba since that time.

35. After graduating from the University of Havana, I completed my social service obligations by working as an *adiestrada*, similar to an attorney trainee, at a *Bufete Colectivo* (collective law firm) in the province of Habana, municipality of Batabano, from 1993 to 1994 and then for three (3) months in 1994 as an *adiestrada* at the *Consultoría Jurídica* in the Cerro municipality in Havana. My responsibilities at the *Consultoría Jurídica* consisted of legal work for Cuban companies, mainly contract and labor issues. My responsibilities at the *Bufete Colectivo* consisted of work for individuals in civil, administrative and criminal matters.

36. My first job after completing my social service was as *asesora jurídica* at the Cuban export company, Cubaníquel, which position I held from 1995 to 2001. My responsibilities included, without limitation, legal work related to counseling as regards contracts, legislation or labor and financial issues. After one to two months working at a Cuban *empresa* dedicated to the export of cultural products and services called Ficsene, I voluntarily left that job and started working as a specialist in commercial policy at the Cuban *Ministerio de Comercio Exterior*. I worked in that position from 2001 to 2003 and my responsibilities



included monitoring and following the work and agenda of international economic organizations, such as the World Trade Organization and the United Nations Conference on Trade and Development (UNCTAD), as well as developing *directivas* for Cuba's participation in these organizations, among other responsibilities. In 2003, I left that position to become Second Secretary of the Permanent Mission of Cuba in Geneva, in which position I worked until 2007. My responsibilities included participation in meetings of the bodies of the World Trade Organization and the World Intellectual Property Organization (WIPO), as a representative of Cuba. In 2007, I returned to Cuba and resumed my position as a specialist in commercial policy at the Cuban *Ministerio de Comercio Exterior*, which in 2009 became the *Ministerio de Comercio Exterior e Inversión Extranjera* (Ministry of Foreign Trade and Investment). I remained in that position until 2012. From 2012-2014, I was appointed as *Consejera Económica y Comercial* at the Cuban Embassy in Uruguay, where I attended to the bilateral commercial issues and served as the *Representante Alterna* (Alternate Representative) of the *Asociación Latinoamericana de Integración* (ALADI) in Montevideo. In 2014, I returned to Cuba and worked as a specialist in commercial policy at the Office of the *Director de Organismos Económicos Internacionales* at the *Ministerio de Comercio Exterior e Inversión Extranjera*. I remained in this position until I began to work at Corporación Habanos, S.A. as its Legal Director on July 12, 2016, the date when I was nominated by the *Junta de Accionistas*.

Executed on: October 2, 2018  
Havana, Cuba

By: [Signature]

Lisset Fernández García

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 1147309  
For the mark COHIBA  
Date registered: February 17, 1981

AND

In the matter of the Trademark Registration No. 1898273  
For the mark COHIBA  
Date registered: June 6, 1995

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EMPRESA CUBANA DEL TABACO, d.b.a.	:	
CUBATABACO,	:	
	:	
Petitioner,	:	
	:	Cancellation No. 92025859
v.	:	
	:	
GENERAL CIGAR CO., INC. and CULBRO	:	
CORP.	:	
	:	
Respondents.	:	
	:	
-----	X	

**DECLARATION OF LISSET FERNÁNDEZ GARCÍA**

**ANNEX A**

**Name of the Party Offering the Exhibit: Empresa Cubana del Tabaco d.b.a. Cubatabaco**

08/24/01 08:32 FAX 0

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GAZETA OFICIAL

29 de Abril de 1962

**POR TANTO:** Mandó que se cumpla y ejecute la presente Ley en todas sus partes.

**DADA:** en el Palacio de la Revolución, en La Habana, a los 15 días del mes de abril de 1962.

**OSVALDO DORTICOS TORRADO**

Viceletrado  
Primer Ministro

**Marcos Fernández Font**  
Ministro del Comercio Exterior

Si

**OSVALDO DORTICOS TORRADO**, Presidente de la República de Cuba

**HAGO SABER:** Que el Consejo de Ministros ha acordado y yo he sancionado lo siguiente:

**POR CUANTO:** El incremento de la demanda interna y externa del tabaco en todas sus formas, precisa la organización de una empresa que, como Organismo Central, abarque todas las actividades relacionadas con el cultivo, producción y distribución, así como la ejecución y operación del comercio exterior de un producto y la dirección técnica de su base agrícola.

**POR TANTO:** En uso de las facultades que le están conferidas, el Consejo de Ministros resuelve dictar la siguiente:

**LEY No. 1191**

**DISPOSICIONES GENERALES**

**ARTICULO 1.**—Se crea una personalidad jurídica independiente y patrimonio y administración propia, la Empresa Cubana del Tabaco, que tendrá las fines y funciones que se determinan en la presente Ley.

La Empresa Cubana del Tabaco, que por esta Ley se crea, será identificada a todos los efectos legales por la sigla "CUBATABACO" y estará sujeta a la legislación mercantil en sus relaciones con terceros, en las operaciones de comercio exterior que realice.

**ARTICULO 2.**—A la Empresa CUBATABACO corresponderá la dirección, ejecución y supervisión de los planes de desarrollo de la economía tabacalera de la Nación y en especial el fomento de la exportación del tabaco.

**ARTICULO 3.**—La Empresa CUBATABACO tendrá su domicilio en la Ciudad de La Habana, República de Cuba, y podrá realizar operaciones mercantiles en todo el territorio nacional y en el extranjero, por medio de las oficinas que a ese fin organice, o a través de los representantes, apoderados o delegados que al efecto designe.

**ARTICULO 4.**—El capital de la Empresa Cubana del Tabaco (CUBATABACO) estará constituido por la suma de \$1,000,000 de los cuales \$100,000 corresponden al Capital de la Empresa Cubana Exportadora de Tabaco, que se le fusiona, y el resto en efectivo será aportado por el Estado cubano.

**ARTICULO 5.**—La Empresa CUBATABACO responderá por su patrimonio de las obligaciones que contraiga al realizar sus operaciones mercantiles y en consecuencia se

deberá responsable de las obligaciones que correspondan a ella, el que tampoco responderá en caso alguno de contraindices por la Empresa.

**De las Funciones**

**ARTICULO 6.**—Para el cumplimiento de los fines en la presente Ley se establecen, la Empresa CUBATABACO deberá:

- a) Realizar estudios económicos relacionados con el desarrollo prospectivo de la economía tabacalera.
- b) Confeccionar el plan anual de la Empresa de acuerdo con las directivas y orientaciones emitidas por la Junta Central de Planificación.
- c) Velar porque el desarrollo de la producción tabacalera en sus distintas fases y aspectos, se realice de acuerdo con la política trazada por el Gobierno revolucionario.
- d) Dirigir, orientar y supervisar técnicamente la producción agrícola tabacalera, tanto en el sector estatal como en el privado, mediante la fijación por zonas las cantidades, tipos y clases de tabaco a producir, la determinación y afectación de nuevas áreas agrícolas, con vista a su desarrollo prospectivo, al establecimiento de normas técnicas para la siembra, cultivo y recolección del tabaco y la organización de centros de experimentación e investigación.
- e) Organizar y ejecutar la producción de semillas y milleros, a fin de lograr pasturas que garanticen máximo de rendimiento y calidad.
- f) Organizar, dirigir, ejecutar y supervisar el cultivo tabacalero, y establecer las normas de selección que rigen en su clasificación, tiempo, beneficio, almacenamiento y fumigación.
- g) Organizar, dirigir, ejecutar y supervisar la producción industrial de tabacos y cigarrillos, teniendo presente la mayor eficiencia, la mayor utilización de la capacidad instalada, el aumento de la productividad, la disminución de los costos y el mejoramiento de la calidad de los productos.
- h) Organizar la adquisición, producción, almacenamiento y distribución de los insumos y demás materiales que se requieren para el abastecimiento de la empresa de los agricultores privados del tabaco, así como adquisición de bienes y activos de cualquier clase y naturaleza que considere necesarios al cumplimiento de sus fines.
- i) Organizar, dirigir y realizar la distribución de tabacos, cigarrillos y raras y demás productos del tabaco en el mercado interno, así como la de los países extranjeros, velando porque las entregas de dichos productos se realicen en unidades de detallistas, lo sean en las cantidades y surtidos necesarios, según los requerimientos de la población.
- j) Impulsar los precios y márgenes comerciales que han de regir para el cultivo del tabaco y la distribución mayorista y minorista del tabaco, cigarrillo y raras y demás productos del tabaco.

P17230

28 de Abril de 1966

GAZETA OFICIAL

35

1) Dirigir las operaciones relativas a la exportación de tabaco en todas sus formas, incluída la gestión de ventas en los mercados extranjeros y, en su caso, las demás operaciones del comercio exterior del tabaco que le asigne el Gobierno, ajustándose a la política comercial que desarrolla el Ministerio del Comercio Exterior.

2) Constituir y administrar reservas de tabaco.

3) Coordinar las medidas destinadas a facilitar el estudio y la implantación de las normas y disposiciones de las materias primas, insumos y demás materiales que regulan la producción tabacalera.

4) Establecer convenientemente medidas, normas y especificaciones destinadas a garantizar la calidad de los productos de la industria tabacalera.

5) Participar en las actividades de cooperación científica y técnica que se realicen en el campo de la economía tabacalera, ya sea en relación con otros organismos nacionales como con los que se desarrollan con otros países por los organismos competentes y coordinar la prestación recíproca de esas actividades, entre las dependencias y unidades.

Del Gobierno y Organización

ARTICULO 7.—El gobierno y administración de la Empresa estarán a cargo de un Director, un Subdirector y un Gerente de Exportación, que tendrán las atribuciones y facultades que se señalan en esta Ley y las que se determinen en el Reglamento Orgánico.

ARTICULO 8.—El Director de la Empresa será designado y removido libremente por el Presidente de la República, quien también nombrará al Subdirector, a propuesta del Director de la Empresa.

El Gerente de Exportación será designado y removido libremente por el Director de la Empresa.

ARTICULO 9.—El Director de la Empresa ostentará su representación legal, sin perjuicio de las facultades que por el Artículo 11 de esta Ley se confieren al Gerente de Exportación y, en su carácter de Jefe Superior en la misma, tendrá facultado para:

a) Ejercer la alta dirección y supervisión de la Empresa, sus dependencias y unidades.

b) Dirigir la formulación, ejecución y control del plan de la Empresa, velando por el estricto cumplimiento de las obligaciones comerciales y financieras de la misma.

c) Acordar, concertar y suscribir a nombre y por cuenta de la Empresa, los contratos y cualesquiera otros documentos que se requieran.

d) Nombrar, promover, trasladar y separar al personal de la Empresa, de acuerdo con la legislación laboral vigente.

e) Contratar el personal técnico y los servicios que correspondan para el cumplimiento de las fun-

1) Dictar, mediante resoluciones, las normas que resulten necesarias para el mejor funcionamiento de la Empresa, sus dependencias y unidades.

2) Delegar cualesquiera de las anteriores facultades y las demás que le correspondan en el Subdirector o en cualquier otro personal dirigente de la Empresa.

ARTICULO 10.—El Subdirector ejercerá las facultades que se le confieren en el Reglamento Orgánico y las que en el diálogo el Director y sustituirá a éste en todos los casos de ausencia temporal.

ARTICULO 11.—El Gerente de Exportación ostentará la representación legal de la Empresa en todas las operaciones y transacciones, relacionadas con la exportación de tabaco en todas sus formas. A esos fines tendrá las atribuciones y facultades que de le asignen en el Reglamento Orgánico y en especial para acordar, concertar y suscribir, a nombre y por cuenta de la Empresa, los contratos y cualesquiera otros documentos públicos o privados que se requieran: otorgar poderes de todas clases y revocarlos; librar, suscribir, aceptar y endosar documentos mercantiles; abrir, operar y cerrar cuentas bancarias, tanto en Cuba como en el extranjero, y realizar cuantas más operaciones a gestiones bancarias y mercantiles autorice la legislación vigente, ejecutándolas por sí o por medio de otras personas en las que delegue sus facultades.

ARTICULO 12.—La Empresa Cubana del Tabaco (CUBATABACO) se organizará internamente en las oficinas, dependencias, unidades y delegaciones provinciales y regionales que se determinen en el Reglamento Orgánico.

ARTICULO 13.—En la Empresa Cubana del Tabaco (CUBATABACO) existirá un Consejo de Dirección que funcionará como órgano asesor del Director, en todos los asuntos en que a su juicio se requiera la discusión y orientación colectiva respecto a la actividad general de la Empresa.

El Consejo de Dirección será presidido por el Director de la Empresa, se reunirá cuando éste lo disponga y se integrará conforme se determinen en el Reglamento Orgánico.

DISPOSICIONES TRANSITORIAS

PRIMERA: Todas las empresas del sector estatal que a la promulgación de esta Ley se encuentren desarrollando actividades relacionadas en cualquier forma con la producción del tabaco, con excepción de las agrícolas, se fusionarán a la Empresa Cubana del Tabaco (CUBATABACO), que por esta Ley se crea.

Como consecuencia de la fusión que por esta Disposición Transitoria se establece, se asignan a la Empresa Cubana del Tabaco (CUBATABACO), todos los fondos, equipos, archivos, documentos y personal, incluído los medios básicos, circulantes y financieros que están asignados o corresponden a las empresas que se le fusionan.

SEGUNDA: El Director de la Empresa Cubana del Tabaco (CUBATABACO), coordinará con los Ministros y jefes de los organismos que correspondan, los traslados de personal, unidades y funciones que correspondan.

P17231

**TERCERA:** Hasta tanto se dicte el Reglamento Orgánico al Director de la Empresa Cubana del Tabaco (CUBATABACO), asumirá, en adición a las atribuciones y funciones que se le confieren en esta Ley, cuantas más sean necesarias al cumplimiento de las mismas para los cuales ha sido creada la Empresa, quedando autorizada para, mediante resoluciones, disponer su estructura orgánica y dictar los reglamentos y demás disposiciones por las que habrán de regirse las oficinas, dependencias, unidades y delegaciones Provinciales y Regionales de la Empresa.

**CUARTA:** Se faculta al Presidente del Banco Nacional de Cuba para hacer las remisiones de créditos y sujeción de consignaciones en el Presupuesto Nacional que fueren necesarias para el cumplimiento de lo dispuesto en esta Ley.

### DISPOSICIONES FINALES

**PRIMERA:** La Empresa Cubana del Tabaco (CUBATABACO), que por esta Ley se crea, se subroga en las acciones y derechos y se sustituye en las obligaciones contractuales y extracontractuales de la Empresa Cubana Exportadora de Tabaco (CUBATABACO), creada por la Resolución número 2 de primero de enero de 1962, del Ministro del Comercio Exterior, de la que es sucesora y continuadora.

**SEGUNDA:** Se faculta al Director de la Empresa Cubana del Tabaco (CUBATABACO) para dictar el Reglamento Orgánico de la Empresa.

**TERCERA:** Se autoriza al Ministro de Justicia para tramitar, en la forma y bajo las condiciones que estime oportunas, a la Empresa Cubana del Tabaco (CUBATABACO) que por esta Ley se crea, todas las modalidades de propiedad industrial que se refieran al tabaco, que haya adquirido o adquiriera, por cualquier título, el Estado cubano, ya se encuentren inscritas o no a su favor en los Registros correspondientes.

**CUARTA:** Se derogan cuantas disposiciones legales y reglamentarias se opongan al cumplimiento de lo dispuesto en la presente Ley, la que comenzará a regir a partir de su publicación en la GACETA OFICIAL de la República.

**POR TANTO:** Mando que se cumpla y ejecute la presente Ley en todas sus partes.

DADO en el Palacio de la Revolución, en La Habana, a los 35 días del mes de abril de 1964.

**OSVALDO DORTICOS TORRADO**

Fidel Castro Ruz  
Primer Ministro

José Domínguez Benítez  
Ministro de Industrias

**DECRETO No. 2214**  
En uso de las facultades de que estoy investido, a propuesta del Ministro de Justicia y asistido del Consejo de Ministros,

**Resuelve:**  
Aceptar la renuncia que del cargo de Teniente Fiscal de la Audiencia de Santiago de Cuba ha presentado el doctor José Víctor Casasús Martín.  
El Ministro de Justicia queda encargado del cumplimiento de lo que por el presente Decreto se dispone.

DADO en el Palacio de la Revolución, en La Habana, a 15 de marzo de 1966.

**OSVALDO DORTICOS TORRADO**  
Presidente

Fidel Castro Ruz  
Primer Ministro

Alfredo Yabar Matuf

Ministro de Justicia

**DECRETO No. 2235**  
En uso de las facultades de que estoy investido, a propuesta del Ministro de Justicia y asistido del Consejo de Ministros,

**Resuelve:**

Aceptar la renuncia, que del cargo de Teniente Fiscal de la Audiencia de Santiago de Cuba ha presentado el doctor Teobaldo Marcelino Vinaso Padron.

El Ministro de Justicia queda encargado del cumplimiento de lo que por el presente Decreto se dispone.

DADO en el Palacio de la Revolución, en La Habana, a 15 de marzo de 1966.

**OSVALDO DORTICOS TORRADO**  
Presidente

Fidel Castro Ruz  
Primer Ministro

Alfredo Yabar Matuf  
Ministro de Justicia

**DECRETO No. 2236**  
En uso de las facultades de que estoy investido, a propuesta del Ministro de Justicia y asistido del Consejo de Ministros,

**Resuelve:**

Aceptar la renuncia presentada por el doctor Vidal Morales y Calvo, del cargo de Registrador de la Propiedad de Matanzas, en el territorio de la Audiencia de Matanzas, declarando vacante dicho cargo.

El Ministro de Justicia queda encargado del cumplimiento de lo que por el presente Decreto se dispone.

DADO en el Palacio de la Revolución, en La Habana, a 24 de marzo de 1966.

**OSVALDO DORTICOS TORRADO**  
Presidente

Fidel Castro Ruz  
Primer Ministro


Alfredo Yabar Matuf  
Ministro de Justicia

Declaration of Translation  
of Ley No. 1191 (P17230-17232)

Debra Evenson declares under penalty of perjury under the laws of the United States that the following is true and correct:

1. I am a lawyer, licensed to practice law in the State of New York, and am of counsel to the law firm Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C. I was professor of law at DePaul University School of Law from 1980-1993 where I taught comparative international law. I am fluent in the Spanish language.
2. I translated Ley No. 1191 (P17230-17232) from Spanish into English. I attach hereto a copy of the original documents in Spanish and the translation thereof which is a true and correct translation into English.

Signed this 14<sup>th</sup> day of January of 2002

  
DEBRA EVENSON

Translation of Ley No. 1191 (P17230-33)

OSVALDO DORTICOS TORRADO, President of the Republic of Cuba

**MAKES KNOWN:** That the Council of Ministers has resolved and I have sanctioned the following:

**WHEREAS:** The increase in the internal and foreign demand for tobacco in all its forms, requires the organization of an enterprise which, as a Central Organism, covers all of the activities related to the cultivation, production and distribution, as well as the execution and operation of foreign commerce of that product and the technical direction in its agricultural phase.

**THEREFORE:** In use of the powers conferred on it, the Council of Ministers resolves to enact the following:

Law No. 1191

#### GENERAL PROVISIONS

**ARTICLE 1. -** The Empresa Cubana del Tabaco is created with independent legal personality and patrimony and its own administration, which will have the objectives and functions that are determined by the present Law.

The Empresa Cubana del Tabaco, which is created by this law, shall be identified for all legal effects by the name CUBATABACO and shall be subject to the commercial legislation in its relations with third parties in the foreign commercial operations it undertakes.

**ARTICLE 2. -** The direction, execution and supervision of the plans of development of the tobacco economy of the Nation and in especial the promotion of the export of tobacco corresponds to the enterprise CUBATABACO.

**ARTICLE 3. -** The enterprise CUBATABACO will have its domicile in the City of Havana, Republic de Cuba, and shall undertake mercantile operations in all of the national territory and in the world, by means of offices which for this purpose it may organize, or through representatives, agents or delegates which it may designate for this purpose.

**ARTICLE 4. -** The capital of the Empresa Cubana del Tabaco (CUBATABACO) shall be comprised of the sum of \$1,000,000 of which \$100,000 corresponds to the Capital of the Empresa Cubana Exportadora de Tabaco, which is merged into it, and the rest in cash will be provided by the Cuban State.

**ARTICLE 5. -** The Empresa CUBATABACO will respond with its own patrimony for the obligations which it contracts to undertake its commercial operations

and consequently will not be liable for the obligations of the State, which will also not be liable in any case for those contracted by the Empresa.

#### On the Functions

ARTICLE 6. -- For the fulfillment of the purposes of the present Law it is established that the Empresa CUBATABACO shall:

- a) Undertake economic studies related to the economic perspective of the tobacco economy.
- b) Draw up the annual plan of the Empresa in accord with the directives and orientations issued by the Central Planning Board.
- c) Oversee that the development of the tobacco production in its distinct phases and aspects is undertaken according to the policy outlined by the revolutionary Government.
- d) Direct, orient and supervise technically the tobacco agricultural production, in the state as well as in the private sector, by establishing by zones the quantities, types and classes of tobacco to be produced and the determination and adoption of new areas for planting, with a view toward the future development, the establishment of technical norms for the planting and the harvesting of tobacco and the organization of centers of experimentation and research.
- e) Organize and execute the production of seeds and seedbeds to achieve seedlings that guarantee the maximum yield and quality.
- f) Organize, direct, execute and supervise the storing of tobacco and establish the norms for the selection that govern its classification, purchase, benefit, storage and fumigation.
- g) Organize, direct, execute and supervise the industrial production of cigars and cigarettes, with the objective of greatest efficiency, the best utilization of the installed capacity, the increase of the production, the reduction of costs and the improvement of the quality of the products.
- h) Organize the acquisition, production, warehousing and distribution of the supplies and other materials that are required for the supply of the enterprise and of the private tobacco farmers as well as the acquisition of the assets and goods of whatever character and nature which are considered necessary for the fulfillment of its purposes.
- i) Organize, direct and undertake the distribution of cigars, cigarettes and leaf and other tobacco products in the internal market, as well as the (illegible)



watching out that the deliveries of said products to the retailers be in the quantities and the types necessary, according to the requirements of the population.

- j) Propose the prices and commercial margins that should govern the harvest of tobacco and the wholesale and retail distribution of cigars, cigarettes and leaf and other tobacco products.
- k) Execute the operations related to the export of tobacco in all of its forms, including the conduct of sale in foreign markets and, as may be the case, the other operations of foreign commerce of tobacco that the Government may assign it, adjusting to the commercial policy that the Ministry of Foreign Commerce develops.
- l) Constitute and administer tobacco reserves.
- m) Coordinate the measures destined to facilitate the study and implementation of the norms and specifications of the raw materials, supplies and other materials the tobacco production requires.
- n) Participate in the activities of scientific cooperation and technical assistance that may be carried out in the field of the tobacco economy, as related to other national organisms as well as to that which may develop with other countries by the competent organisms and coordinate the reciprocal offering of these activities among its dependencies and units.

#### On Government and Organization

ARTICLE 7. - The government and administration of the Enterprise shall be assigned to a Director, a Vice Director and an Export Manager, that shall have the powers and faculties that are indicated in this law and those that are determined by its Organic Regulations.

ARTICLE 8. - The Director of the Enterprise shall be designated and freely removed by the President of the Republic, who also shall name the Vice Director, at the proposal of the Director of the Enterprise.

The Manager of Export shall be designated and freely removed by the Director of the Enterprise.

ARTICLE 9. - The Director of the Enterprise shall hold its legal representation without prejudice to the faculties that are conferred on the Manager of Export by Article 11 of this Law, and in his character as Superior Chief of same, shall be empowered to:

- a) Exercise the top direction and supervision of the Enterprise, its dependencies and units.
- b) Direct the formulation, execution and control of the plan of the Enterprise, overseeing the strict fulfillment of the commercial and financial obligations of the same.
- c) Agree to, contract and sign on behalf and on account of the Enterprise, the contracts and whatever other documents that may be required.
- d) Name, promote, transfer and dismiss the personnel of the Enterprise, in accordance with the labor legislation in force.
- e) Contract the technical personnel and services which he considers necessary for the fulfillment of the (illegible)
- f) Dictate, by means of resolutions, the norms that are necessary for the better functioning of the Enterprise, its dependents and units.
- g) Delegate whatever of the above mentioned powers and others that may correspond to him to the Vice Director or to whatever other management personnel of the Enterprise.

ARTICLE 10. – The Vice Director shall exercise the powers that are conferred on him in the Organic Regulation and those that the Director may delegate to him and to substitute for the Director in any case of temporary absence.

ARTICLE 11. – The Manager of Export shall hold the legal representation of the Enterprise in all of the operations and transactions related to the export of tobacco in all of its forms. To these ends, he shall have the attributes and powers that the Organic Regulation may assign him and especially to agree to, contract and sign in the name and on the account of the Enterprise, all contracts and whatever other public and private documents may be required; grant powers of all classes and revoke them; issue, sign, accept and endorse commercial documents; open, operate and close bank accounts, in Cuba as well as abroad, and undertake other operations or banking and mercantile actions that the legislation in force authorizes, executing them himself or through other persons to whom he may delegate his powers.

ARTICLE 12. – The Empresa Cubana del Tabaco (CUBATABACO) shall be organized internally in the offices, dependencies, units and provincial and regional delegations that are determined in the Organic Regulation.

ARTICLE 13. – There shall exist a Council of Direction in the Empresa Cubana del Tabaco (CUBATABACO) that shall function as the advisory body of the Director in all the matters which, in his judgment, require the discussion and collective guidance with respect to the general activity of the Enterprise.

The Council of Direction shall be presided over by the Director of the Enterprise, shall meet when he decides and shall be composed according to that determined in the Organic Regulation.

### TRANSITORY DISPOSITIONS

FIRST: All the enterprises of the state sector which at the time of the promulgation of this Law are found developing activities related in whatever form to the production of tobacco, except the agricultural activities, shall be merged into the Empresa Cubana del Tabaco (CUBATABACO) which is created by this Law.

As a consequence of the merger established by this Transitory Disposition, the Empresa Cubana del Tabaco (CUBATABACO) is assigned all of the funds, equipment, files, documents and personnel, including the basic means, cash and finances which are assigned or correspond to the enterprises which are merged into it.

SECOND. – The Director of the Empresa Cubana de Tabaco (CUBATABACO), shall coordinate with the Ministries and heads of the corresponding bodies, the transfers of enterprises, (illegible) and functions (illegible)...

THIRD. – Until such time as the Organic regulation is dictated, the Director of the Empresa Cubana del Tabaco (CUBATABACO) shall assume in addition to the attributes and powers conferred on him in this Law, all those necessary for the fulfillment of the purposes for which the Empresa has been created, being authorized through resolutions to set out its organic structure and enact rules and other dispositions which shall govern the offices, dependencies, units and Provincial and Regional delegations of the Enterprise.

### FINAL DISPOSITIONS

FIRST. – The Empresa Cubana del Tabaco (CUBATABACO), created by this Law, is subrogated to the assets and rights and substitutes in the contractual and extra contractual obligations of the Empresa Cubana Exportadora de Tabaco (CUBATABACO), created by Resolution number 2 of the first of January of 1962, by the Ministry of Foreign Commerce, of which it is the successor and continuation.

SECOND. – The Director of the Empresa Cubana del Tabaco (CUBATABACO) is empowered to enact the Organic Regulation of the Enterprise.

THIRD. – The Minister of Justice is authorized to issue in the form and under the conditions he believes appropriate to the Empresa Cubana del Tabaco (CUBATABACO) THAT THIS Law creates, all of the modalities of industrial property that refer to tobacco, which the Cuban State has acquired or may acquire by whatever title, whether found registered or not in its favor in the corresponding registries.

FOURTH. – All legal dispositions and regulations in conflict with the fulfillment of that set forth in the present Law, which will go into force from the time of its publication in the Official Gazette of the republic, are repealed.

THEREFORE: I mandate that the present Law be fulfilled and executed in all its parts.

GIVEN en the Palace of the Revolution in Havana, the 25<sup>th</sup> day of the month of April of 1966.

OSVALDO DORTICOS TORRADO

Fidel Castro Ruz  
Prime Minister

Joel Dominican Benitez  
Minister of Industries

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 1147309  
For the mark COHIBA  
Date registered: February 17, 1981

AND

In the matter of the Trademark Registration No. 1898273  
For the mark COHIBA  
Date registered: June 6, 1995

-----	X	
EMPRESA CUBANA DEL TABACO, d.b.a.	:	
CUBATABACO,	:	
	:	
Petitioner,	:	
	:	Cancellation No. 92025859
v.	:	
	:	
GENERAL CIGAR CO., INC. and CULBRO	:	
CORP.	:	
	:	
Respondents.	:	
	:	
-----	X	

**DECLARATION OF LISSET FERNÁNDEZ GARCÍA**

**ANNEX B**

**Name of the Party Offering the Exhibit: Empresa Cubana del Tabaco d.b.a. Cubatabaco**

REDACTED

CONFIDENTIAL UNDER  
PROTECTIVE ORDER

FOR MORGAN & FINNEGAN'S  
EYES ONLY  
UNDER COURT ORDER

P10035

Box 412-3

REDACTED

REDACTED



REDACTED

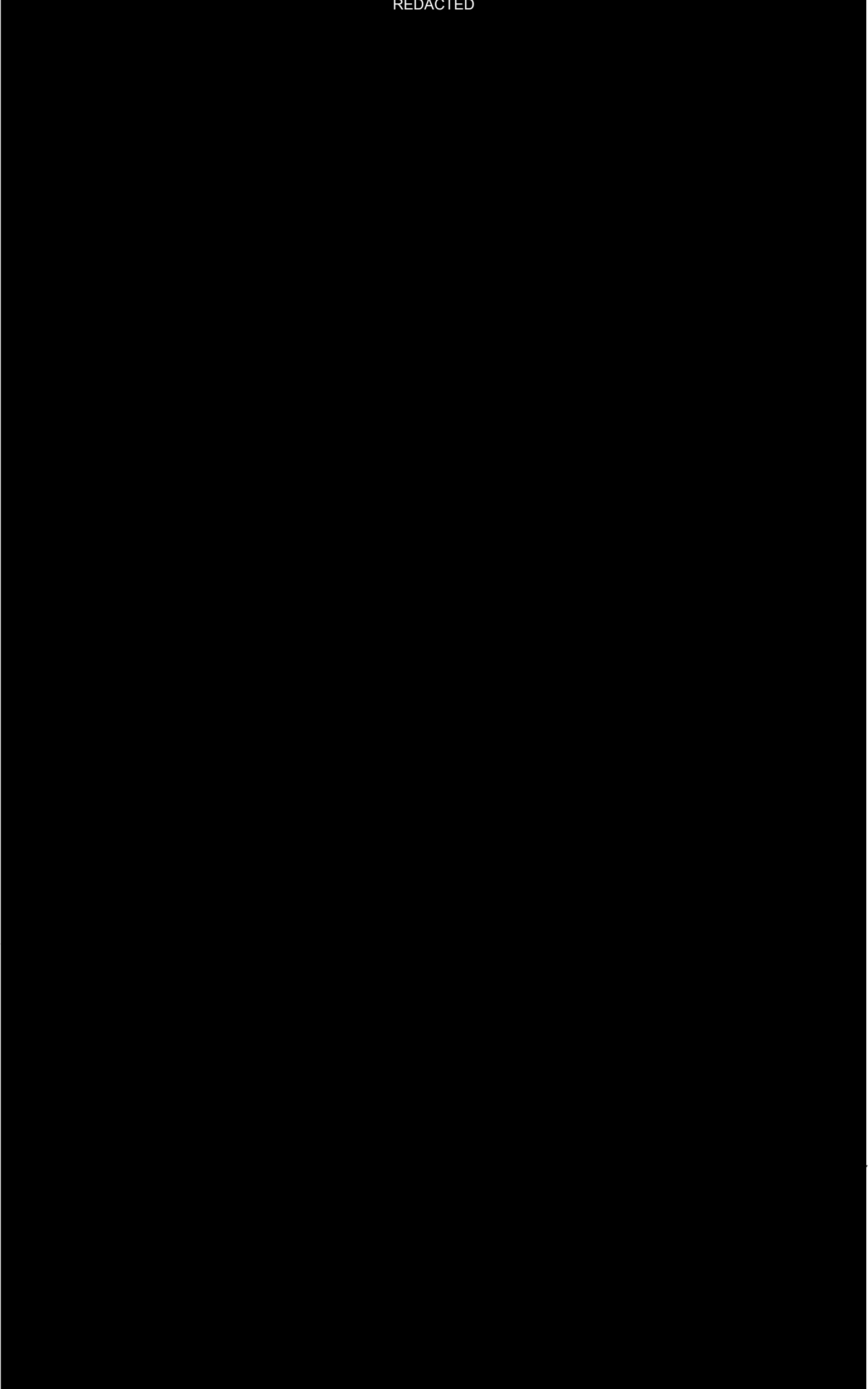
CONFIDENTIAL UNDER  
PROTECTIVE ORDER

FOR MORGAN & FINNEGAN'S  
EYES ONLY  
UNDER COURT ORDER

P10038



REDACTED



REDACTED

REDACTED

REDACTED

REDACTED



## **CERTIFICATE OF TRANSLATION**

**I, Nahum Hahn, am competent to translate from Spanish into English, and certify that the translation of the attached document, “REDACTED”, is true and accurate to the best of my abilities.**

**October 4, 2018**

A handwritten signature in black ink, appearing to be 'N. Hahn', written over the printed name.

**Nahum Hahn**

**161 Gordonhurst Ave.**

**Montclair, NJ 07043**

**(917) 680-4699**

[Translation from Spanish into English]

REDACTED



[Stamp in English:]  
CONFIDENTIAL UNDER  
PROTECTIVE ORDER

[Stamp in English:]  
FOR MORGAN & FINNEGAN'S  
EYES ONLY  
UNDER COURT ORDER

P10035  
*Box 42 3*

REDACTED



[Stamp in English:]  
CONFIDENTIAL UNDER  
PROTECTIVE ORDER

[Stamp in English:]  
FOR MORGAN & FINNEGAN'S  
EYES ONLY  
UNDER COURT ORDER

P10036

REDACTED



[Stamp in English:]  
CONFIDENTIAL UNDER  
PROTECTIVE ORDER

[Stamp in English:]  
FOR MORGAN & FINNEGAN'S  
EYES ONLY  
UNDER COURT ORDER

P10037

REDACTED



[Stamp in English:]  
CONFIDENTIAL UNDER  
PROTECTIVE ORDER

[Stamp in English:]  
FOR MORGAN & FINNEGAN'S  
EYES ONLY  
UNDER COURT ORDER

P10038

REDACTED



[Stamp in English:]  
CONFIDENTIAL UNDER  
PROTECTIVE ORDER

[Stamp in English:]  
FOR MORGAN & FINNEGAN'S  
EYES ONLY  
UNDER COURT ORDER

P10039

REDACTED



[Stamp in English:]  
CONFIDENTIAL UNDER  
PROTECTIVE ORDER

[Stamp in English:]  
FOR MORGAN & FINNEGAN'S  
EYES ONLY  
UNDER COURT ORDER

P10040

REDACTED



[Stamp in English:]  
CONFIDENTIAL UNDER  
PROTECTIVE ORDER

[Stamp in English:]  
FOR MORGAN & FINNEGAN'S  
EYES ONLY  
UNDER COURT ORDER

P10041



REDACTED



[Stamp in English:]  
CONFIDENTIAL UNDER  
PROTECTIVE ORDER

[Stamp in English:]  
FOR MORGAN & FINNEGAN'S  
EYES ONLY  
UNDER COURT ORDER

P10042

REDACTED



[Stamp in English:]  
CONFIDENTIAL UNDER  
PROTECTIVE ORDER

[Stamp in English:]  
FOR MORGAN & FINNEGAN'S  
EYES ONLY  
UNDER COURT ORDER

P10043

REDACTED

[Stamp in English:]  
CONFIDENTIAL UNDER  
PROTECTIVE ORDER

[Stamp in English:]  
FOR MORGAN & FINNEGAN'S  
EYES ONLY  
UNDER COURT ORDER

P10044

REDACTED



[Stamp in English:]  
CONFIDENTIAL UNDER  
PROTECTIVE ORDER

[Stamp in English:]  
FOR MORGAN & FINNEGAN'S  
EYES ONLY  
UNDER COURT ORDER

P10045

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of Trademark Registration No. 1147309  
For the mark COHIBA  
Date registered: February 17, 1981

AND

In the matter of the Trademark Registration No. 1898273  
For the mark COHIBA  
Date registered: June 6, 1995

-----	X	
EMPRESA CUBANA DEL TABACO, d.b.a.	:	
CUBATABACO,	:	
	:	
Petitioner,	:	
	:	Cancellation No. 92025859
v.	:	
	:	
GENERAL CIGAR CO., INC. and CULBRO	:	
CORP.	:	
	:	
Respondents.	:	
	:	
-----	X	

**DECLARATION OF LISSET FERNÁNDEZ GARCÍA**

**ANNEX C**

**Name of the Party Offering the Exhibit: Empresa Cubana del Tabaco d.b.a. Cubatabaco**

REDACTED

REDACTED

REDACTED



REDACTED



# **CERTIFICATE OF TRANSLATION**

**I, Nahum Hahn, am competent to translate from Spanish into English, and certify that the**

**translation of the attached document, “**REDACTED**”**

**REDACTED s true and accurate to the best of my abilities.**

**October 4, 2018**



**Nahum Hahn**

**161 Gordonhurst Ave.**

**Montclair, NJ 07043**

**(917) 680-4699**

REDACTED



CT0033810

REDACTED



CT0033811

REDACTED



CT0033812

REDACTED



CT0033813

**CERTIFICATE OF SERVICE**

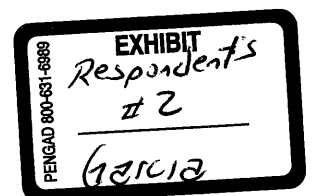
The undersigned certifies that a true and correct copy of the foregoing the DECLARACIÓN DE

LISSET FERNÁNDEZ GARCÍA was served by email on Respondent on October 6, 2018 to:

Andrew L. Deutsch  
Rodrigues, Airina  
DLA Piper US LLP  
1251 Avenue of the Americas  
New York, NY 10020  
Telephone: (212) 335-4673  
[andrew.deutsch@dlapiper.com](mailto:andrew.deutsch@dlapiper.com)  
[Airina.Rodrigues@dlapiper.com](mailto:Airina.Rodrigues@dlapiper.com)

\_\_\_\_\_/Lindsey Frank/\_\_\_\_\_  
\_\_\_\_\_

# EXHIBIT 2





**Int. Cl.: 34**

**Prior U.S. Cl.: 17**

**United States Patent and Trademark Office**

**Reg. No. 1,147,309**

**Registered Feb. 17, 1981**

**TRADEMARK**  
**Principal Register**

**COHIBA**

**Culbro Corporation (New York corporation)**  
**605 3rd Ave.**  
**New York, N.Y. 10016**

**For: CIGARS, in CLASS 34 (U.S. Cl. 17).**  
**First use Feb. 13, 1978; in commerce Feb. 13,**  
**1978.**

**Ser. No. 161,879, filed Mar. 13, 1978.**

**DAVID C. REIHNER, Primary Examiner**

**Int. Cl.: 34**

**Prior U.S. Cl.: 17**

**United States Patent and Trademark Office**

**Reg. No. 1,147,309**

**Registered Feb. 17, 1981**

**TRADEMARK**  
**Principal Register**

**COHIBA**

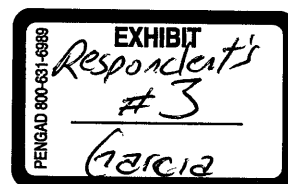
**Culbro Corporation (New York corporation)**  
**605 3rd Ave.**  
**New York, N.Y. 10016**

**For: CIGARS, in CLASS 34 (U.S. Cl. 17).**  
**First use Feb. 13, 1978; in commerce Feb. 13,**  
**1978.**

**Ser. No. 161,879, filed Mar. 13, 1978.**

**DAVID C. REIHNER, Primary Examiner**

# EXHIBIT 3



Int. Cl.: 34

Prior U.S. Cl.: 17

**United States Patent and Trademark Office**

Reg. No. 1,898,273

Registered June 6, 1995

**TRADEMARK  
PRINCIPAL REGISTER**

**COHIBA**

GENERAL CIGAR CO., INC. (DELAWARE  
CORPORATION)  
320 WEST NEWBERRY ROAD  
BLOOMFIELD, CT 06002

FOR: CIGARS, IN CLASS 34 (U.S. CL. 17).  
FIRST USE 12-0-1992; IN COMMERCE  
12-0-1992, FIRST USED IN COMMERCE IN AN-  
OTHER FORM IN FEBRUARY 1978.

OWNER OF U.S. REG. NO. 1,147,309.  
UPON INFORMATION AND BELIEF,  
"COHIBA" IS A CONJUGATIVE FORM OF THE  
SPANISH WORD "COHIBIR", WHICH MEANS  
"TO RESTRAIN" OR "COHIBIT".

SN 74-344,349, FILED 12-30-1992.

R. G. COLE, EXAMINING ATTORNEY

Int. Cl.: 34

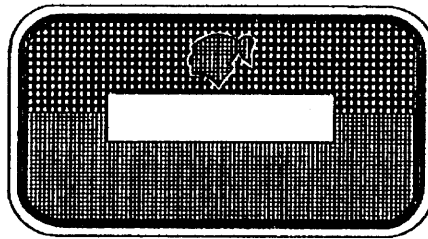
Prior U.S. Cls.: 2, 8, 9 and 17

Reg. No. 2,145,804

**United States Patent and Trademark Office**

Registered Mar. 24, 1998

**TRADEMARK  
PRINCIPAL REGISTER**



EMPRESA CUBANA DEL TABACO (CUBA CORPORATION), DBA CUBATABACO  
O'REILLY NO. 104  
CIUDAD LA HABANA, CUBA

FOR: RAW TOBACCO, CIGARS, CIGARETTES, CUT TOBACCO, RAPPEE, MATCHES, TOBACCO, TOBACCO PIPES, PIPE-HOLDERS, ASHTRAYS NOT OF PRECIOUS METAL, MATCH BOXES, CIGAR CASES NOT OF PRECIOUS METAL, AND HUMIDORS, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

OWNER OF CUBA REG. NO. 123125, DATED 2-6-1996, EXPIRES 1-10-2005.

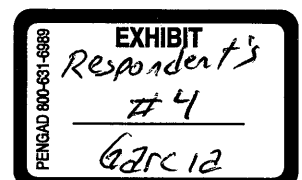
THE MARK IS LINED FOR THE COLOR GOLD. THE BOLDLY LINED SECTION OF

THE DRAWING, HOWEVER, DOES NOT INDICATE COLOR, BUT IS A FEATURE OF THE MARK.

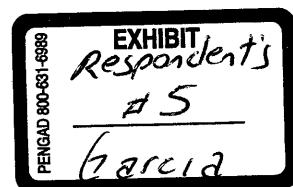
THE MARK CONSISTS OF A RECTANGULAR DESIGN WITH ROUNDED CORNERS, A GOLD OUTLINE, THE SILHOUETTE OF A HEAD OF AN INDIAN AGAINST A BLACK AND WHITE DOTTED BACKGROUND, A WHITE RECTANGLE, AND A GOLD RECTANGLE.

SER. NO. 75-151,226, FILED 8-16-1996.

DAVID C. REIHNER, EXAMINING ATTORNEY

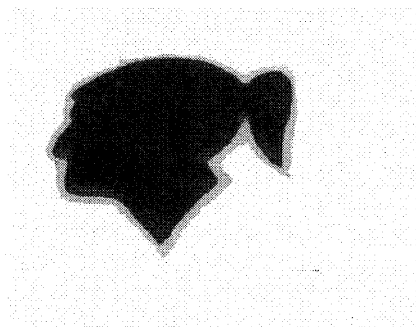


# EXHIBIT 5



# United States of America

United States Patent and Trademark Office



**Reg. No. 4,988,587**

**Registered June 28, 2016**

**Int. Cl.: 34**

**TRADEMARK**

**PRINCIPAL REGISTER**

EMPRESA CUBANA DEL TABACO (CUBA EMPRESA ESTATAL), DBA CUBATABACO  
CALLE NUEVA 75 ENTRE UNIVERSIDAD Y PEDRO  
CERRO, LA HABANA, CUBA 0

FOR: ASHTRAYS; CIGAR CASES; CIGAR CUTTERS; CIGARETTES; CIGARILLOS; CIGARS;  
MATCH BOXES; MATCHES; PIPE TOBACCO, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

OWNER OF CUBA REG. NO. 2013-0209, DATED 4-12-2013, EXPIRES 4-12-2023.

THE MARK CONSISTS OF A SILHOUETTE OF A HEAD WITH A PONYTAIL IN PROFILE.

SER. NO. 86-815,550, FILED 11-10-2015.

ROSELLE HERRERA, EXAMINING ATTORNEY



*Michelle K. Lee*

Director of the United States  
Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

**First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

**Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
See 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

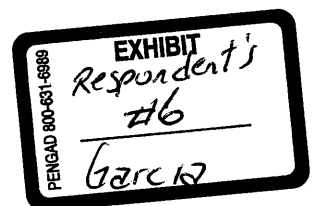
**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE:** Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

**NOTE:** A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at <http://www.uspto.gov>.



# EXHIBIT 6



Int. Cl.: 34

Prior U.S. Cls.: 8, 9 and 17

Reg. No. 1,557,163

United States Patent and Trademark Office Registered Sep. 19, 1989

TRADEMARK  
PRINCIPAL REGISTER



EMPRESA CUBANA DEL TABACO (CUBA  
CORPORATION)  
O'REILLY 104 STREET  
HAVANA CITY, CUBA

FOR: RAW TOBACCO; CIGARS, CIGARETTES, CUT TOBACCO, RAPPEE, MANUFACTURED TOBACCO OF ALL KINDS, MATCHES, TOBACCO-PIPES, PIPE HOLDERS, ASHTRAYS, MATCH BOXES, CIGAR CASES, HUMIDORS, IN CLASS 34 (U.S. CLS. 8, 9 AND 17).

OWNER OF CUBA REG. NO. 36987, DATED 12-24-1987, EXPIRES 12-24-1997.

OWNER OF U.S. REG. NO. 1,441,404.

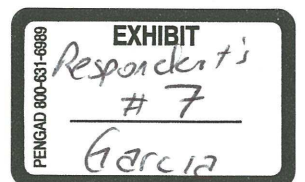
THE DRAWING OF THE MARK IS LINED FOR THE COLORS YELLOW AND GOLD.

THE ENGLISH TRANSLATION OF THE WORD "BEHIKE" IN THE MARK IS "INDO-CUBAN WITCH DOCTOR".

SER. NO. 742,915, FILED 7-29-1988.

ALICE SUE CARRUTHERS, EXAMINING ATTORNEY

# EXHIBIT 7



Int. Cl.: 34

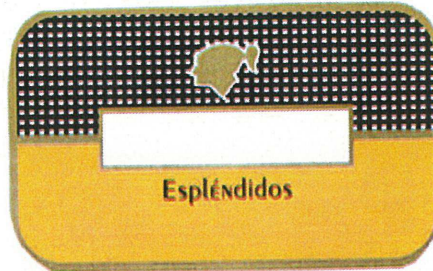
Prior U.S. Cls.: 2, 8, 9 and 17

**United States Patent and Trademark Office**

Reg. No. 3,402,158

Registered Mar. 25, 2008

**TRADEMARK  
PRINCIPAL REGISTER**



EMPRESA CUBANA DEL TABACO (CUBATABACO) (CUBA CORPORATION)

O'REILLY 104, HABANA VIEJA

CIUDAD DE LA HABANA

CUBA

FOR: RAW TOBACCO, PROCESSED TOBACCO FOR SMOKING, CHEWING OR AS SNUFF, CIGARETTE, SMALL CIGARS, FINE-CUT TOBACCO, SMOKERS' ARTICLES, NAMELY, ASHTRAYS, CIGAR CUTTERS, MATCH BOXES, CIGAR CASES, AND MATCHES, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

PRIORITY DATE OF 7-17-2006 IS CLAIMED.

OWNER OF INTERNATIONAL REGISTRATION  
0931046 DATED 12-18-2006, EXPIRES 12-18-2016.

THE COLOR(S) GOLD, BLACK, WHITE, YELLOWISH ORANGE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

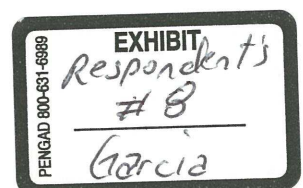
THE MARK CONSISTS OF A RECTANGULAR SHAPE WITH CURVED CORNERS, OUTLINED IN GOLD. THE TOP HALF IS BLACK WITH WHITE DOTS, AND CONTAINS THE SILHOUETTE OF A HEAD OF AN INDIAN IN GOLD, OUTLINED IN WHITE. THE BOTTOM HALF IS IN YELLOWISH ORANGE, AND CONTAINS THE WORD ESPLÉNDIDOS IN BLACK. THE RECTANGLE IS DIVIDED IN HALF WITH A GOLD LINE, AND A WHITE RECTANGLE IN THE CENTER OF THE MARK. "

THE ENGLISH TRANSLATION OF THE FOREIGN WORD(S) IN THE MARK IS: "SPLENDID."

SER. NO. 79-041,168, FILED 12-18-2006.

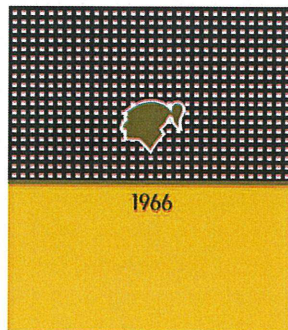
EUGENIA MARTIN, EXAMINING ATTORNEY

# EXHIBIT 8



# United States of America

United States Patent and Trademark Office



**Reg. No. 4,244,461**

**Registered Nov. 20, 2012**

**Int. Cl.: 34**

**TRADEMARK**

**PRINCIPAL REGISTER**

EMPRESA CUBANA DEL TABACO (CUBATABACO) (CUBA EMPRESA ESTATAL)  
O'REILLY NO.104 ENTRE TACON Y MERCADERES  
CIUDAD DE LA HABANA, CUBA

FOR: ASHTRAYS; CIGAR CASES; CIGAR CUTTERS; MATCH BOXES; MATCHES; PIPE  
TOBACCO; TOBACCO, CIGARS AND CIGARETTES, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND  
17).

PRIORITY CLAIMED UNDER SEC. 44(D) ON CUBA APPLICATION NO. 2011-0355, FILED  
7-7-2011, REG. NO. 2011-0355, DATED 7-7-2011, EXPIRES 7-7-2021.

THE COLOR(S) WHITE, BLACK, GOLD AND YELLOWISH ORANGE IS/ARE CLAIMED  
AS A FEATURE OF THE MARK.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "1966", APART FROM THE  
MARK AS SHOWN.

THE MARK CONSISTS OF A RECTANGLE THE TOP HALF OF WHICH IS BLACK WITH  
WHITE DOTS, AND CONTAINS THE SILHOUETTE OF A HEAD OF AN INDIAN IN GOLD,  
OUTLINED IN WHITE. THE BOTTOM HALF IS IN YELLOWISH ORANGE, AND CONTAINS  
THE NUMBER "1966" IN BLACK. THE RECTANGLE IS DIVIDED IN HALF WITH A GOLD  
LINE.

SER. NO. 85-415,744, FILED 9-6-2011.

VIVIAN MICZNIK FIRST, EXAMINING ATTORNEY



*David J. Kappas*

Director of the United States Patent and Trademark Office



**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***  
**What and When to File:**

**First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. See 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

**Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between the 9th and 10th years after the registration date.\*  
See 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***  
**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) and an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

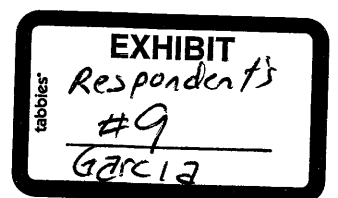
The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. See 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. See 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE:** Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

# EXHIBIT 9





Int. Cl.: 34

Prior U.S. Cls.: 2, 8, 9 and 17

**United States Patent and Trademark Office**

Reg. No. 1,970,911

Registered Apr. 30, 1996

**TRADEMARK  
PRINCIPAL REGISTER**



EMPRESA CUBANA DEL TABACO (CUBA  
CORPORATION), DBA CUBATABACO  
CALLE O'REILLY NO. 104  
CIUDAD HABANA, CUBA

FOR: RAW TOBACCO; CIGARS; CIGARETTES; CUT TOBACCO; RAPPEE; MANUFACTURED TOBACCO OF ALL KINDS; MATCHES; TOBACCO; SMOKING PIPES; PIPE-HOLDERS, NOT OF PRECIOUS METAL; ASH-TRAYS, NOT OF PRECIOUS METAL; MATCH BOXES, CIGAR CASES AND HUMIDORS, NOT OF PRECIOUS METAL, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

OWNER OF CUBA REG. NO. 118875, DATED 8-5-1991, EXPIRES 8-5-2001.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CUBAN CIGAR", APART FROM THE MARK AS SHOWN.

THE ENGLISH TRANSLATION OF "LA CASA DEL HABANO" IS "THE HOUSE OF THE CUBAN CIGAR".

SER. NO. 74-576,950, FILED 9-22-1994.

JYLL A. SMITH, EXAMINING ATTORNEY

Int. Cl.: 34

Prior U.S. Cls.: 2, 8, 9 and 17

United States Patent and Trademark Office

Reg. No. 1,970,911

Registered Apr. 30, 1996

**TRADEMARK  
PRINCIPAL REGISTER**



EMPRESA CUBANA DEL TABACO (CUBA  
CORPORATION), DBA CUBATABACO  
CALLE O'REILLY NO. 104  
CIUDAD HABANA, CUBA

FOR: RAW TOBACCO; CIGARS; CIGARETTES; CUT TOBACCO; RAPPEE; MANUFACTURED TOBACCO OF ALL KINDS; MATCHES; TOBACCO; SMOKING PIPES; PIPE-HOLDERS, NOT OF PRECIOUS METAL; ASH-TRAYS, NOT OF PRECIOUS METAL; MATCH BOXES, CIGAR CASES AND HUMIDORS, NOT OF PRECIOUS METAL, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

OWNER OF CUBA REG. NO. 118875, DATED 8-5-1991, EXPIRES 8-5-2001.

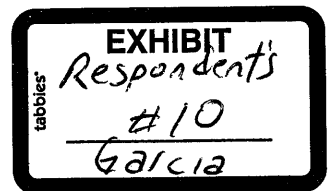
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "CUBAN CIGAR", APART FROM THE MARK AS SHOWN.

THE ENGLISH TRANSLATION OF "LA CASA DEL HABANO" IS "THE HOUSE OF THE CUBAN CIGAR".

SER. NO. 74-576,950, FILED 9-22-1994.

JYLL A. SMITH, EXAMINING ATTORNEY

# EXHIBIT 10



Int. Cls.: 35 and 42

Prior U.S. Cls.: 100, 101 and 102

**United States Patent and Trademark Office**

**Reg. No. 2,212,119**

**Registered Dec. 22, 1998**

**SERVICE MARK  
PRINCIPAL REGISTER**



EMPRESA CUBANA DEL TABACO (CUBA  
CORPORATION), DBA CUBATABACO  
O'REILLY NO. 104  
CIUDAD LA HABANA, CUBA

FOR: RETAIL STORE SERVICES FEATUR-  
ING TOBACCO AND SMOKERS' ACCESSO-  
RIES, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FOR: SOCIAL CLUB SERVICES, BAR SERV-  
ICES, AND RESTAURANT SERVICES, IN  
CLASS 42 (U.S. CLS. 100 AND 101).

OWNER OF CUBA REG. NO. 121292, DATED  
6-30-1994, EXPIRES 6-12-2004.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "LA CASA DEL HABANO",  
APART FROM THE MARK AS SHOWN.

THE ENGLISH TRANSLATION OF "LA  
CASA DEL HABANO" IS "THE HOUSE OF  
THE CUBAN CIGAR".

SER. NO. 75-151,529, FILED 8-16-1996.

CRAIG D. TAYLOR, EXAMINING ATTORNEY

Int. Cls.: 35 and 42


Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,212,119

**United States Patent and Trademark Office**

Registered Dec. 22, 1998

**SERVICE MARK  
PRINCIPAL REGISTER**

**LA CASA DEL HABANO** 

EMPRESA CUBANA DEL TABACO (CUBA  
CORPORATION), DBA CUBATABACO  
O'REILLY NO. 104  
CIUDAD LA HABANA, CUBA

FOR: RETAIL STORE SERVICES FEATUR-  
ING TOBACCO AND SMOKERS' ACCESSO-  
RIES, IN CLASS 35 (U.S. CLS. 100, 101 AND 102).

FOR: SOCIAL CLUB SERVICES, BAR SERV-  
ICES, AND RESTAURANT SERVICES, IN  
CLASS 42 (U.S. CLS. 100 AND 101).

OWNER OF CUBA REG. NO. 121292, DATED  
6-30-1994, EXPIRES 6-12-2004.

NO CLAIM IS MADE TO THE EXCLUSIVE  
RIGHT TO USE "LA CASA DEL HABANO",  
APART FROM THE MARK AS SHOWN.

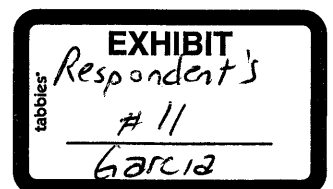
THE ENGLISH TRANSLATION OF "LA  
CASA DEL HABANO" IS "THE HOUSE OF  
THE CUBAN CIGAR".

SER. NO. 75-151,529, FILED 8-16-1996.

CRAIG D. TAYLOR, EXAMINING ATTORNEY

Spoke to Mr.  
Goldstein and  
told him we  
need written  
response and then  
go ahead + accept  
+ 2/20/98

# EXHIBIT 11



**Int. Cl.: 34**

**Prior U.S. Cls.: 2, 8, 9 and 17**

**Reg. No. 2,128,050**

**United States Patent and Trademark Office**

**Registered Jan. 13, 1998**

**TRADEMARK  
PRINCIPAL REGISTER**

**LA PERLA**

EMPRESA CUBANA DEL TABACO (CUBA  
CORPORATION), DBA CUBATABACO  
CALLE O'REILLY NO. 104  
LA HABANA, CUBA

OWNER OF CUBA REG. NO. 112,574, DATED  
1-14-1982, EXPIRES 1-14-2007.

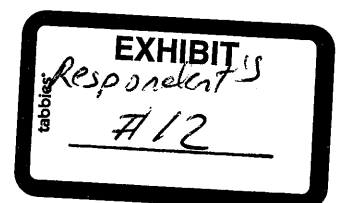
THE ENGLISH TRANSLATION OF THE  
WORDS "LA PERLA" IN THE MARK IS "THE  
PEARL".

FOR: CURED AND UNCURED TOBACCO  
FOR SMOKING, CHEWING, SNUFF OR CIGA-  
RETTES, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND  
17).

SER. NO. 75-011,206, FILED 10-27-1995.

LEIGH CAROLINE CASE, EXAMINING AT-  
TORNEY

# EXHIBIT 12





Int. Cl.: 34

Prior U.S. Cls.: 8, 9 and 17

**United States Patent and Trademark Office** **Reg. No. 1,653,845**  
Registered Aug. 13, 1991

**TRADEMARK**  
**PRINCIPAL REGISTER**

**QUAI D'ORSAY**

EMPRESA CUBANA DEL TABACO (CUBA  
CORPORATION), TA CUBATABACO  
104 O'REILLY STREET  
VEDADO, HAVANA CITY, CUBA

FOR: RAW TOBACCO; CIGARS; CIGA-  
RETTES; CUT TOBACCO; RAPEE; MATCHES;  
TOBACCO PIPES; PIPE RACKS; ASHTRAYS;  
MATCH-BOXES NOT OF PRECIOUS METAL;  
CIGAR CASES NOT OF PRECIOUS METAL;

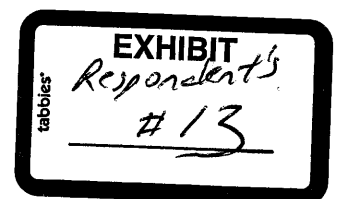
HUMIDORS NOT OF PRECIOUS METAL, IN  
CLASS 34 (U.S. CLS. 8, 9 AND 17).

PRIORITY CLAIMED UNDER SEC. 44(D) ON  
CUBA APPLICATION NO. 370/87, FILED  
12-24-1987, REG. NO. 370/87, DATED 12-24-1987,  
EXPIRES 12-24-1997.

SER. NO. 73-729,557, FILED 5-20-1988.

MICHAEL MASON, EXAMINING ATTORNEY

# EXHIBIT 13



★ ★ ★

# United States Restricts Travel and Vessels to Cuba

## MEDIA NOTE

OFFICE OF THE SPOKESPERSON  
WASHINGTON, DC

JUNE 4, 2019

Share 

Today, the United States took strong action to prevent U.S. travel to Cuba from enriching the Cuban military, security, and intelligence services by announcing new restrictions on authorized travel and vessels to the island.

Going forward, the United States will prohibit U.S. travelers from going to Cuba under the previous 'group people-to-people educational' travel authorization. In addition, the United States will no longer permit visits to Cuba via passenger and recreational vessels, including cruise ships and yachts, and private and corporate aircraft.

The United States holds the Cuban regime accountable for its repression of the Cuban people, its interference in Venezuela, and its direct role in the man-made crisis led by Nicolas Maduro. Despite widespread international condemnation, Maduro continues to undermine his country's institutions and subvert the Venezuelan people's right to self-determination. Empowered by Cuba, he has created a humanitarian disaster that destabilizes the region.

These actions are directly linked to the tourism industry, which has strong economic ties to the Cuban security, military, and intelligence sectors in Cuba. Veiled tourism has served to line the

pockets of the Cuban military, the very same people supporting Nicolas Maduro in Venezuela and repressing the Cuban people on the island. In Cuba, the regime continues to harass, intimidate, and jail Cubans who dare to voice an opinion different from the one the regime wants them to have. The United States calls on the regime to abandon its repression of Cubans, cease its interference in Venezuela, and work toward building a stable, prosperous, and free country for the Cuban people.

For more information on the regulations on U.S. travel to Cuba and restrictions on vessels and aircraft, please refer to releases by the **Departments of the Treasury** and **Commerce**.

For further information, please contact WHA Press at **WHA\_Press@state.gov** and EB Press at **EB-A-PD-DL@state.gov**.

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#### TAGS

Bureau of Economic and Business Affairs

Bureau of Western Hemisphere Affairs

Cuba

Office of the Spokesperson

Venezuela

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★ ★ ★

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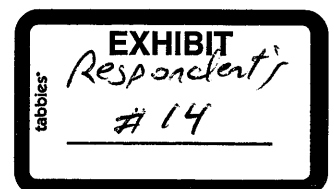
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# EXHIBIT 14



KeyCite Yellow Flag - Negative Treatment  
Declined to Extend by *De Beers LV Trademark Ltd. v. DeBeers  
Diamond Syndicate, Inc.*, S.D.N.Y., June 9, 2006

399 F.3d 462

United States Court of Appeals,  
Second Circuit.

EMPRESA CUBANA DEL TABACO, doing  
business as **Cubatabaco**, Plaintiff-Counter-  
Defendant-Appellee-Cross-Appellant,

v.

CULBRO CORPORATION,  
Defendant-Counter-Claimant,  
**General Cigar Co., Inc.** and **General  
Cigar Holdings, Inc.** Defendants-  
Counterclaimants-Appellants-Cross-Appellees.

Docket Nos. 04-2527-CV(L), 04-3005-CV (XAP).

|  
Argued: Aug. 24, 2004.

|  
Decided: Feb. 24, 2005.

#### Synopsis

**Background:** Cuban cigar manufacturer brought action against United States manufacturer, alleging, inter alia, infringement of its "COHIBA" trademark, trade dress infringement, unfair competition, misappropriation and trademark dilution. The United States District Court for the Southern District of New York, **Robert W. Sweet, J.**, 2004 WL 602295, found infringement and dismissed remaining claims. Cross-appeals were taken.

**Holdings:** The Court of Appeals, **Straub**, Circuit Judge, held that:

Cuban embargo statute precluded manufacturer's acquisition of property rights in mark, and

embargo statute precluded manufacturer from obtaining cancellation of competitor's registration of mark or injunction barring competitor from using mark in United States.

Affirmed in part, reversed in part, and remanded.

#### Attorneys and Law Firms

\*463 **Maureen E. Mahoney**, Latham & Watkins LLP, Washington, DC (**John J. Kirby, Jr.** and **Alexandra A.E. Shapiro**, Latham & Watkins LLP, New York, NY, on the brief; **E. Marcellus Williamson**, Latham & Watkins LLP, Washington DC, on the brief; **Harry C. Marcus** and **Janet Dore**, Morgan & Finnegan, L.L.P., New York, NY, of counsel), for Defendants-Counterclaimants-Appellants-Cross-Appellees.

**Michael Krinsky**, Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C. (**David B. Goldstein**, **Christopher J. Klatell**, and **Carrie Corcoran**, Boudin, Standard, Krinsky & Lieberman, P.C.; **Kevin Walsh** and **Steven J. Young**, Winston & Strawn, on the brief), New York, NY, for Plaintiff-Counter-Defendant-Appellee-Cross-Appellant.

\*464 **Peter D. Keisler**, Assistant Attorney General; **Douglas N. Letter** and **Jonathan H. Levy**, Attorneys, Civil Division, U.S. Department of Justice, Washington DC; **David N. Kelley**, United States Attorney for the Southern District of New York, New York, NY; **Arnold I. Havens**, General Counsel, U.S. Department of the Treasury, Washington, DC, for Amicus Curiae United States of America.

Before: **CABRANES, STRAUB, WESLEY**, Circuit Judges.

#### Opinion

**STRAUB**, Circuit Judge.

Defendants-Counterclaimants-Appellants-Cross-Appellees, General Cigar Co., Inc., and General Cigar Holdings, Inc. ("General Cigar"), appeal from a judgment and permanent injunction of the United States District Court for the Southern District of New York (**Robert W. Sweet, Judge**), entered on May 6, 2004, finding in favor of Plaintiff-Counter-Defendant-Appellee-Cross-Appellant, Empresa Cubana del Tabaco, doing business as Cubatabaco ("Cubatabaco"), on its claim of trademark infringement under Section 43(a) of the Lanham Act, ordering cancellation of General Cigar's United States trademark registration for COHIBA cigars, permanently enjoining General Cigar from further use of the COHIBA mark, and ordering General Cigar to deliver to Cubatabaco all merchandise, packaging and other



materials bearing the COHIBA name, to recall from retail customers and distributors products bearing the mark, and to inform customers and distributors that they could not sell General Cigar's COHIBA-labeled products in the United States. Cubatabaco has cross-appealed from the District Court's dismissal of its treaty-based and state law claims.

This appeal arises from a dispute between Cubatabaco, a Cuban company, and General Cigar, an American company, over who has the right to use the COHIBA mark on cigars. After filing an application to register the COHIBA mark in Cuba in 1969, Cubatabaco began selling COHIBA cigars in Cuba. Cubatabaco has sold COHIBA cigars outside of Cuba since 1982, but, because of the United States embargo against Cuban goods, imposed in 1963, Cubatabaco has never sold COHIBA cigars in the United States. General Cigar obtained a registration for the COHIBA mark in the United States in 1981 and sold COHIBA cigars in the United States from 1978 until late 1987. In 1992, General Cigar relaunched a COHIBA cigar in the United States and has sold cigars under that mark in the United States since that time.

Cubatabaco claims that it owns the U.S. COHIBA trademark because General Cigar abandoned its 1981 registration in 1987 and that, by the time General Cigar resumed use of the mark in 1992, the Cuban COHIBA mark was sufficiently well known in the United States that it deserved protection under the so-called "famous marks doctrine." The District Court agreed and found that, although Cubatabaco had never used the mark in the United States and was prohibited from doing so under the embargo, it nonetheless owned the U.S. COHIBA mark. The District Court concluded that by failing to use the COHIBA mark from late 1987 to 1992, General Cigar abandoned its 1981 registration. It found further that because the Cuban COHIBA mark was sufficiently well known in the United States by November 1992, the date General Cigar resumed its use of the mark, Cubatabaco was entitled to priority in asserting ownership of the mark. After finding that there was a likelihood of confusion between the Cuban COHIBA mark and the General Cigar COHIBA mark, the court granted judgment to Cubatabaco on its claim for trademark infringement under \*465 Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a), cancelled General Cigar's registration of the mark, and enjoined General Cigar from using the mark. The court dismissed all other

claims brought by Cubatabaco, including claims under international trademark treaties and New York law.

We do not reach the question of whether an entity that has not used a mark on products sold in the United States can nonetheless acquire a U.S. trademark through operation of the famous marks doctrine. We need not reach that question in this case because even were we to recognize and apply the famous marks doctrine, the Cuban embargo bars Cubatabaco's acquisition of the COHIBA mark via the famous marks doctrine. Therefore, we reverse the District Court's grant of judgment to Cubatabaco on its claim of trademark infringement under Section 43(a) of the Lanham Act. We affirm the District Court's dismissal of all other claims brought by Cubatabaco.

## BACKGROUND

In 1963 the United States imposed an embargo on Cuba. The Cuban Asset Control Regulations ("Embargo Regulations" or "Regulations"), 31 C.F.R. § 515.201 *et seq.*, which were promulgated pursuant to Section 5(b) of the Trading with the Enemy Act of 1917, ch. 106, § 5(b), 40 Stat. 415 (codified as amended at 12 U.S.C. § 95a (2000)), contain the terms of the embargo. *See Havana Club Holding, S.A. v. Galleon S.A.*, 203 F.3d 116, 120 (2d Cir.), *cert. denied*, 531 U.S. 918, 121 S.Ct. 277, 148 L.Ed.2d 201 (2000). In 1996 Congress codified the Regulations in the Cuban Liberty and Democratic Solidarity Act of 1996 ("LIBERTAD Act"), Pub.L. No. 104-114, Title I, § 102, Mar. 12, 1996, 110 Stat. 792 (1996) (codified at 22 U.S.C. § 6032(h)). "The Secretary of the Treasury has the authority to administer the Cuban embargo, which he has delegated to the Office of Foreign Assets Control ('OFAC')." *Havana Club*, 203 F.3d at 120 (citing 31 C.F.R. § 515.802). The Embargo Regulations prevent Cuban entities, such as Cubatabaco, from selling cigars in the United States. Despite its inability to sell cigars here, Cubatabaco claims that it owns the COHIBA mark in the United States and that General Cigar's sale of COHIBA cigars in the United States unlawfully infringes its mark.

The District Court, after a bench trial, issued a comprehensive opinion setting forth its factual findings. *See Empresa Cubana del Tabaco v. Culbro Corp.*, No. 97 Civ. 8399, 2004 WL 602295, at \*3-27 (S.D.N.Y. Mar.26,

2004) (“*Empresa III*”). Here we recount only those facts necessary to explain our holding.

In 1969 Cubatabaco filed an application to register the COHIBA mark in Cuba. Throughout the 1970s it sold COHIBA cigars in Cuba. By January 1978 Cubatabaco had applied to register the COHIBA mark in seventeen countries, including most Western European countries, but did not apply to register the mark in the United States. In 1982 Cubatabaco began selling COHIBA cigars outside of Cuba. In 1983 Cubatabaco considered registering its COHIBA mark in the United States but learned that General Cigar had already obtained the United States registration. On February 22, 1985, Cubatabaco filed an application with the United States Patent and Trademark Office (“PTO”) to register its BEHIQUE mark in the United States with the same trade dress that it used on its COHIBA cigars elsewhere. In 1987 Cubatabaco considered challenging General Cigar’s 1981 COHIBA registration, but chose not to take any action.

General Cigar first learned of the name “Cohiba” in the late 1970s after General \*466 Cigar executives read a *Forbes* magazine article stating that Cubatabaco was planning to sell its COHIBA cigars outside of Cuba. General Cigar filed an application to register the COHIBA mark with the PTO on March 13, 1978, with a claimed first use date of February 13, 1978. The application was unopposed, and General Cigar obtained the registration on February 17, 1981. General Cigar sold COHIBA cigars in the United States from 1978 until late 1987.

In February 1992 *The Wine Spectator* magazine published articles describing COHIBA as Cuba’s “finest” cigar and “the hot brand.” In September 1992, the premier issue of *Cigar Aficionado* magazine, which had a United States circulation of 115,000 copies, featured a story about Cubatabaco’s Cuban COHIBA cigars. The magazine rated cigars and gave the Cubatabaco’s COHIBA Robusto the highest ranking. Shortly thereafter, General Cigar decided to use COHIBA on a new premium cigar, which it launched on November 20, 1992. The District Court noted that General Cigar “acknowledges that the reintroduction was at least in part a response to *Cigar Aficionado*’s coverage of the Cuban COHIBA.” General Cigar filed for a second COHIBA registration on December 30, 1992, and the application was granted without opposition in 1995.

In late 1992 and early 1993 General Cigar considered seeking permission to use Cubatabaco’s registered trade dress. In a January 1993 memo, General Cigar’s then in-house counsel wrote that having permission to use the trade dress would help General Cigar “to exploit the popularity, familiarity, brand recognition and overall success of the Cuban Cohiba.” General Cigar did not pursue further the plan to seek permission to use the trade dress.

In late January or February 1997 General Cigar decided to launch a new cigar under the COHIBA name. General Cigar acknowledges that the Cuban COHIBA was well known to U.S. cigar consumers by the time General Cigar launched its new product in the fall of 1997. The District Court noted that “[t]he 1997 advertising for the General Cigar COHIBA attempted to create an association in the consumer’s mind to Cuba and the Cuban COHIBA.”

In January 1997 Cubatabaco commenced a proceeding in the Trademark Trial and Appeal Board to cancel General Cigar’s registration of the COHIBA mark. On November 12, 1997, Cubatabaco filed this action alleging thirteen claims against General Cigar. The first six claims alleged violations of various treaty provisions and asserted that Cubatabaco was entitled to relief under Sections 44(b) and 44(h) of the Lanham Act, 15 U.S.C. § 1126(b), (h). In particular, Cubatabaco claimed that General Cigar violated: (1) the protection under Article 6bis of the Paris Convention for the Protection of Industrial Property, Mar. 20, 1883, as revised at **Stockholm, July 14, 1967, 21 U.S.T. 1583**, 828 U.N.T.S. 305 (“Paris Convention”), for famous marks; (2) Section 10bis of the Paris Convention’s prohibition against unfair competition; (3) Articles 7 and 8 of the General Inter-American Convention for Trade Mark and Commercial Protection, Feb. 20, 1929, 46 Stat. 2907 (“IAC”), by using and registering COHIBA for cigars with knowledge of Cubatabaco’s use of the mark on cigars; (4) Articles 20 and 21 of the IAC’s prohibition against unfair competition; (5) Article 22 of the Agreement on Trade-Related Aspects of Intellectual Property Rights (“TRIPS”) by representing its cigar as the product of “Cuban seed”; and (6) Article 10 of the Paris Convention by representing its cigar as the product of “Cuban seed.”

\*467 In addition to the treaty-based claims, Cubatabaco alleged that: (7) General Cigar committed willful

trademark and trade dress infringement in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a); (8) General Cigar engaged in false representation of source of origin in willful violation of Section 43(a) of the Lanham Act by stating that their cigars contained tobacco grown from Cuban seed; (9) General Cigar engaged in deceptive advertising in willful violation of Section 43(a) of the Lanham Act by stating that their cigars contained Cuban seed; (10) General Cigar's acts constituted unfair competition under New York law and under the laws of every state in which General Cigar has engaged in the misconduct alleged; (11) General Cigar's registration should be cancelled pursuant to 15 U.S.C. § 1120; (12) General Cigar's actions were likely to dilute Cubatabaco's COHIBA mark and constituted willful violation of New York General Business Law § 360l, comparable laws of other states where General Cigar engaged in the misconduct, and Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c); and (13) General Cigar willfully misappropriated Cubatabaco's trademark in violation of New York law and the law of other states where General Cigar engaged in the conduct. Cubatabaco sought injunctive relief, damages, and attorneys' fees. General Cigar counterclaimed, seeking a declaratory judgment that it had the right to continued use and registration in the United States of the COHIBA mark, as well attorneys' fees and costs.

On December 4, 2000, Cubatabaco stipulated to the dismissal with prejudice of its Fifth, Sixth, Eighth, and Ninth claims for relief—i.e., the TRIPS claim, the claim that General Cigar violated Article 10 of the Paris Convention, and claims under Section 43(a) of the Lanham Act for false representation of source of origin and deceptive advertising.<sup>1</sup>

On November 29, 2001, General Cigar moved for summary judgment dismissing Cubatabaco's complaint on the basis of estoppel, acquiescence, and laches, due to Cubatabaco's alleged delay in challenging General Cigar's use of the COHIBA mark. On January 29, 2002, Cubatabaco moved to dismiss General Cigar's affirmative defenses. Cubatabaco also moved for partial summary judgment on its claim that General Cigar abandoned its 1981 registration, as well as its claims that General Cigar violated Articles 7 and 8 of the IAC, Article 6bis of the Paris Convention, New York common law, and the Federal Trademark Dilution Act.

On June 26, 2002, the District Court, resolving the motions, held that Cubatabaco was entitled to partial summary judgment on its claim that General Cigar had abandoned the COHIBA mark during its period of non-use from 1987 to 1992.<sup>2</sup> \*468 *Emmpresa Cubana Del Tabaco v. Culbro Corp.*, 213 F.Supp.2d 247, 267–71 (S.D.N.Y.2002) (“*Emmpresa I*”). The court dismissed General Cigar's affirmative defenses of acquiescence, estoppel, and laches.

In addition, the court dismissed Cubatabaco's claims under Articles 7 and 8 of the IAC, reasoning that under our decision in *Havana Club*, the only IAC rights that could be asserted under Sections 44(b) and (h) of the Lanham Act are those rights that are “related to the repression of unfair competition.” *Emmpresa I*, 213 F.Supp.2d at 279–80. Because Articles 7 and 8 of the IAC relate to the registration of trademarks and are not found in the chapter of the IAC labeled “Repression of Unfair Competition,” the court concluded that Article 7 and Article 8 rights could not be asserted under Sections 44(b) and (h) of the Lanham Act. *Id.* at 281–82. The District Court also dismissed Cubatabaco's Article 6bis Paris Convention claim, which Cubatabaco asserted under Sections 44(b) and (h) of the Lanham Act, on the ground that Article 6bis does not concern “rights related to the repression of unfair competition.” *Id.* at 283–84. Finally, the court found that there were material issues of fact regarding Cubatabaco's New York common law and Federal Trademark Dilution Act claims and denied summary judgment to Cubatabaco on those claims. *Id.* at 284–86.

Both parties moved for reconsideration, and the District Court denied the motions. *See Emmpresa Cubana del Tabaco v. Culbro Corp.*, No. 97 Civ. 8399, 2002 WL 31251005 (S.D.N.Y. Oct.8, 2002) (“*Emmpresa II*”). The court held a bench trial on various dates between May 27, 2003, and June 23, 2003. *Empresa III*, 2004 WL 602295, at \*1.

On March 26, 2004, the District Court found that Cubatabaco was entitled to prevail on its claim of trademark infringement under Section 43(a) of the Lanham Act. The court's finding of trademark infringement rested on its adoption of the famous marks doctrine.

The court reasoned that, to prevail on its Section 43(a) trademark infringement claim, Cubatabaco had to establish (1) that its mark is entitled to protection and (2) that General Cigar's use of the mark is likely to cause consumers confusion as to the origin or sponsorship of **General Cigar's goods**. *Empresa III*, 2004 WL 602295, at \*29. The court recognized that the standard test for ownership of a mark is priority of use, and that, under the "territoriality principle," foreign use of a trademark cannot form the basis for establishing priority in the United States. *Id.* at \*30. However, the court rejected General Cigar's argument that it owned the COHIBA mark because it was the first to use it in the United States after it was allegedly abandoned, stating that "General Cigar's priority of use ... is not the end of the matter." *Id.* Rather, the court held that "[u]nder the common-law well-known or famous marks doctrine, a party with a well known mark at the time another party starts to use the mark has priority over the party using the mark." *Id.* (internal quotation marks omitted). The court concluded that if the Cuban COHIBA mark was sufficiently famous in the United States before General Cigar resumed use of the mark in November 1992, then Cubatabaco owned the U.S. trademark even though it had never used the mark in the United States. The court determined that secondary meaning was the level of recognition required for a mark to be protected under the famous marks doctrine and concluded that the Cuban COHIBA mark was sufficiently well known in the United States by November 1992 that Cubatabaco was entitled to priority. The court further \*469 held that Cubatabaco had established a likelihood of confusion between the Cuban COHIBA and General Cigar's COHIBA mark, *id.* at \*39-49, and that Cubatabaco was therefore entitled to prevail on its claim of trademark infringement against General Cigar under Section 43(a) of the Lanham Act. *Id.* at \*52.<sup>3</sup>

Although finding in Cubatabaco's favor on its claim of trademark infringement, the court dismissed the remainder of Cubatabaco's claims. In particular, the court dismissed Cubatabaco's claim that the band General Cigar used on its cigars infringed upon Cubatabaco's registered trade dress because Cubatabaco failed to show a likelihood of confusion between the cigar bands. *Id.* at \*56. The court dismissed Cubatabaco's Article 10bis Paris Convention claim and its claims under Articles 20 and 21 of the IAC as duplicative of Cubatabaco's rights under Section 43(a) of the Lanham Act. As to Cubatabaco's claim under the Federal Trademark

Dilution Act ("FTDA"), 15 U.S.C. § 1125(c), the court found that Cubatabaco's COHIBA mark had not acquired the high level of fame required by that statute. *Id.* at \*53. Cubatabaco's claim under New York's anti-dilution law, NY. Gen. Bus. Law § 360-l, was dismissed on similar grounds. *Id.* at \*53-54. The court dismissed Cubatabaco's New York unfair competition claim because it found Cubatabaco failed to show that General Cigar acted in bad faith, *id.* at \*55, dismissed Cubatabaco's misappropriation claim as duplicative of the New York unfair competition claim, *id.*, and dismissed Cubatabaco's deceptive trade practices claim brought under **New York General Business Law § 349** as not actionable, *id.* at 57. The court rejected Cubatabaco's request for cancellation of General Cigar's mark under 15 U.S.C. § 1120 because it had already canceled the registration based on the Section 43(a) violation and because Cubatabaco failed to establish that General Cigar made statements in its registration application with knowledge of their falsity. *Id.* at \*55.

Finally, the court noted that the parties had stipulated in the Joint Pretrial Order that "[a]ny trial on the issue of monetary relief claimed by Plaintiff against Defendants shall be bifurcated from a trial on liability." *Id.* at \*58. The court stated that if the parties wanted to seek appellate review of the court's liability determinations, they should file a motion for certification pursuant to **Federal Rule of Civil Procedure 54(b)**, and the trial on monetary relief would be held at a later date. *Id.* Both parties filed motions for the court to enter judgment pursuant to **Rule 54(b)**.

On May 6, 2004, the District Court entered an order, judgment, and permanent injunction, which, *inter alia*: (1) granted Cubatabaco judgment against General Cigar on its claim for infringement of Cubatabaco's COHIBA mark pursuant to 15 U.S.C. § 1125(a) and granted judgment to Cubatabaco on its claim that prior to November 1992 General Cigar had abandoned the COHIBA mark; (2) canceled General Cigar's trademark registration for the COHIBA mark, and permanently enjoined General Cigar from using the COHIBA mark; and (3) ordered General Cigar to deliver to Cubatabaco all goods and labels bearing the COHIBA mark, to recall from retail customers and distributors products bearing the mark, and to inform customers and distributors that they could not sell General Cigar's COHIBA-labeled products in the United States. Finally, the court stated that all of General Cigar's equitable and other affirmative defenses

were dismissed with prejudice, and all of Cubatabaco's \*470 claims were dismissed with prejudice, except for the claims on which relief was granted. The court found that "[t]here was no reason to delay the appeal of plaintiff's claims for relief and defendants' equitable and other affirmative defenses that have been dismissed with prejudice," and "[i]n the interest of judicial efficiency and to avoid duplicative and piecemeal litigation about liability," the court entered final judgment pursuant to **Federal Rule of Civil Procedure 54(b)** on "all of the claims and defenses that have been dismissed to date."

The District Court denied General Cigar's motion to stay the order pending appeal, but entered a temporary stay to allow General Cigar to seek such a stay from this Court. On June 23, 2004, this Court granted a stay of the District Court's order pending appeal, and granted a motion to expedite the appeal.

On appeal, General Cigar argues that the District Court erred in (1) granting summary judgment to Cubatabaco on its claim that General Cigar had abandoned its 1981 trademark registration, and in holding that claims of abandonment are not subject to equitable defenses; and (2) granting judgment to Cubatabaco on its claim of trademark infringement based on a finding that Cubatabaco acquired rights to the mark under the famous marks doctrine. In addition, General Cigar asserts that Cubatabaco lacks standing to bring a Section 43(a) trademark infringement claim because, due to the embargo, Cubatabaco could not establish "commercial injury." General Cigar also makes an argument not raised below—that Cubatabaco's acquisition of trademark rights in the United States through the famous marks doctrine was a transfer of property that was prohibited by the Embargo Regulations.

In addition to defending the District Court's finding of trademark infringement under Section 43(a) of the Lanham Act, Cubatabaco cross-appeals arguing that: (1) Cubatabaco is entitled to protection of its "famous" COHIBA mark under Article 6*bis* of the Paris Convention, which Cubatabaco claims is implemented by Sections 44(b) and (h) of the Lanham Act; (2) General Cigar's registration for the U.S. COHIBA mark should be cancelled under Articles 7 and 8 of the IAC, which Cubatabaco claims are implemented through Sections 44(b) and (h) of the Lanham Act; (3) Cubatabaco is entitled to relief on its New York common law and

its treaty-based unfair competition claims brought under Sections 44(b) and (h) of the Lanham Act; and (4) Cubatabaco is entitled to relief on its New York law dilution claim.

After oral argument in this Court we invited the United States Departments of Justice and Treasury ("government") to submit a brief as *amicus curiae* addressing the question of whether the Embargo Regulations barred Cubatabaco's acquisition of the COHIBA mark in the United States via the famous marks doctrine. On November 12, 2004, the government filed its letter brief. There, the government asserts that the Regulations bar Cubatabaco's acquisition of the mark via the famous marks doctrine and that the District Court's finding of trademark infringement under Section 43(a) must therefore be reversed. In addition, the government reasons that the portion of the District Court's order requiring General Cigar to deliver merchandise and other materials bearing the COHIBA mark to Cubatabaco is barred by the Regulations. According to the government, however, the Regulations do not bar the portion of the District Court's order that cancels General Cigar's registration and enjoins its use of the COHIBA mark. The government notes that \*471 Cubatabaco's ownership of the U.S. COHIBA mark is not required for a Section 43(a) claim, and expresses the view that, given the District Court's factual findings, the cancellation of General Cigar's mark and the injunction against General Cigar's use of the mark is appropriate relief. On December 3, 2004, the parties filed letter briefs responding to the *amicus curiae* letter brief filed by the government. Cubatabaco asserts that the government correctly concluded that it was entitled to the relief ordered by the District Court under Section 43(a) of the Lanham Act. General Cigar agrees with the government's conclusion that the Embargo Regulations barred Cubatabaco's acquisition of the mark through the famous marks doctrine, but asserts that the government is incorrect in its claim that Cubatabaco is nonetheless entitled to relief under Section 43(a).

## DISCUSSION

General Cigar argues that the Embargo Regulations bar Cubatabaco from acquiring rights in the COHIBA mark in the United States through the famous marks doctrine and that the District Court's finding of trademark infringement must therefore be reversed. Although

General Cigar did not raise this argument below, we consider it on appeal because it implicates an issue of significant public concern—the United States' national policy towards Cuba as established by the President and the Congress—and it involves a question of pure law. See *Dean Witter Reynolds, Inc. v. Fernandez*, 741 F.2d 355, 360–61 (11th Cir.1984) (reaching issue regarding the Cuban embargo even though not raised below because “a principal purpose of the Cuban Assets Control Regulations was to deny Cuba access to American dollars which could finance acts of aggression or subversion,” and therefore was an issue “of great public concern”); see also *Singleton v. Wulff*, 428 U.S. 106, 121, 96 S.Ct. 2868, 49 L.Ed.2d 826 (1976) (“The matter of what questions may be taken up and resolved for the first time on appeal is one left primarily to the discretion of the courts of appeals, to be exercised on the facts of individual cases.”); *Krumme v. WestPoint Stevens Inc.*, 238 F.3d 133, 142 (2d Cir.2000) (“[W]here an allegedly forfeited claim raises a pure question of law, we may choose to reach the merits.” (internal quotation marks omitted)); *Sheffield Commercial Corp. v. Clemente*, 792 F.2d 282, 286 (2d Cir.1986) (considering issue not raised below regarding New York's Motor Vehicle Retail Installment Sales Act “because of the strong public interest in enforcement of the Act”).

For the reasons explained below, we hold that the Embargo Regulations bar Cubatabaco's acquisition of property rights in the U.S. COHIBA trademark through the famous marks doctrine. Cubatabaco claims no other basis for owning the mark, and, therefore, the District Court's finding of trademark infringement under Section 43(a) of the Lanham Act must be reversed. We do not reach the question of whether to recognize the famous marks doctrine because even if a foreign entity can, as a general matter, acquire trademark rights in the United States through the famous marks doctrine, Cubatabaco's acquisition rights in the COHIBA mark in this manner is barred by the embargo. We also reject Cubatabaco's argument that, even if the embargo bars its acquisition of the mark, it nonetheless is entitled, based on the “fame” of its mark, to obtain cancellation of General Cigar's mark and an injunction barring General Cigar from using the mark in the United States because to grant this relief would entail a transfer of property rights in the COHIBA mark to Cubatabaco in violation of the embargo.

\*472 We also do not decide whether the District Court properly found that General Cigar had abandoned its mark between 1987 and 1992. We have no need to decide that issue because even if General Cigar did abandon its mark, it owns the mark now because it resumed use of the mark in November 1992 and Cubatabaco is unable, in light of the embargo, to establish that it acquired rights to the mark in the interval. Finally, we affirm the District Court's dismissal of Cubatabaco's remaining treaty claims and its claims under New York law.

## I. CLAIMS UNDER SECTIONS 43(A), 44(B), AND 44(H) OF THE LANHAM ACT BASED ON “FAME” OF THE CUBAN COHIBA MARK.....

### A. The Trademark Infringement Claim Fails Because Acquisition of the Mark Via the Famous Marks Doctrine Is Prohibited By the Embargo Regulations

Cubatabaco argues that the District Court properly entered judgment in its favor on its claim of trademark infringement under Section 43(a) of the Lanham Act. To prove trademark infringement, Cubatabaco must establish that it owns the COHIBA mark in the United States. According to Cubatabaco, it owns the mark because General Cigar abandoned its 1981 COHIBA registration in 1987 and, by the time General Cigar resumed use of the mark in 1992, the Cuban COHIBA mark was sufficiently well known in the United States that it deserved protection under the famous marks doctrine. For the reasons explained below, we hold that the Embargo Regulations bar Cubatabaco's acquisition of the U.S. COHIBA mark through the famous marks doctrine, and thus the District Court's finding of trademark infringement is reversed.

### 1. The Embargo Regulations

Unless otherwise authorized, the Embargo Regulations prohibit a broad range of transactions involving property in which a Cuban entity has an interest. In particular, 31 C.F.R. § 515.201(b) provides in pertinent part that:

(b) All of the following transactions are prohibited, except as specifically authorized by the Secretary of the Treasury (or any person, agency, or instrumentality designated by him) by means of regulations, rulings, instructions, licenses, or otherwise, if such transactions involve property in which any foreign country designated under this part, or any national thereof, has

at any time on or since the effective date of this section had any interest of any nature whatsoever, direct or indirect:

- (1) All dealings in, including, without limitation, transfers, withdrawals, or exportations of, any property or evidences of indebtedness or evidences of ownership of property by any person subject to the jurisdiction of the United States; and
- (2) All transfers outside the United States with regard to any property or property interest subject to the jurisdiction of the United States.

**31 C.F.R. § 515.201(b) (2005).**<sup>4</sup> Section 515.201(c) provides that “[a]ny transaction for the purpose or which has the effect of \*473 evading or avoiding any of the prohibitions set forth in paragraphs (a) or (b) of this section is hereby prohibited.” *Id.* § 515.201(c); see also *Havana Club Holding, S.A. v. Galleon S.A.*, 203 F.3d 116, 122 n. 3 (2d Cir.), cert. denied, 531 U.S. 918, 121 S.Ct. 277, 148 L.Ed.2d 201 (2000).

The Regulations provide several relevant definitions. The “foreign country designated under this part” is Cuba, **31 C.F.R. § 515.201(d)**, and “property” or “property interest” includes trademarks, *id.* § 515.311. “Transfer” is defined broadly to include “any actual or purported act or transaction ... the purpose, intent, or effect of which is to create, surrender, release, transfer, or alter, directly or indirectly, any right, remedy, power, privilege, or interest with respect to any property.” *Id.* § 515.310. Section 515.309 provides that the phrase “transactions which involve property in which a designated foreign country, or any national thereof, has any interest of any nature whatsoever, direct or indirect includes ... [a]ny ... transfer to such designated foreign country or national thereof.” *Id.* § 515.309(a). In other words, a transaction involving property in which a Cuban national has an interest includes a transfer of property to a Cuban national.

Therefore, absent a general or specific license, § 515.201(b) (1) of the Regulations prohibits a transfer of property rights, including trademark rights, to a Cuban entity by a person subject to the jurisdiction of the United States. Section 515.201(b)(2) prohibits a transfer outside of the United States of property subject to the jurisdiction of the United States—if the transfer is to a Cuban entity.

General licenses and specific licenses provide exceptions to the prohibition of § 515.201(b). General licenses are contained within the Regulations whereas specific licenses are granted by the OFAC in response to requests. See *id.* §§ 515.201(b), 515.317, 515.318.

A general license authorizing certain actions with respect to trademarks is provided at **31 C.F.R. § 515.527**. The current version of the Regulations explicitly authorizes “[t]ransactions related to the registration and renewal in the United States Patent and Trademark Office or the United States Copyright Office of patents, trademarks, and copyrights in which the Government of Cuba or a Cuban national has an interest.” *Id.* § 515.527(a)(1). The government asserts that the applicable version of the Regulations is the version in effect in 1992, when the allegedly prohibited transfer of trademark rights to Cubatabaco occurred. See *Amicus Curiae Br.* at 8. In 1992, § 515.527 provided that:

- (1) The filing in the United States Patent Office of applications for letters patent and for trademarks registration;
- (2) The making and filing in the United States Copyright Office of applications for registration or renewal of copyrights;
- (3) The prosecution in the United States Patent Office of applications for letters patent and for trademarks registration;
- (4) The receipt of letters patent or trademark registration certificates or copyright registration or renewal certificates granted pursuant to any such applications in which any designated national has at any time on or since the “effective date” had any interest.

**31 C.F.R. § 515.527(a) (1992).** Therefore, the 1992 Regulations did not include an authorization for “[t]ransactions related to the registration and renewal in the United States Patent and Trademark Office ... of ... trademarks.” **31 C.F.R. § 515.527(a)(1).**

Also relevant to our inquiry is the specific license that OFAC granted Cubatabaco \*474 in October 1997 before Cubatabaco initiated this action. This license, number C-18942, authorizes Cubatabaco to

initiate legal proceedings in the U.S. courts and to otherwise pursue their judicial remedies with respect to claims to the COHIBA trademark (the “Trademark”) and against those persons that are alleged to be infringing upon the Trademark (collectively, the “Actions”); and Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C. (the “Firm”), and persons employed by, under the control of, or cooperating with the Firm, are hereby authorized to provide legal services to Cubatabaco and Habanos, S.A. in connection with the Actions, and to receive payment of professional fees and reimbursement for expenses incurred therefor from or on behalf of the Cubatabaco and/or Habanos, S.A., provided that payments of fees, retainers, and other payments originate from a source not currently within the United States, or within the possession or control of a person subject to U.S. jurisdiction, and such payment is not made from a blocked account or blocked funds.

Accordingly, we must determine whether Cubatabaco's acquisition of the U.S. COHIBA mark is a transfer that is prohibited by § 515.201(b), and if so, whether it is nonetheless authorized either by § 515.527, or by the specific license granted to Cubatabaco by the OFAC.

## 2. Prohibited Transfers

We hold that Cubatabaco's acquisition of the U.S. COHIBA mark through the famous marks doctrine would constitute a transfer that is prohibited by § 515.201(b), and such transfers are not authorized by a general or specific license.

### a. General Prohibition: 515.201(b)

Cubatabaco's acquisition of the U.S. COHIBA mark through the famous marks doctrine is barred by 31 C.F.R. § 515.201(b)(2), which prohibits “transfers outside the United States with regard to any property or property interest subject to the jurisdiction of the United States” if the transfer involves property in which a Cuban entity has an interest. 31 C.F.R. § 515.201(b)(2).

A transaction involving property in which a Cuban entity has an interest includes a transfer of property to a Cuban entity. “Property” includes trademarks, *id.* § 515.311, and “transfers outside the United States” of United States trademark rights to Cuban entities are prohibited by § 515.201(b)(2). “Transfer” is broadly defined to include “any ... act ... the ... effect of which is to create ... any right, remedy, power, privilege, or interest with respect to property.” *Id.* § 515.310. Cubatabaco's acquisition of the mark is a “transfer[ ] outside the United States with regard to any property or property interest subject to the jurisdiction of the United States,” *id.* § 515.201(b)(2), because Cubatabaco's acquisition of the mark is a transfer of U.S. property rights from inside the United States to Cuba—a location “outside of the United States.” Therefore, Cubatabaco's acquisition of the U.S. COHIBA mark through the famous marks doctrine is barred by § 515.201(b)(2).

Cubatabaco argues that the Embargo Regulations “regulate[ ] transactions involving property in which a Cuban national has, or had, an interest, *not* their legal effect.” Appellee Br. at 58. In other words, Cubatabaco claims that if the acts that made the Cuban COHIBA famous were permitted under the Regulations, Cubatabaco's acquisition of the mark through operation of the famous marks doctrine is permitted. We reject this argument because there is no doubt that acquisition of property through operation of law is covered by § 515.201(b). As the government \*475 asserts, “[r]egardless of whether the acquisition of the COHIBA mark through the famous marks doctrine is characterized as an ‘effect’ of other actions or not, it nevertheless falls within the Regulations’ definition of a ‘transaction’ involving property in which a Cuban national has an interest.” *Amicus Curiae* Br. at 7. The Regulations explicitly permit specific “transfers by operation of law,” including “[a]ny transfer to any person by intestate succession,” 31 C.F.R. § 515.525(a)(2), and transfers arising “solely as a consequence of the existence or change of marital status,” *id.* § 515.525(a)(1). These provisions would not be



necessary if § 515.201's prohibitions did not cover transfers by operation of law.

Our conclusion is consistent with the views expressed by the United States in its *amicus curiae* brief. The United States concludes that “[u]nder the plain language of these regulations, the acquisition of the trademark by Cubatabaco in 1992 through the famous marks doctrine, as found by the district court, created or vested a property right in Cubatabaco, and was therefore prohibited absent a general or specific license.” *Amicus Curiae* Br. at 7. Because we conclude that § 515.201(b)(2) clearly bars Cubatabaco's acquisition of the COHIBA mark through the famous marks doctrine, we need not determine what level of deference is owed to the U.S. Department of Treasury's interpretation of the Embargo Regulations. *Cf. Havana Club*, 203 F.3d at 125 (noting that the interpretation of a provision of the Embargo Regulations “given by the agency charged with enforcing the embargo is normally controlling”).<sup>5</sup>

#### ***b. General and Specific Licenses***

Because the acquisition of the U.S. COHIBA mark by Cubatabaco through the famous marks doctrine is a prohibited transfer under § 515.201, it is barred unless authorized by a general or specific license.

The general license contained in the 1992 version of § 515.527 does not authorize Cubatabaco's acquisition of the COHIBA mark through the famous marks doctrine. With respect to trademarks, that version of § 515.527 permitted only the filing of applications for trademark registrations, *id.* § 515.527(a)(1), and “[t]he receipt of ... trademark registration certificates ... or renewal certificates granted pursuant to any such applications,” *id.* § 515.527(a)(4). Clearly, neither of these provisions authorized Cubatabaco's acquisition of the mark through the famous marks doctrine. In addition, even if we applied the current version of § 515.527, which authorizes transactions “related to the registration and renewal” of trademarks in the United States Patent and Trademark Office, we would not read the provision to authorize acquisition of the mark through the famous marks doctrine, as acquisition of a mark through the famous marks doctrine is wholly outside the process of registering the mark with the PTO. *See* \*476 *Havana Club*, 203 F.3d at 123–24 (holding that the “related to” language of §

515.527(a)(1) should be interpreted narrowly as it creates an exception to the broad prohibitions of the embargo).<sup>6</sup>

Finally, the special license issued by OFAC to Cubatabaco, which allows Cubatabaco to “pursue ... judicial remedies with respect to claims to the COHIBA trademark,” does not permit acquisition of the mark via the famous marks doctrine. This license allows Cubatabaco to seek relief in U.S. courts, but does not authorize transfers of property barred by the Regulations. This is also the view of the government. *See Amicus Curiae* Br. at 10 (“[The OFAC license] does not retroactively authorize the acquisition found by the district court. The most obvious reading of this license is that it allows Cubatabaco to seek remedies but does not alter the substantive law for a court to apply in determining what, if any, remedies are appropriate.”)

Accordingly, Cubatabaco's acquisition of the U.S. COHIBA mark through the famous marks doctrine is barred by the Regulations. We reverse the District Court's finding of trademark infringement under Section 43(a) of the Lanham Act, as that finding was based on the District Court's conclusion that Cubatabaco acquired the COHIBA mark through the famous marks doctrine.

#### ***B. Cubatabaco's Claims for Injunctive Relief Based on Section 43(a) and the Paris Convention Fail Because They Entail a Transfer of Property Rights to Cubatabaco in Violation of the Embargo***

Cubatabaco argues that even if the Regulations bar its acquisition of the U.S. COHIBA mark, it is entitled to obtain cancellation of General Cigar's registration of the COHIBA mark and an injunction preventing General Cigar from using the mark in the United States because its mark was famous in the United States before General Cigar recommenced its use in November 1992. Cubatabaco maintains that this relief is warranted under Section 43(a) of the Lanham Act, as well as under Article 6bis of the Paris Convention, which it claims is implemented by Sections 44(b) and (h) of the Lanham Act even if full transfer of the COHIBA mark to Cubatabaco is prohibited.

As an initial matter, we find that granting Cubatabaco the injunctive relief sought would effect a transfer of property rights to a Cuban entity in violation of the embargo. There is no contest that, as matters stand, General Cigar has

the full panel of property rights in the COHIBA mark, including the right to exclude or limit others seeking to use the mark in the United States. Invoking Sections 43(a), 44(b), and 44(h) of the Lanham Act and treaty duties owed by a state party to the Paris Convention, Cubatabaco seeks to exclude General Cigar from commercial use of the COHIBA mark in the United States. There is no doubt that granting this relief to Cubatabaco would entail a transfer from General Cigar to Cubatabaco of a “right, remedy, power, privilege, or interest with respect to [the COHIBA mark].” 31 C.F.R. § 515.310. As it is exactly this brand of property right transfer that the embargo prohibits, we cannot sanction a grant of injunctive remedy to Cubatabaco in the form of the right, privilege, and \*477 power to exclude General Cigar from using its duly registered mark. As described below, this limitation on judicial authority applies equally to Cubatabaco's Lanham Act and Paris Convention claims.

### 1. Section 43(a) Claim for Unfair Competition

In response to the *amicus curiae* brief submitted by the United States, Cubatabaco argues that even if acquisition of the U.S. COHIBA mark is barred by the Embargo Regulations and Cubatabaco cannot bring a trademark infringement claim under Section 43(a) of the Lanham Act, it nonetheless should obtain, under Section 43(a), cancellation of General Cigar's mark and an injunction against General Cigar's use of the mark.<sup>7</sup> Cubatabaco asserts that the government correctly concludes that ownership of a mark is not required for a Section 43(a) claim of unfair competition, and that the District Court's factual findings support the conclusion that General Cigar violated Section 43(a).<sup>8</sup>

Cubatabaco did not litigate this Section 43(a) claim in the District Court. The only Section 43(a) claim that Cubatabaco brought was a claim for trademark infringement. Cubatabaco did initially assert in its complaint several non-trademark infringement claims under Section 43(a), but it stipulated to dismissal of those claims with prejudice after our decision in *Havana Club*. Cubatabaco argues, however, that “the United States' construction of the Lanham Act is properly before this Court” and “[a]ny supposed delay in advancing legal theories supporting affirmance is solely attributable to [General Cigar's] own failure to raise its [Embargo Regulations] arguments until appeal.” Appellee Letter Br. at 14. Because Cubatabaco might have litigated in

the District Court a claim of the type imagined by the United States had General Cigar argued below that the Regulations barred Cubatabaco's acquisition of the U.S. COHIBA mark through the famous marks doctrine, we address Cubatabaco's argument that the relief ordered by the District Court was appropriate even if the embargo prevents Cubatabaco from owning the U.S. COHIBA mark.

Adopting the views set forth in the *amicus curiae* brief filed by the United States, Cubatabaco argues that even if General Cigar owns the COHIBA mark in the United States, Cubatabaco can prevail in a Section 43(a) claim against General Cigar on the theory that General Cigar's use of the COHIBA mark in the United States causes consumer confusion. In support of \*478 this argument, Cubatabaco argues that Section 43(a) “goes beyond trademark protection.” Appellee Letter Br. at 8.

While it is true that Section 43(a) “goes beyond trademark protection,” *Dastar Corp. v. Twentieth Century Fox Film Corp.*, 539 U.S. 23, 28, 123 S.Ct. 2041, 156 L.Ed.2d 18 (2003), to prohibit market behavior that may “deceive consumers and impair a producer's goodwill,” *id.* at 32, 123 S.Ct. 2041, through “the deceptive and misleading use of marks ... ‘ § 43(a) can never be a federal codification of the overall law of unfair competition,’ but can apply only to certain unfair trade practices prohibited by its text,” *id.* at 28–29, 123 S.Ct. 2041 (quoting 4 J. McCarthy *Trademarks and Unfair Competition* § 27:7, p 27–14 (4th ed.2002) (internal quotation marks omitted)). Specifically, Section 43(a) includes causes of action grounded in allegations of “false or misleading description of fact,” “false or misleading representation of fact,” or false designation of geographic origin.

None of these theories need detain us here, however, because the case before us turns on the right to use the COHIBA mark, putting it well within the category of Section 43(a) cases that involve claims “for infringement of rights in a mark acquired by use.” *Virgin Enterps., Ltd. v. Nawab*, 335 F.3d 141, 146 (2d Cir.2003); see also 4 McCarthy, *supra*, § 27:9 (“[Section] 43(a) gradually developed through judicial construction into the foremost federal vehicle for the assertion of two major and distinct types of ‘unfair competition’: (1) infringement of even unregistered marks, names and trade dress, and (2) ‘false advertising.’ .... [I]n 1989, Congress codified the two-prongs ....”). Cubatabaco stipulated to the dismissal of

its false advertising claim and is not attempting to argue that General Cigar is engaging in any form of false advertising.<sup>9</sup>

Therefore, the cases that provide the closest analogues to the case at bar are those like *Genesee Brewing Co., Inc. v. Stroh Brewing Co.*, 124 F.3d 137 (2d Cir.1997), where we held that although Genesee could not prevail in a claim for trademark infringement under Section 43(a) against Stroh because the phrase “Honey Brown,” which it was seeking to protect, was generic as applied to Stroh's ale beer, “[t]he fact that Genesee's mark is generic as applied to Stroh's product ... does not preclude a finding that Stroh has violated the Lanham Act by engaging in unfair competition.” *Id.* at 149. In *Genesee*, the plaintiff's ability to bring a claim for confusion against a defendant using a particular trademark in commerce depended on the plaintiff showing that it was the first to use the mark in commerce. The plaintiff in *Genesee* was not attempting to assert a Section 43(a) unfair competition claim against a defendant who owned the mark at issue—rather, the claim was against a defendant who was using a generic mark subsequent to the plaintiff's use of the mark.

Cubatabaco's theory is that General Cigar's sale of COHIBA cigars in the United States violates Section 43(a) because it is likely to cause consumer confusion as to \*479 the source or attribution of those cigars. The confusion alleged by Cubatabaco in support of its Section 43(a) claim is derived solely from General Cigar's use of the COHIBA mark. Cubatabaco cannot obtain relief on a theory that General Cigar's use of the mark causes confusion, because, pursuant to our holding today, General Cigar's legal right to the COHIBA mark has been established as against Cubatabaco. General Cigar has a right to use the mark in the United States because it owns the mark in the United States.

In Part IA of this opinion we held that General Cigar has priority rights to the COHIBA mark in the United States as against Cubatabaco. *See supra* at page 472–76. To allow Cubatabaco to prevail on a claim of unfair competition against General Cigar and to obtain an injunction prohibiting General Cigar from using the mark would turn the law of trademark on its head. None of United States law, the facts in this case, or international treaties warrants such acrobatics in this case. We therefore find that, on the facts of this case, Cubatabaco's Section 43(a) claim seeking an injunction against General Cigar's

use of its duly registered COHIBA mark cannot succeed as a matter of law.

We do not find the analysis offered by the government and by Cubatabaco in defense of the recast Section 43(a) claim persuasive. It may be true that, as the government argues, “Cubatabaco's foreign registrations give it the right to register its COHIBA mark [in the United States], absent General Cigar's registration.” *Amicus Curiae Br.* at 12. That is, however, a hypothetical circumstance upon which we need not speculate. As we hold today, General Cigar *does have* a valid registration on the COHIBA mark in the United States. Further, while it may be true, as the government points out, that Cubatabaco's COHIBA mark “was ‘famous’ and had secondary meaning in the United States before General Cigar's first use [of its COHIBA mark],” *id.*, we have already held that this fact cannot justify a transfer of property rights in the COHIBA mark to Cubatabaco via the “famous marks doctrine.” We see no reason to alter that holding to allow Cubatabaco to achieve the same transfer via a route that is one step more circuitous than the path rejected above.

## 2. Article 6bis Paris Convention

Cubatabaco maintains that even if the Regulations bar its acquisition of the mark, and even if it cannot obtain relief for an unfair competition claim under Section 43(a), it has a right under Article 6bis of the Paris Convention, in conjunction with Sections 44(b) and (h) of the Lanham Act, to obtain cancellation of General Cigar's mark and an injunction against its use.

Article 6bis of the Paris Convention provides that:

- (1) The countries of the Union undertake, ex officio if their legislation so permits, or at the request of an interested party, to refuse or to cancel the registration, and to prohibit the use, of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark considered by the competent authority of the country of registration or use to be well known in that country as being already the mark of a person entitled to the benefits of this Convention and used for identical or similar goods. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

(2) A period of at least five years from the date of registration shall be allowed \*480 for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested.

(3) No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith.

Paris Convention, Art. 6bis, 21 U.S.T. at 1640.

Both the United States and Cuba are parties to the Paris Convention. *Id.* at 1669, 1676.

According to Cubatabaco, Sections 44(b) and (h) incorporate treaty provisions relating to the “repression of unfair competition,” and rights under Article 6bis fall into that category. Section 44(b) provides that:

Any person whose country of origin is a party to any convention or treaty relating to trademarks, trade or commercial names, or the repression of unfair competition, to which the United States is also a party, or extends reciprocal rights to nationals of the United States by law, shall be entitled to the benefits of this section under the conditions expressed herein to the extent necessary to give effect to any provision of such convention, treaty or reciprocal law, in addition to the rights to which any owner of a mark is otherwise entitled by this chapter.

15 U.S.C. § 1126(b). Therefore, Cubatabaco is entitled to the benefits of Section 44, “under the conditions expressed herein,” but only to the extent necessary to give effect to any provision of a treaty. Section 44(h) provides:

Any person designated in subsection (b) of this section as entitled to the benefits and subject to the provisions of this chapter shall

be entitled to effective protection against unfair competition, and the remedies provided in this chapter for infringement of marks shall be available so far as they may be appropriate in repressing acts of unfair competition.

*Id.* § 1126(h). “Rights under Section 44(h) are co-extensive with treaty rights under section 44(b), including treaty rights ‘relating to ... the repression of unfair competition.’” *Havana Club*, 203 F.3d at 134 (quoting 15 U.S.C. § 1126(b)); see also *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 907 (9th Cir.2002) (“[T]he grant in subsection (h) of effective protection against unfair competition is tailored to the provisions of the unfair competition treaties by subsection (b), which extends the benefits of section 44 only to the extent necessary to give effect to the treaties.’ Subsection 44(h) creates a federal right that is coextensive with the substantive provisions of the treaty involved.” (quoting *Toho Co. v. Sears, Roebuck & Co.*, 645 F.2d 788, 792 (9th Cir.1981) (citation omitted))).

Cubatabaco may be correct that Sections 44(b) and (h) incorporate Article 6bis and allow foreign entities to acquire U.S. trademark rights in the United States if their marks are sufficiently famous in the United States before they are used in this country. That is the view expressed by some commentators. See 4 *McCarthy on Trademarks and Unfair Competition* § 29:4 (4th ed. 2004) (“In the author’s view, the well-known or famous marks doctrine of Paris Convention Article 6bis is incorporated into United States domestic law though the operation of Lanham Act § 43(a), § 44(b) and § 44(h).” (footnote omitted)).<sup>10</sup>

\*481 However, we need not decide that broad question here because even assuming that the famous marks doctrine is otherwise viable and applicable, the embargo bars Cubatabaco from acquiring property rights in the U.S. COHIBA mark through the doctrine. The Embargo Regulations do not permit Cubatabaco to acquire the power to exclude General Cigar from using the mark in the United States. We do not read Article 6bis and Section 44(b) and (h) of the Lanham Act to require cancellation of General Cigar’s properly registered trademark or an injunction against its use of the mark in the United States under these circumstances.

In any event, to the extent that the Paris Convention, standing alone, might pose an irreconcilable conflict to the Regulations, the latter will prevail. “[A]n act of congress ought never to be construed to violate the law of nations, if any other possible construction remains.” *Weinberger v. Rossi*, 456 U.S. 25, 32, 102 S.Ct. 1510, 71 L.Ed.2d 715 (1982) (quotations and citations omitted). However, as we have recently recalled, “legislative acts trump treaty-made international law” when those acts are passed subsequent to ratification of the treaty and clearly contradict treaty obligations. *United States v. Yousef*, 327 F.3d 56, 110 (2d Cir.2003) (citing *Breard v. Greene*, 523 U.S. 371, 376, 118 S.Ct. 1352, 140 L.Ed.2d 529 (1998)); see also *Whitney v. Robertson*, 124 U.S. 190, 194, 8 S.Ct. 456, 31 L.Ed. 386 (1888) (if a treaty and a federal statute conflict, “the one last in date will control the other”). The most recent iteration of the Paris Convention was ratified by the United States in 1970, see 21 U.S.T. 1583; whereas the Regulations were reaffirmed and codified in 1996 with the passage of the LIBERTAD Act, 110 Stat. 792 (1996), 22 U.S.C. § 6032(h). In these circumstances, any claim grounded in the Paris Convention that presented an irreconcilable conflict with the Regulations would be rendered “null” by the Regulations. *Breard*, 523 U.S. at 376, 118 S.Ct. 1352.

## II. OTHER TREATY CLAIMS BROUGHT UNDER SECTIONS 44(B) AND (H) OF THE LANHAM ACT

### A. Articles 7 and 8 of the IAC

Cubatabaco argues that the District Court erred in dismissing its claims under Articles 7 and 8 of the Inter-American Convention. Both the United States and Cuba are parties to the IAC. See IAC, Art. 13, 46 Stat. 2907, 2946–47; *Havana Club Holding, S.A. v. Galleon S.A.*, 203 F.3d 116, 121 (2d Cir.), cert. denied, 531 U.S. 918, 121 S.Ct. 277, 148 L.Ed.2d 201 (2000).

Articles 7 and 8 appear in the chapter of the IAC entitled “Trademark Protection.” Article 7 provides that:

Any owner of a mark protected in one of the Contracting States in accordance with its domestic law, who may know that some other person is using or applying to register or deposit an interfering mark in any other of the Contracting

States, shall have the right to oppose such use, registration or deposit and shall have the right to employ all legal means, procedure or recourse provided in the country in which such interfering \*482 mark is being used or where its registration or deposit is being sought, and upon proof that the person who is using such mark or applying to register or deposit it, had knowledge of the existence and continuous use in any of the Contracting States of the mark on which opposition is based upon goods of the same class, the opposer may claim for himself the preferential right to use such mark in the country where the opposition is made or priority to register or deposit it in such country, upon compliance with the requirements established by the domestic legislation in such country and by this Convention.

IAC, Art. 7, 46 Stat. at 2918–19. Article 8 provides that:

When the owner of a mark seeks the registration or deposit of the mark in a Contracting State other than that of origin of the mark and such registration or deposit is refused because of the previous registration or deposit of an interfering mark, he shall have the right to apply for and obtain the cancellation or annulment of the interfering mark upon proving, in accordance with the legal procedure of the country in which cancellation is sought, the stipulations in Paragraph (a) and those of either Paragraph (b) or (c) below:

- (a) That he enjoyed legal protection for his mark in another of the Contracting States prior to the date of the application for the registration or deposit which he seeks to cancel; and
- (b) that the claimant of the interfering mark, the cancellation of which is sought, had knowledge of the use, employment, registration or deposit in any of the Contracting States of the mark for the specific goods to which said interfering mark is applied, prior to adoption and use thereof or prior to the filing of

the application or deposit of the mark which is sought to be cancelled; or

(c) that the owner of the mark who seeks cancellation based on a prior right to the ownership and use of such mark, has traded or trades with or in the country in which cancellation is sought, and that goods designated by his mark have circulated and circulate in said country from a date prior to the filing of the application for registration or deposit for the mark, the cancellation which is claimed, or prior to the adoption and use of the same.

IAC, Art. 8, 46 Stat. at 2920–21.

According to Cubatabaco, Articles 7 and 8 of the IAC “grant the owner of a trademark in one country (Cuba) the priority to register and to use the mark in another country (the U.S.), *as against* one ( [General Cigar] ) who had knowledge of the treaty national's prior use or registration (Cubatabaco's use or registration in Cuba).” Appellee's Br. at 85. Cubatabaco argues that under Articles 7 and 8, “[i]f the foreign treaty national's application to register the mark would otherwise be refused, it can cancel the ‘interfering’ registration” and “has the ‘right to oppose such use.’ ” *Id.*

Cubatabaco asserts that it is entitled to relief for its claims under Articles 7 and 8 of the IAC under Sections 44(b) and (h) of the Lanham Act. In *Havana Club*, however, we noted that a foreign entity may not assert a claim under Article 23 of the IAC pursuant to Section 44(h) of the Lanham Act “because the IAC does not treat rights under Article 23 as rights related to the repression of unfair competition.”<sup>11</sup> **\*483 *Havana Club*, 203 F.3d at 135 n. 19.** Following our holding in *Havana Club*, the District Court concluded that Cubatabaco could not assert rights under Articles 7 and 8 of the IAC pursuant to Section 44(h) of the Lanham Act because Articles 7 and 8 are not related to the repression of unfair competition. The court noted that Chapter IV of the IAC, which includes Articles 20, 21, and 22, is entitled “Repression of Unfair Competition,” whereas Articles 7 and 8 of the IAC are located in Chapter II, which is entitled “Trademark Protection.” *Emmpresa I*, 213 F.Supp.2d at 281. Furthermore, the court said that Articles 7 and 8 relate to priority of registration and under Section 44(d) Congress “specifically carved out how owners of trademarks registered in other countries may obtain a U.S. registration.” *Id.*

We agree with the District Court that Cubatabaco cannot assert claims under Articles 7 and 8 pursuant to Section 44(h) of the Lanham Act because Articles 7 and 8 do not relate to the repression of unfair competition. As General Cigar points out, Congress enacted Section 44(d) of the Lanham Act to implement treaty rights regarding priority of foreign registrants. Under Section 44(d), a foreign entity, whose country of origin is a party to a trademark treaty to which the United States is also a party, can secure priority in the United States from the date of its foreign registration as long as it registers in the United States within six months of the date of its foreign registration and it states that it has “a bona fide intention to use the mark in commerce.” **15 U.S.C. § 1126(d).** Foreign entities are entitled to this benefit regardless of whether a domestic registrant or user had knowledge of the prior foreign registration or use. Thus, although Section 44(d) contains a time limit, the priority rights it provides for foreign entities are broader than Articles 7 and 8 of the IAC. Congress implemented Articles 7 and 8 through Section 44(d) of the Lanham Act and those provisions do not relate to the “repression of unfair competition” within the meaning of Section 44(h). Accordingly, we hold that Cubatabaco cannot assert Article 7 or Article 8 rights under Sections 44(b) and (h) of the Lanham Act. The District Court properly dismissed these claims.

### ***B. Treaty–Based Unfair Competition Claims***

Cubatabaco argues that the District Court erred in dismissing its claims under Articles 20 and 21 of the IAC,<sup>12</sup> and Article **\*484 *10bis*** of the Paris Convention,<sup>13</sup> all of which Cubatabaco asserted pursuant to Sections 44(b) and (h) of the Lanham Act.

In *Havana Club* we dismissed a claim for unfair competition brought by the plaintiff under Article 21(c) of the IAC and Section 44(h) of the Lanham Act. We noted that Article 21 of the IAC “authorizes the prohibition of its specified acts of unfair competition ‘unless otherwise effectively dealt with under the domestic laws of the Contracting States.’ ” *Havana Club*, 203 F.3d at 134 (quoting IAC, Art. 21, 46 Stat. at 2932). We held that Section 43(a) already effectively prohibited the conduct covered by Article 21(c) of the IAC and dismissed the IAC claim. That holding applies here. Cubatabaco does not claim that Article 21 prohibits a broader range of conduct than Section 43(a) of the Lanham Act. Appellant Reply

Br. at 22. Therefore, Cubatabaco cannot bring a claim under Article 21 of the IAC pursuant to Sections 44(b) and (h). To the extent Cubatabaco is attempting to raise claims under IAC Article 20, that provision does not provide a separate basis for relief because it is implemented through Section 43(a) of the Lanham Act.

In addition, Cubatabaco cannot maintain a claim for unfair competition under Article 10bis of the Paris Convention pursuant to Sections 44(b) and (h) of the Lanham Act. The Paris Convention requires that “foreign nationals ... be given the same treatment in each of the member countries as that country makes available to its own citizens.” *Vanity Fair Mills v. T. Eaton Co.*, 234 F.2d 633, 640 (2d Cir.), cert. denied, 352 U.S. 871, 77 S.Ct. 96, 1 L.Ed.2d 76 (1956). “[T]he Paris Convention provides for national treatment, and does not define the substantive law of unfair competition.” *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 908 (9th Cir.2002). As the Eleventh Circuit has explained:

We agree that section 44 of the Lanham Act incorporated, to some degree, \*485 the Paris Convention. But we disagree that the Paris Convention creates substantive rights beyond those independently provided in the Lanham Act. As other courts of appeals have noted, the rights articulated in the Paris Convention do not exceed the rights conferred by the Lanham Act. Instead, we conclude that the Paris Convention, as incorporated by the Lanham Act, only requires “national treatment.”

National treatment means that “foreign nationals should be given the same treatment in each of the member countries as that country makes available to its own citizens.” So, section 44 of the Lanham Act gives foreign nationals the same rights and protections provided to United States citizens by the Lanham Act. As such, foreign nationals like Plaintiff may seek protection in United States courts for violations of the Lanham Act. But the Paris Convention, as incorporated by section 44 of the Lanham Act, creates no new cause of action for unfair competition. Any cause of action based on unfair competition must be grounded in the substantive provisions of the Lanham Act.

*Int'l Café, S.A.L. v. Hard Rock Café Int'l (U.S.A.), Inc.*, 252 F.3d 1274, 1277–78 (11th Cir.2001) (citations omitted). Therefore, we conclude that Cubatabaco cannot maintain a separate claim for unfair competition under

Article 10bis and Sections 44(b) and (h). Rather, a claim for unfair competition must be brought under Section 43(a) or state law. *See Mattel*, 296 F.3d at 908.<sup>14</sup>

### III. STATE LAW CLAIMS

Cubatabaco also argues that the District Court erred in dismissing its New York unfair competition claim, and its claim under New York's anti-dilution statute, N.Y. Gen. Bus. Law § 360–l.<sup>15</sup> We affirm the dismissal of both of these claims.

The District Court found that General Cigar had not acted in bad faith by using the COHIBA name, and, because bad faith must be demonstrated for a claim of unfair competition under New York law, Cubatabaco's claim should be dismissed. We agree. A plaintiff claiming unfair competition under New York law must show that the defendant acted in bad faith. *See Genesee Brewing Co., Inc. v. Stroh Brewing Co.*, 124 F.3d 137, 149 (2d Cir.1997) (“The district court was correct that Genesee's state law claim of unfair competition is not viable without a showing of bad faith.”); *Jeffrey Milstein, Inc. v. Greger, Lawlor, Roth, Inc.*, 58 F.3d 27, 35 (2d Cir.1995) (stating that in “a common law unfair competition claim under New York law” there “must be some showing of bad faith”). We find no error in the District Court's bad faith determination and therefore affirm the dismissal of the claim.

We affirm the District Court's dismissal of Cubatabaco's claim of dilution under New York General Business Law § 360–l. Cubatabaco has failed to establish that it owns the COHIBA mark and cannot prevail on a claim of dilution. *See The Sports Authority, Inc. v. Prime Hospitality Corp.*, 89 F.3d 955, 966 (2d Cir.1996) (“To establish a trademark dilution \*486 claim under New York law, TSA must show ownership of a distinctive mark and a likelihood of dilution.”).

### CONCLUSION

For the foregoing reasons, the judgment of the District Court is affirmed in part, reversed in part, and remanded for entry of an order dismissing all remaining claims. We vacate those portions of the District Court's order that cancel General Cigar's registration, enjoin its use of the mark, order it to deliver materials to Cubatabaco, and

require it to recall from retail customers and distributors products bearing the mark, and to inform customers and distributors that they cannot sell General Cigar's COHIBA-labeled products in the United States.

All Citations

399 F.3d 462, 73 U.S.P.Q.2d 1936

Footnotes

- 1 The stipulation stated that the dismissal was with prejudice, except that dismissal would be without prejudice if the Supreme Court reversed or vacated certain portions of this Court's decision in *Havana Club*.
- 2 Because we reverse on other grounds, we need not address the District Court's finding that General Cigar did, in fact, abandon the COHIBA mark. However, we do note that the District Court cited *Silverman* for the premise that "defendants must come forward with objective, hard evidence of actual 'concrete plans to resume use' in the 'reasonably foreseeable future when the conditions requiring suspension abate.'" *Emmpresa I*, 213 F.Supp.2d at 268. We do not agree that *Silverman* imposed such a heavy burden. *Silverman* required that, to overcome a presumption of abandonment after a sufficiently long period of non-use, a defendant need show only an intention to resume use "within the reasonably foreseeable future." *Silverman*, 870 F.2d at 46.
- 3 The court also rejected General Cigar's claim that Cubatabaco had abandoned the COHIBA mark between 1992 and 1997. *Empresa III*, 2004 WL 602295, at \*52.
- 4 We need not decide whether the current version of the Regulations or the 1992 version—the version in effect at the time Cubatabaco alleges it acquired rights to the U.S. COHIBA mark—applies. Except with respect to 31 C.F.R. § 515.527, all the provisions that we consider have either remained unchanged since 1992 or have changed in a manner immaterial to the issues raised here. As we discuss *infra* at page 476, although § 515.527 has been amended since 1992, neither the current version nor the 1992 version authorizes Cubatabaco's acquisition of the mark via the famous marks doctrine.
- 5 The *amicus curiae* brief cites § 515.201(b)(1) and does not specifically address § 515.201(b)(2). Section 515.201(b)(1) prohibits "transactions," including "transfers," involving property in which a Cuban entity has an interest by any person subject to the jurisdiction of the United States. 31 C.F.R. § 515.201(b)(1). Therefore, § 515.201(b)(1) prohibits transfers of trademarks to Cuban entities by persons subject to the jurisdiction of the United States. The District Court's holding that Cubatabaco's mark was sufficiently famous in 1992 for property rights to attach could be viewed as a transfer of property rights to Cubatabaco by a "person subject to the jurisdiction of the United States." The United States does not address that particular point, and we need not resolve it because Cubatabaco's acquisition of the mark through the famous marks doctrine is plainly barred by § 515.201(b)(2).
- 6 Indeed, Cubatabaco does not appear to be arguing that § 515.527(a)(1) permits acquisition through the famous marks doctrine. Instead, Cubatabaco argues that (1) its acquisition of the mark is not prohibited by § 515.201(b) because that section does not cover transfers by operation of law and (2) its acquisition of the mark is in any event permitted by the special license granted to it by the OFAC.
- 7 Section 43(a)(1) of the Lanham Act provides:
  - (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which -
    - (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
    - (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.15 U.S.C. § 1125(a)(1).
- 8 The government argues that canceling General Cigar's mark, enjoining General Cigar's use of the mark, and requiring General Cigar to recall goods and labels bearing the mark, based on a finding of unfair competition under Section 43(a), is not barred by the Embargo Regulations.
- 9 Section 43(a) also "goes beyond trademark protection" in the sense that the provision can be used to protect trade dress or to protect against other forms of product infringement. But this is not a case about trade dress—Cubatabaco originally brought a trade dress infringement claim but has not appealed the District Court's dismissal of the claim. This is, rather, a case about which entity owns the COHIBA trademark in the United States, and—principally because we hold that the



Regulations prohibit transfer of any property right in the COHIBA mark to Cubatabaco—we hold today that General Cigar, and not Cubatabaco, owns the COHIBA trademark in the United States.

10 *McCarthy* asserts that claims for protection of “famous” marks should be brought under Section 43(a). See 4 *McCarthy on Trademarks and Unfair Competition* § 29:4 (“Lanham Act § 43(a) gives a foreign national without a federal registration of its mark standing to sue in a federal court, invoke the well-known marks doctrine of the Paris Convention Article 6bis, and prevail if its mark is so well-known in the U.S. that confusion is likely.”). To the extent that a foreign entity attempts to utilize the famous marks doctrine as basis for its right to a U.S. trademark and seeks to prevent another entity from using the mark in the United States, the claim should be brought under Section 43(a). Under Section 43(a), both foreign and domestic entities can seek relief for infringement of unregistered marks.

11 Article 23 of the IAC, which appears under Chapter V of the IAC entitled “Repression of False Indications of Geographical Origin or Sources,” provides: “Every indication of geographical origin or source which does not actually correspond to the place in which the article, product or merchandise was fabricated, manufactured, produced or harvested, shall be considered fraudulent and illegal, and therefore prohibited.” IAC, Article 23, 46 Stat. at 2934.

12 Article 20 of the IAC provides that “[e]very act or deed contrary to commercial good faith or to the normal and honorable development of industrial or business activities shall be considered as unfair competition and, therefore, unjust and prohibited.” IAC, Art. 20, 46 Stat. at 2930–32. Article 21 provides:

The following are declared to be acts of unfair competition and unless otherwise effectively dealt with under the domestic laws of the Contracting States shall be repressed under the provisions of this Convention:

(a) Acts calculated directly or indirectly to represent that the goods or business of a manufacturer, industrialist, merchant or agriculturist are the goods or business of another manufacturer, industrialist, merchant or agriculturist of any of the other Contracting States, whether such representation be made by the appropriation or simulation of trade marks, symbols, distinctive names, the imitation of labels, wrappers, containers, commercial names, or other means of identification;

(b) The use of false descriptions of goods, by words, symbols or other means tending to deceive the public in the country where the acts occur, with respect to the nature, quality, or utility of the goods;

(c) The use of false indications of geographical origin or source of goods, by words, symbols, or other means which tend in that respect to deceive the public in the country in which these acts occur;

(d) To sell, or offer for sale to the public an article, product or merchandise of such form or appearance that even though it does not bear directly or indirectly an indication of origin or source, gives or produces, either by pictures, ornaments, or language employed in the text, the impression of being a product, article or commodity originating, manufactured or produced in one of the other Contracting States;

(e) Any other act or deed contrary to good faith in industrial, commercial or agricultural matters which, because of its nature or purpose, may be considered analogous or similar to those above mentioned.

*Id.*, Art. 21, 46 stat. at 2932–34.

13 Article 10*bis* provides:

(1) The countries of the Union are bound to assure to nationals of such countries effective protection against unfair competition.

(2) Any act of competition contrary to honest practices in industrial or commercial matters constitutes an act of unfair competition.

(3) The following in particular shall be prohibited:

1. all acts of such a nature as to create confusion by any means whatever with the establishment, the goods, or the industrial or commercial activities, of a competitor;

2. false allegations in the course of trade of such a nature as to discredit the establishment, the goods, or the industrial or commercial activities, of a competitor;

3. indications or allegations the use of which in the course of trade is liable to mislead the public as to the nature, the manufacturing process, the characteristics, the suitability for their purpose, or the quantity, of the goods.

Paris Convention, Art. 10*bis*, 21 U.S.T. at 1648.

14 In any event, as noted above, any irreconcilable conflict between the Paris Convention and the Regulations would be resolved in favor of the Regulations.

15 That statute provides:

Likelihood of injury to business reputation or of dilution of the distinctive quality of a mark or trade name shall be a ground for injunctive relief in cases of infringement of a mark registered or not registered or in cases of unfair competition,

notwithstanding the absence of competition between the parties or the absence of confusion as to the source of goods or services.

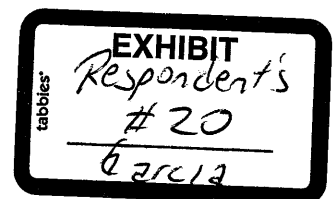
N.Y. Gen. Bus. Law § 360-1 (McKinney Supp.2004).

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# EXHIBIT 20



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92025859
Party	Plaintiff Empresa Cubana Del Tabaco d.b.a Cubatabaco
Correspondence Address	MICHAEL KRINSKY RABINOWITZ BOUDIN STANDARD KRINSKY & LIEBERMAN 45 BROADWAY, SUITE 1700 NEW YORK, NY 10006-3791 UNITED STATES mkrinsky@rbskl.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Michael Krinsky
Filer's e-mail	mkrinsky@rbskl.com, dreich@rbskl.com
Signature	/Michael Krinsky/
Date	06/23/2011
Attachments	Amended Petition. No. 92025859.pdf ( 32 pages )(1570887 bytes )

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEALS BOARD

In the matter of Trademark Registration No. 1147309  
For the mark COHIBA  
Date registered: February 17, 1981

AND

In the matter of the Trademark Registration No. 1898273  
For the mark COHIBA  
Date registered: June 6, 1995

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EMPRESA CUBANA DEL TABACO,	:	
d.b.a. CUBATABACO,	:	
	:	
Petitioner,	:	
	:	
v.	:	Cancellation No. 92025859
	:	
GENERAL CIGAR CO., INC. and CULBRO CORP.,	:	
	:	
Respondents.	:	
-----X		

**AMENDED PETITION FOR CANCELLATION**

EMPRESA CUBANA DEL TABACO, d.b.a. CUBATABACO (hereinafter  
“Cubatabaco”) submits of right, and pursuant to the Board’s Order of June 23, 2011, this  
Amended Petition for Cancellation of Registration Nos. 1147309 and 1898273 of the mark  
COHIBA in International Class 34 for cigars pursuant to 37 C.F.R. § 2.115; Fed. R. Civ. P. 15 as  
in effect prior to December 1, 2009; and Order of the Supreme Court of the United States dated  
March 26, 2009 (concerning the December 1, 2009 amendments to the Federal Rules of Civil  
Procedure), and avers as follows:

## **Parties**

1. Cubatabaco is a company with legal personality organized under the laws of Cuba. Its principal place of business is Calle O'Reilly, No. 104, Havana, Cuba. It is the owner of Application Serial No. 75226002 (filed January 15, 1997) to register COHIBA as a word mark pursuant to Section 44(e), Trademark Act, 15 U.S.C. § 1126(e), in International Class 34 for cigars (and other specified tobacco products and cigar accessories), on the basis of its ownership of the Cuban registration of the mark COHIBA in International Class 34 for the same goods.

2. Respondent General Cigar Co., Inc. ("General Cigar") is a Delaware corporation with its principal place of business in Connecticut. General Cigar is the owner of two registrations for the mark COHIBA in International Class 34 (hereinafter collectively sometimes "General Cigar's Registrations" or the "Registrations"): Registration No. 1147309, with registration date of February 17, 1981 (hereinafter sometimes "General Cigar's First Registration") and Registration No. 1898273, with registration date of June 6, 1995 (hereinafter sometimes "General Cigar's Second Registration").

3. Respondent Culbro Corporation ("Culbro") was a New York corporation and formerly the parent corporation of General Cigar. At all relevant times prior to General Cigar's incorporation in August 1986, Culbro engaged in the sale of cigars through a division or wholly owned subsidiary named "General Cigar & Tobacco Co." or the like. All references herein to "Culbro" include said division or subsidiary. Subsequent to the commencement of this proceeding, Culbro was merged with General Cigar Holdings, Inc., which is the surviving corporation of the merger. General Cigar Holdings, Inc. is the parent corporation of General Cigar. It is a Delaware corporation with its principal place of business in New York.

## **Procedural History**

4. On January 15, 1997, Cubatabaco filed Application Serial No. 75226002 to register COHIBA as a word mark in International Class 34 pursuant to Section 44(e), Trademark Act, 15 U.S.C. § 1126(e), for cigars (and other specified tobacco products and cigar accessories), on the basis of its ownership of the Cuban registration of the mark COHIBA in International Class 34 for the same goods. Also on January 15, 1997, Cubatabaco commenced the instant proceeding by filing a petition to cancel General Cigar's Registrations.

5. On January 28, 1998, the Board suspended proceedings on Cubatabaco's petition to cancel General Cigar's Registrations on account of an action brought by Cubatabaco against Culbro and General Cigar on November 12, 1997 in the United States District Court for the Southern District of New York, *Empresa Cubana del Tabacao v. Culbro Corp. and General Cigar Co., Inc.*, No. 97 Civ. 8399 (RWS). By filing dated October 27, 2010, Cubatabaco advised the Board that the action that occasioned the suspension had ended and that the instant proceeding should resume with Cubatabaco filing an Amended Petition of Cancellation as of right. By Order dated June 23, 2011, the Board resumed proceedings herein, and allowed Petitioner until thirty (30) days from the mailing date of said Order "in which to file a motion or pleading, as it deems appropriate, relevant to its petition to cancel."

6. In the action which occasioned suspension of this cancellation proceeding, the United States District Court for the Southern District of New York ("District Court") issued partial summary judgment to Cubatabaco on June 26, 2002, in which it cancelled General Cigar's First Registration on grounds of abandonment. The District Court held that General Cigar and Culbro, its predecessor in interest and assignor, had abandoned any rights in the First Registration, and any rights derived from its use of the mark COHIBA prior to November 20, 1992, because of non-use of the mark for a period of more than five years, until November 20,

1992, without intent to resume use. *Empresa Cubana del Tabacao v. Culbro Corp.*, 213 F.Supp. 2d 247 (S.D.N.Y. 2000).

7. After a bench trial, the District Court issued an opinion on March 26, 2004, cancelling General Cigar's Second Registration and enjoining General Cigar from using the mark COHIBA on the basis of the "well-known marks" doctrine. The District Court, after making extensive findings of fact, held that the Cuban COHIBA was well-known among U.S. consumers of premium cigars prior to General Cigar selling a COHIBA-branded product on November 20, 1992, after more than five years of non-use and abandonment, and prior to General Cigar filing an application for registration of the mark COHIBA on December 30, 1992, which matured into the Second Registration. The District Court further held that there was a likelihood of confusion as to source between the Cuban COHIBA and General Cigar's junior COHIBA mark. *Empresa Cubana del Tabaco v. Culbro Corp.*, 70 U.S.P.Q. 2d 1650 (S.D.N.Y. 2004). The District Court's judgment, entered on May 4, 2004, is reported at 2004 WL 925647.

8. On the basis of the United States Treasury Department's Cuban Assets Control Regulations, 31 C.F.R. Part 515 ("CACR"), the United States Court of Appeals for the Second Circuit reversed the District Court's cancellation of General Cigar's Second Registration and its injunction against General Cigar's use of the COHIBA mark. *Empresa Cubana del Tabaco v. Culbro Corp.*, 399 F.3d 462 (2d Cir. 2005). The Court of Appeals held that these rulings mooted any need to consider whether the CACR barred the District Court from cancelling General Cigar's First Registration on grounds of abandonment, or otherwise reviewing that order. *Empresa Cubana del Tabaco v. Culbro Corp.*, 399 F.3d at 471. On June 1, 2005, the United States Supreme Court denied Cubatabco's petition for a writ of *certiorari*.



9. On July 6, 2006, General Cigar moved in the District Court for an order directing the Patent and Trademark Office (“PTO”) to dismiss Cubatabaco's petition in the TTAB to cancel General Cigar's Registrations and to dismiss Cubatabaco's application for registration of COHIBA. General Cigar argued that this relief was required by the Court of Appeals’ decision and the CACR.

10. On March 14, 2007, the District Court denied General Cigar’s motion. It concluded that General Cigar's motion was untimely, and that, even if the motion were timely and not precluded by the appellate mandate, the motion must be denied. The District Court found that General Cigar had not sought dismissal of Cubatabaco’s petition for cancellation or its application for registration in the federal court action. It held that the Board, not the District Court, should decide whether grant of Cubatabaco's petition for cancellation was precluded by the Court of Appeals’ decision and that the PTO should do the same with respect to Cubatabaco’s application for registration. *Empresa Cubana del Tabaco v. Culbro Corp.*, 478 F. Supp. 2d 513 (S.D.N.Y. 2007).

11. The District Court further held that the Court of Appeals did not decide whether the CACR barred the Board from granting Cubatabaco’s petition for cancellation of General Cigar’s Registrations. Without deciding the issue, the District Court found that there were substantial arguments for concluding that the Board, as distinct from the federal courts, is authorized by CACR General License 31 C.F.R. § 515.527 to grant cancellation of both Registrations.

12. On September 4, 2008, the United States Court of Appeals for the Second Circuit affirmed the judgment of the District Court. *Empresa Cubana del Tabaco v. Culbro Corp.*, 541 F.3d 476 (2d 2008).

13. On the basis of an intervening decision of the New York Court of Appeals, Cubatabaco moved in the District Court on January 17, 2008 for relief pursuant to Rule 60(b)(6), Fed. R. Civ. P., from the District Court's 2005 judgment dismissing its claim of unfair competition under New York common law, and for an injunction under New York unfair competition law against General Cigar's use of COHIBA. On November 19, 2008, the District Court granted Cubatabaco's motion. The District Court found that General Cigar had begun to sell a COHIBA-branded product on November 20, 1992 and had applied for a second registration for COHIBA on December 30, 1992, after at least five years of non-use of the mark and abandonment, in order to capitalize upon and to exploit the renown and reputation of the Cuban COHIBA in the United States, including the reputation and renown generated for the Cuban COHIBA by the extensive coverage and praise of the Cuban COHIBA as the world's finest cigar in the premier issue of *Cigar Aficionado*, which was published on September 1, 1992. *Empresa Cubana del Tabaco v. Culbro Corp.*, 587 F. Supp. 2d 622 (S.D.N.Y. 2008).

14. On January 15, 2010, the District Court, applying its November 19, 2008 decision, issued a judgment permanently enjoining General Cigar from using the mark COHIBA for cigars.

15. On July 14, 2010, the Court of Appeals for the Second Circuit reversed the District Court's judgment. It did not reach the District Court's finding that General Cigar had sought to capitalize upon and to exploit the substantial renown and reputation of the Cuban COHIBA in the United States. Rather, the Court of Appeals held that the intervening decision of the New York Court of Appeals did not present sufficient grounds under Rule 60(b)(6), Fed. R. Civ. P., to reopen the nearly three-year old judgment in favor of General Cigar. On October 12,

2010, Cubatabaco's time to file for a petition for a writ of *certiorari* in the United States Supreme Court expired without Cubatabaco filing a petition.

#### **Cubatabaco's Pending Application for Registration of COHIBA**

16. On August 14, 1997, the Trademark Attorney issued a Non-Final Office Action under Section 2(d), Trademark Act, 15 U.S.C. § 1052(d), refusing Cubatabaco's January 15, 1997 application to register the mark COHIBA. The Trademark Attorney found that the applicant's mark, when used on or in connection with the identified goods, so resembles the mark comprising General Cigar's two Registrations as to be likely to cause confusion, or to cause mistake, or to deceive.

17. In his August 14, 1997 Non-Final Office Action, the Trademark Attorney also referenced, as a possible ground for refusal if it matured into a registration, Application Serial No. 75/051706 for COHIBA, filed by General Cigar on January 2, 1996, in International Class 03, for men's fragrances; 09, for eyeglasses and sunglasses; 14, for jewelry and watches; 16, for writing instruments; 18, for leather goods; 25, for men's knitwear, active wear golf apparel; 33, for alcoholic beverages; and 34, for smokers' accessories. On July 9, 1997, the Trademark Attorney suspended further action on Application Serial No. 75/051706 pending disposition of an application (Application Serial No. 75/012912) filed by Tequila Cuervo La Rojena on October 31, 1995, for the mark COHIBA in International Class 33, for alcoholic beverages. General Cigar filed an opposition to that application, Opposition Serial No. 91117311, on March 10, 2000. On General Cigar's motion, with the consent of Applicant, proceedings on that opposition were suspended on January 1, 2007, pending the outcome of the instant proceeding to cancel General Cigar's two Registrations, upon which General Cigar relies in its opposition. On November 16, 1999, the Trademark Attorney suspended proceedings on Cubatabaco's

application to register the mark COHIBA pending the disposition of Application Serial No. 75/051706. On January 12, 2000, the Trademark Attorney suspended proceedings on Cubatabaco's application to register the mark COHIBA pending the disposition of the federal court action and the disposition of Application Serial No. 75/051706. Proceedings on Cubatabaco's application remain suspended.

18. Save for the matters referenced in paragraphs 16 and 17, the Trademark Attorney has withdrawn all other asserted grounds for refusal to grant Cubatabaco's application to register COHIBA.

#### **The Cuban Assets Control Regulations**

19. By General License, 31 C.F.R. § 515.527, the CACR authorize the Board to grant the instant petition and to cancel General Cigar's two Registrations. The U.S. Treasury Department's Office of Foreign Assets Control ("OFAC"), which administers the CACR, issued a ruling on August 19, 1996 (FAC Nos. C-152409, C-152468) confirming that General License 31 C.F.R. § 515.527 authorizes a Cuban national to petition the Board for cancellation of, and for the Board to cancel, a registration that is an obstacle to the Cuban national's efforts to register a trademark. OFAC's ruling is applicable to the instant petition for cancellation.

#### **General Cigar's First Registration of COHIBA (Registration No. 1147309)**

20. On March 13, 1978, Culbro filed an application to register the mark COHIBA in International Class 34 for cigars. It represented that it had first used the COHIBA mark in commerce on February 18, 1978, and that the mark was then in use in commerce.

21. In 1969, Cubatabaco filed an application to register COHIBA in Cuba in International Class 34 for cigars (and other tobacco products and cigar accessories); the registration issued on May 31, 1972 as Registration No. 1147309.

22. By 1970, cigars branded with Cubatabaco's COHIBA trademark were being produced at the El Laguito factory in Havana, Cuba.

23. Throughout the 1970's, Cuban COHIBA cigars were commercially available and sold in Cuba at Havana's main hotels, upscale restaurants and two retail outlets, including sales to United States visitors to Cuba. From 1970 to 1975, annual sales through these channels averaged approximately 96,000 cigars per year, and increased to approximately 180,000 cigars per year by 1975. In addition, since at least 1970, COHIBA cigars had been sold to the Cuban Council of State, which includes the office of the Cuban President, and to another Cuban enterprise, which in turn sold the cigars to Cuban Ministries and other government institutions. Cuba's then President, Fidel Castro Ruz, regularly gave COHIBA cigars as state gifts, as did other governmental officials. The total volume of sales of COHIBA grew from approximately 350,000 to 375,000 per year from 1970 to 1975 to approximately 550,000 to 600,000 per year from 1975 to 1980.

24. By January 1978, Cubatabaco had applied to register COHIBA for cigars in 17 foreign countries, including most of the Western European countries, which registrations issued in due course.

25. Culbro first learned of the mark and the word "COHIBA" when it learned of the Cuban COHIBA in 1977. On or about November 15, 1977, Culbro's principal executives read a *Forbes* article published under that date discussing the potential impact of Cuban cigars on the U.S. industry and noting that Cubatabaco was developing a COHIBA cigar to market abroad. A December 1977 internal company memorandum referred to COHIBA as "sold in Cuba/brand in Cuba" and "Castro's brand cigars." In February 1978, an employee discussed the Cuban COHIBA brand with Culbro's chairman; the employee had learned of the brand from a friend

who had visited Cuba on behalf of the State Department and was given COHIBA cigars in Cuba by the highest echelons of the Cuban Government. A February 6, 1978 article in *New York* magazine also featured Cubatabaco and COHIBA.

26. Prior to March 13, 1978, numerous U.S. journalists, business executives, and other U.S. persons knew of the Cuban COHIBA from its sale in retail outlets and hotels in Havana, from buying COHIBA-branded cigars in Cuba and receiving COHIBA as gifts in Cuba and at receptions at the Cuban Mission to the United Nations in New York and the Cuban Interests Section in Washington, D.C., and by word of mouth.

27. Prior to filing an application in the PTO on March 13, 1978 to register the mark COHIBA, Culbro knew of the existence, use, continuous use, and employment of the mark COHIBA in Cuba for cigars.

28. Prior to filing its application on March 13, 1978 to register the mark COHIBA, Culbro expected the Cuban COHIBA to obtain great renown and cachet in the United States because of Cuba's extraordinary and unequalled renown in the United States for cigars, Cubatabaco's positioning of COHIBA as the pinnacle of Cuban cigars, and COHIBA's association with Cuba's then President, Fidel Castro.

29. Culbro applied for the registration of COHIBA for the purpose of using its ownership of the U.S. registration to block Cubatabaco from entering the U.S. market with COHIBA-branded Cuban cigars when the U.S. embargo on trade with Cuba ended, and to coerce Cubatabaco into granting distribution rights for the Cuban COHIBA in the U.S. once the U.S. embargo ended.

30. Culbro applied for the registration of the mark COHIBA in bad faith.

31. On July 25, 1978, the PTO, in a Non-Final Office Action, required Culbro to advise “whether the term COHIBA has any meaning or significance in the relevant trade or industry.” On January 3, 1979, Culbro responded that “to the best of applicants’ knowledge, the term ‘Cohiba’ has no English translation, or any meaning or significance in the relevant trade or industry.” Culbro knowingly made a material misrepresentation of fact and material omission of fact when it responded that “Cohiba” did not have any meaning or significance in the relevant trade or industry and did not inform the PTO that Cohiba was the name of a Cuban cigar, and that the Cuban cigar was associated with Cuban President Fidel Castro and used as a state gift in Cuba, and did so with specific intent to obtain registration of the mark COHIBA through false and fraudulent pretenses, which Culbro knew would otherwise be refused.

32. The PTO issued Registration No. 1147309 on February 17, 1981 in reliance on Culbro’s representation in its application that it had first used the mark COHIBA in commerce on February 18, 1978, and that the mark was then in use in commerce, and in reliance on the aforesaid responses of Culbro to the PTO’s Non-Final Office Action.

33. Culbro knowingly made a material misrepresentation of fact and material omission of fact in its March 13, 1978 application to register the mark COHIBA when it represented that it had first used the COHIBA mark in commerce on February 18, 1978 and that the mark was then in use in such commerce, and did so with specific intent to obtain registration of the mark COHIBA through false and fraudulent pretenses, which Culbro knew would otherwise be refused.

34. Neither on its claimed first use date of February 18, 1978, nor on the date of its application for registration, March 13, 1978, nor thereafter through and including issuance of the First Registration on February 17, 1981 and into 1982, did Culbro use the COHIBA trademark in

commerce, or engage in any bona fide sale of cigars under the COHIBA trademark. It only engaged in the self-described “trademark maintenance program” as alleged in paragraphs 35 through 39 herein.

35. From the claimed first use date of February 18, 1978 into 1982, Culbro shipped 1,000 or fewer cigars per year in boxes labeled with “COHIBA.” The cigars were White Owl “stock” machine-made cigars that were shipped along with other White Owl cigars (or other factory “seconds”), labeled with as many as 32 other different brands as part of what internal General Cigar documents characterized as a “trademark maintenance program.”

36. The COHIBA-labeled boxes and the other 32 differently labeled cigars were irregularly and sporadically shipped to only two retailers who, by prearrangement, were given a full credit back on the nominal payment they made to Culbro.

37. Two boxes of 50 cigars of each of the 33 brands were simultaneously shipped in identical cardboard boxes, with stick-on labels affixed to two boxes for each of the 33 different brands. These shipments were not sent out when “seconds” were not available. The cardboard boxes with the different labels, including the two boxes of “COHIBA”-labeled cigars, were displayed in the same cartons in which they were shipped. If the two boxes with the COHIBA label were not at the top of the carton, they would not have been visible to the consumer. General Cigar made no effort to place the two boxes with the COHIBA label on the top of the carton.

38. Culbro shipped the following amounts of COHIBA-branded White Owl seconds in the above manner during this period: 1978 – 650; 1979 – 600; 1980 – 1,000; 1981 – 700; 1982 – (single shipment on April 15, 1982).



39. From the claimed first use date of February 18, 1978 and thereafter through and including issuance of the Registration on February 17, 1981, neither Culbro nor any retailer or other person, engaged in any advertising, promotion, point of sale promotion or any other efforts to stimulate sales of the White Owl cigars in the boxes labeled COHIBA, or to establish any goodwill for its COHIBA mark.

40. In July 1981, Cubatabaco announced that it would soon begin commercial exports of COHIBA in *Cubatabaco International*, which it published for the foreign cigar trade. In this publication, Cubatabaco expressly positioned COHIBA as the pinnacle of Cuban cigars.

41. In January 1982, a Spanish trade publication reported that Cuba would soon begin international sales of the "famous cigar COHIBA." In June 1982, *El Pais*, a large general circulation newspaper, reported on the imminent arrival of COHIBA in Spain. On June 30, 1982, Cubatabaco launched international commercial sales of its COHIBA cigars at an event in Madrid, during the soccer World Cup, which was being held in Spain.

42. Following the events alleged in paragraphs 40 and 41, Culbro, beginning in November 1982, placed the COHIBA mark on its pre-existing Canario D'Oro premium cigar. Its sole promotion of the brand consisted of in-store advertising. The COHIBA-branded Canario D'Oro was packed in a clear plastic canister with a price between that of a high-end premium cigar and a "bundled" cigar.

43. Culbro sold 90,000 of the COHIBA-branded Canario D'Oro cigars in November and December 1982; 323,000 in 1983; 118,000 in 1984; 70,000 in 1985; and 5,000 in 1986 prior to June; and none thereafter.

44. On June 23, 1986, Culbro filed a sworn "Declaration Under Sections 8 and 15 of the Trademark Act of 1946," to which it attached the packaging in which the Canario D'Oro

COHIBA had previously been sold. Culbro declared that the “mark shown therein is still in use, as evidenced by the attached specimen showing the mark as currently used;” and that “the mark shown therein has been in continuous use in interstate commerce for five consecutive years from February 17, 1981 to the present.” In reliance on these representations, the PTO accepted the Declaration and found that it satisfied the statutory requirements of Sections 8 and 15 of the Trademark Act.

45. Culbro knowingly made a material misrepresentation of fact and material omission of fact in its aforesaid Declaration when it represented that the mark had been “in continuous use in interstate commerce for five consecutive years from February 17, 1981 to the present” and was still in use in interstate commerce, and did so with specific intent to have the PTO find that it had satisfied the statutory requirements of Sections 8 and 15, and that its First Registration was entitled to continue in effect, through false and fraudulent pretenses, which finding Culbro knew would otherwise not be made.

46. On January 13, 1987, Culbro assigned approximately 120 of its trademarks, including the COHIBA mark and the First Registration, to its newly incorporated subsidiary, General Cigar.

47. Culbro and General Cigar made no sales under the COHIBA mark for at least five years prior to November 20, 1992. For at least five years prior to November 20, 1992, they did not engage in any advertising, promotion, or any other efforts to establish or to maintain any goodwill for its COHIBA mark.

48. This non-use for more than five years is prima facie evidence of and gives rise to a presumption of abandonment of the First Registration and any rights derived from use of the COHIBA mark prior to November 20, 1992.

49. Culbro ceased sales of COHIBA-branded cigars with the intent not to resume use.

50. Culbro and General Cigar had no intention of resuming use when use was discontinued and during more than five years of non-use, until after September 1, 1992.

51. During more than five years of non-use, until after September 1, 1992, Culbro and General Cigar did not have plans to resume use in the reasonably foreseeable future or at any point.

52. There is no contemporaneous evidence of such plans.

53. During this period, Culbro and General Cigar did not undertake the activities that a reasonable business with a bona fide intent to use the mark in U.S. commerce would have taken.

54. During this period, Culbro and General Cigar did not undertake any activities with the intention of rekindling, or that might have rekindled, the public's identification, if any, of the mark COHIBA with Culbro and General Cigar.

55. Culbro and General Cigar abandoned the First Registration and any rights that they may have derived from use of the mark in commerce prior to discontinuing use.

**General Cigar's Second Registration (Registration No. 1898273)**

56. After more than five years of non-use with no intention to resume use, General Cigar commenced sales of a COHIBA-branded product on November 20, 1992 and filed an intent to use application for a second registration of COHIBA (Block Letters) for cigars on December 30, 1992, pursuant to Section 1(b), Trademark Act, 15 U.S.C. § 1051(b).

57. On January 5, 1995, General Cigar filed a Statement of Use of the mark COHIBA on or in connection with cigars in support of its application. It represented therein that it had first used the mark COHIBA in commerce in the form applied for in December 1992.

58. General Cigar's application matured into the Second Registration on June 6, 1995, as Registration No. 1898273.

59. Cubatabaco used the COHIBA mark in the United States prior to November 20, 1992, including, without limitation, in the ways alleged hereafter, and had not, and has not, abandoned the mark.

60. As a result of Cubatabaco's use of the COHIBA mark in the United States, Cubatabaco had, prior to November 20, 1992, built up substantial goodwill, renown and reputation for its COHIBA cigars in the United States; created public awareness of COHIBA as identifying Cubatabaco as the source of COHIBA-branded cigars; created, in the mind of the relevant purchasing public, an association of COHIBA with Cubatabaco's cigar; popularized COHIBA in the public mind as identifying COHIBA-branded cigars as the product of Cubatabaco; and caused the purchasing public to recognize COHIBA as a mark used in connection with a cigar product emanating exclusively from Cubatabaco.

61. The February 15, 1992 issue of *The Wine Spectator*, a United States publication, was devoted principally to Cuban cigars and gave particular prominence to the Cuban COHIBA. Its paid circulation was 105,659, of which a substantial number, at least 70%, were consumers of premium cigars in the United States. At the time, there were approximately 467,000 consumers of premium cigars in the United States. The February 15, 1992 issue was purchased by more than 15% of the premium cigar consumers in the United States. It reached a higher percentage of the premium cigar consumers in the United States as a result of pass along readership and word of mouth.

62. "The Allure of Cuban Cigars, Special Report from Havana 30 Years After the U.S. Embargo" occupied all of the issue's cover. The cover story identified COHIBA as Cuba's

“finest” cigar. In an article entitled “The Man Behind the Coveted Cohiba,” the issue profiled the manager of the El Laguito cigar factory in Havana, Cuba, where COHIBA cigars are made, and reported on COHIBA extensively, noting that “Cohiba is revered by cigar aficionados like Lafite or Petrus are treasured by wine connoisseurs” and that it “was Fidel Castro’s most coveted cigar.” Another article reported that COHIBA is “*the* hot brand” in London’s cigar shops. The issue powerfully projected COHIBA more than any other cigar, and positioned it as the best of the best, the best of Cuban cigars.

63. *The Wine Spectator*’s focus on and high praise of the Cuban COHIBA in its February 15, 1992 issue was the result of a week-long trip to Cuba in September 1991 by its publisher and editor, Marvin Shanken, and senior staff member James Suckling. Cubatabaco arranged for Shanken and Suckling’s trip to Cuba to report on Cuban cigars; arranged for them to visit the prime tobacco growing regions of Cuba and principal cigar factories and facilities; arranged interviews with figures in Cuba’s cigar industry; and discussed Cuban cigars and possible story lines with Shanken and Suckling. At its own expense, Cubatabaco provided translators for Shanken and Suckling, and Cubatabaco personnel accompanied them throughout their visit, guiding and assisting them. Cubatabaco devoted substantial time, effort and expense to assisting Shanken and Suckling.

64. During this trip, Cubatabaco encouraged Shanken and Suckling to pay particular and pre-eminent attention to the Cuban COHIBA in the forthcoming issue of *Wine Spectator*. To that end, it arranged for visits to El Laguito cigar factory, where COHIBA is manufactured; arranged for interviews with the head of El Laguito factory; and arranged for visits to the vegas (farms) outside of Havana where the tobacco for COHIBA is grown. Cubatabaco invested this

time, effort and expense for the purpose of promoting Cuban cigars and, most prominently, COHIBA, in the United States.

65. During this period, Shanken was considering whether to launch a consumer publication devoted to premium cigars. He conceived of the Cuban cigar issue of *Wine Spectator* as a test and possible prototype for this new publication.

66. During his September 1991 visit to Cuba, Shanken expressed the hope that Cubatabaco would provide support and cooperation for the new publication, and Cubatabaco indicated it would do so, with the stated expectation that the new publication would feature Cuban cigars prominently and regularly and thereby help promote them in the United States. While in Cuba during this trip, Shanken decided to go forward with the magazine, which he launched in September 1992 as *Cigar Aficionado*.

67. In February 1992, Cubatabaco advised Shanken that it would advertise in the planned cigar magazine, and would provide additional assistance and support for the publication on an on-going basis, including by suggesting stories and story lines, arranging for Shanken and his reporters to visit Cuba, giving Shanken and his reporters access to cigar vegas and factories, accompanying them on these visits, arranging interviews and providing, at its own expense, translators, transportation within Cuba and Cuban cigars to sample.

68. Cubatabaco placed a full page, color advertisement for COHIBA, with the legend "COHIBA the first name in cigars," in the premier issue of *Cigar Aficionado*, which was published on September 1, 1992. Cubatabaco placed the same advertisement in the second, December 1992 issue, which was published and placed in circulation prior to November 20, 1992.

69. Cubatabaco intended to place advertisements for COHIBA in subsequent issues of *Cigar Aficionado*, but was prevented from doing so by General Cigar's threat of legal action against *Cigar Aficionado* for trademark infringement if the magazine continued to carry advertisements for the Cuban COHIBA. Cubatabaco and/or its distributors thereafter regularly placed advertisements in *Cigar Aficionado* without specifically referencing COHIBA.

70. During his February 1992 visit to Cuba, Shanken asked Cubatabaco what promotion it would prefer in the premier issue of *Cigar Aficionado*, and Cubatabaco informed Shanken that it preferred the premier issue to focus on the Cuban COHIBA.

71. Shanken returned to Cuba in May 1992 on a visit arranged for and supported by Cubatabaco. Cubatabaco arranged for Shanken to meet with the presidents of Cubatabaco's exclusive foreign distributors, who were holding their annual meeting with Cubatabaco in Havana at the time, in order for Shanken to explain his plans for *Cigar Aficionado* and to solicit their advertising, support and cooperation. Cubatabaco encouraged the distributors to support the magazine, including by placing advertisements. The exclusive distributors agreed to support the magazine, including by placing advertisements, and to cooperate with the publication.

72. One of Cubatabaco's exclusive foreign distributors ran a full-page, color advertisement in the premier and second issues of *Cigar Aficionado* that featured COHIBA and another exclusive distributor placed a full-page, color advertisement in both issues that featured Cuban cigars. Further advertisement by the distributors featuring COHIBA was prevented by General Cigar's threat of legal action against the magazine.

73. To promote COHIBA in the premier issue, Cubatabaco arranged for the visits of *Cigar Aficionado*'s editors, writers and staff to Cuba, provided them with information about COHIBA, made arrangements for and accompanied them on visits to the El Laguito factory,

where COHIBA is made; arranged an interview with its manager, Avelino Lara; arranged for visits to the vegas outside of Havana where the tobacco for COHIBA is grown; and provided them at its own expense with translators, transportation within Cuba and COHIBA cigars to sample.

74. On September 1, 1992, Shanken published the premier issue of *Cigar Aficionado*. At the time, it was the only U.S. publication devoted to premium cigars other than trade publications.

75. The premier issue had a U.S. circulation of 115,000 copies. At year-end 1991, there were approximately 467,000 premium cigar smokers in the U.S.; by year-end 1992, there were approximately 484,000. Thus, the circulation of the premier issue of *Cigar Aficionado* was equal to approximately 25% of all premium cigar smokers in the United States at the time. In addition, pass along readership, word of mouth and extensive press coverage in other media of *Cigar Aficionado*'s launch significantly extended the reach of the premier issue and its praise of the Cuban COHIBA.

76. As a result in substantial part of Cubatabaco's foregoing efforts, alleged in paragraphs 60 through 73, the premier issue of *Cigar Aficionado*, in addition to running two full-page, color advertisements for the Cuban COHIBA, focused principally and preeminently on the Cuban COHIBA, and provided powerful and favorable promotion for the Cuban COHIBA in the United States.

77. The premier issue's table of contents lists "Cuba's Cohiba," with the description: "An inside look at Cuba's legendary brand, perhaps the world's finest smoke;" no other brand is mentioned in the table of contents.



78. The referenced article, authored by James Suckling, is the first major story to appear in the magazine and occupies six pages. It is entitled, “The Legend of Cohiba: Cigar Lovers Everywhere Dream of Cuba's Finest Cigar.”

- a. The article begins by unequivocally stating that COHIBA is “considered Cuba’s finest cigars,” and that “Cohiba is legendary to most cigar aficionados, and for more than two decades it has been one of the government’s most prestigious gifts to honor foreign dignitaries,” from King Carlos of Spain and the Queen of England to Russia’s Boris Yelsin and Saddam Hussein. “Lighting up a Cohiba, such as an Esplendido or Robusto, is a great experience. They are gloriously rich with aromas and flavors of chocolate and coffee, yet they remain incredibly elegant. To a cigar lover, smoking a Cohiba is a moment to savor. It gives the same kind of satisfaction as a wonderful glass of Chateau Lafite-Rothschild gives to a wine lover or a superb main course at a Michelin three-star restaurant does to a gourmet.”
- b. The next paragraph, still on the article’s title page, is devoted to the cigar’s association with Fidel Castro, describing it as holding a “special place in the heart of Cuba’s president” and “like a lost love” after he gave up smoking, and depicting Castro as one who “still dreams of smoking a Cohiba.” Castro says that giving up the Cohiba for the anti-smoking campaigns “may have been one of his greatest sacrifices to the revolution”; “Fidel loved smoking Cohibas.”

- c. The article's title page continues with a paragraph describing the Cohiba as "the cigar of the world cognoscenti" and a "symbol of financial success," and reporting that "actors such as Tom Cruise and Arnold Schwarzenegger have standing orders" with European merchants for Cohiba, "while business magnates have been known to light up Cohibas after a successful meal."
- d. There follows five more pages of photos, text, and graphics embellishing and extending the same themes.
- e. One of these pages is a graphic depiction of "The Six Cigars of Cohiba" (Lanceros, Esplendido, Coronas Especial, Robusto, Exquisito, and Panetela) with their ratings by *Cigar Aficionado*: 94, 98, 87, 96, 90 and 89, respectively.

79. The next article in the magazine powerfully reinforces the COHIBA story and also the advertisements for COHIBA. It begins with a dramatic two-page photo of a movie being shot on a beach, with a superimposed title "Discovering Columbus" and subtitle, "Ridley Scott, Cohiba in Hand, Directs Gerard Depardieu in *1492*." This title functions as a strong celebrity endorsement.

80. Other highly positive references to the Cuban COHIBA appear throughout the magazine. There was no article in the premier issue devoted to any other cigar brand.

81. As Cubatabaco intended and hoped, *Cigar Aficionado*'s strong projection of COHIBA in its premier issue generated prominent, highly favorable references to COHIBA in other publications in the United States. The September 21, 1992 issue of *Newsweek*, with a national circulation of 3,195,309, reported on the launch of *Cigar Aficionado*; it described *Cigar*

*Aficionado*’s “blind tastings,” and noted, “Unfortunately this month’s winner, the five-inch Cohiba Robusto (‘mouth-filling with rich coffee, spicy flavors and an impressively long finish’) is Cuban and can’t be bought on the open U.S. market.” The article also commented on the “impressive 60 pages of ads for such premium products as a handblown bottle of Glenlivet Scotch at \$650, Louis Vuitton luggage and, of course, Cohiba cigars.” A *Miami Herald* article on September 30, 1992 features COHIBA and quotes Shanken that COHIBA is the best Cuban cigar. Additional media published articles soon after the premier issue and before November 20, 1992, that focused on the growing cigar market and referenced both *Cigar Aficionado* and the Cuban COHIBA.

82. The premier issue of *Cigar Aficionado* provided a significant boost to the renown and reputation of the Cuban COHIBA among premium cigar consumers in the United States.

83. The second, December 1992 issue of *Cigar Aficionado* was prepared, published and circulated prior to November 20, 1992. In addition to paid advertisements for COHIBA, the second issue gave the COHIBA Esplendido and the COHIBA Robusto exceptional ratings of 98 and 96, respectively; placed both in a gallery of “Star Cigars of Cuba,” and described both in the most glowing terms.

84. Cubatabaco launched the 1492 Siglo (meaning, “Century”) line of COHIBA at the 5th Centennial celebration of the landing of Columbus in Cuba, held in Havana from November 2 to November 4, 1992. Cubatabaco invited Shanken and Suckling from *Cigar Aficionado*, and paid their admission fees to the event. In its November 6, 1992 edition, the *Journal of Commerce*, a U.S. publication, featured an article on the launch. The March 1993 issue of *Cigar Aficionado* contained a laudatory feature on the launch, and gave high ratings, from 90 to 96, to each COHIBA cigar in the line.

85. After the premier issue, Cubatabaco continued to provide ongoing support and assistance in the foregoing ways to *Cigar Aficionado*, whose writers continued to visit Cuba between two and three times per year. *Cigar Aficionado* continued to give prominent attention to the Cuban COHIBA.

86. From the early 1980's through the launch of *Cigar Aficionado* in September 1992, as well as thereafter, Cubatabaco consistently promoted the Cuban COHIBA in United States media and in other ways in the United States, in addition to the ways alleged in the preceding paragraphs. It did so by encouraging U.S. press to report on COHIBA, arranging for them to visit the El Laguito factory and the vegas where COHIBA is grown; arranging for interviews with persons associated with COHIBA; and providing them with translators and transportation at its own expense. It arranged the visits to Cuba of U.S. journalists wishing to write specifically about cigars. Cubatabaco also arranged for Cuba's International Press Center to refer to Cubatabaco those U.S. journalists already in Cuba on other assignments who wished to report on Cuban cigars, and provided those U.S. journalists with support and encouragement, with a particular emphasis on promoting COHIBA.

87. From the early 1980's to November 20, 1992, and thereafter, Cubatabaco also promoted COHIBA in the United States by arranging numerous visits by famous and influential U.S. personalities to El Laguito, where COHIBA is manufactured, and to the vegas where the tobacco for COHIBA is grown; by providing them with translators and guides on these visits at its own expense; by offering them COHIBA cigars at its own expense to sample in Cuba; and by encouraging their interest in and familiarity with COHIBA.

88. In substantial part as a result of Cubatabaco's foregoing efforts, there were approximately 46 articles published in U.S. media between 1986 and November 20, 1992 that

mentioned the Cuban COHIBA, in addition to the *Wine Spectator* and *Cigar Aficionado* articles. These articles refer to the Cuban COHIBA in highly positive terms. They also portray the Cuban COHIBA as the cigar of choice of the famous, rich and powerful, which provided powerful promotion of the cigar.

89. For more than two decades prior to November 20, 1992, Cubatabaco sold COHIBA-branded cigars in Cuba to United States visitors who visited Cuba, including through airport shops, hotels, restaurants and other retail outlets. Throughout this period, the CACR authorized U.S. nationals within a variety of specified categories to travel to Cuba; and, from March 21, 1977 through April 20, 1982, authorized all U.S. nationals to travel there. There were approximately 484,000 visits by U.S. nationals to Cuba pursuant to United States law between 1979 and 1992 alone.

90. From at least May 12, 1977 to 2004, the CACR authorized United States nationals to purchase merchandise in Cuba for importation as accompanied baggage into the United States for personal use in the United States, provided that the value of the merchandise imported into the United States did not exceed \$100 per person every six months. Pursuant to this authorization, numerous United States nationals purchased COHIBA cigars in Cuba and brought them back to the United States for personal consumption in the United States. Cubatabaco sold COHIBA cigars to United States nationals for such importation, including to departing U.S. nationals at airports awaiting flights to the United States.

91. Prior to November 20, 1992: (a) the Cuban COHIBA was well-known among the consumers of premium cigars in the United States; (b) it enjoyed considerable renown and notoriety among the consumers of premium cigars in the U.S.; (c) it had a known reputation among the consumers of premium cigars in the U.S.; (d) the primary significance of COHIBA

was to identify the source of the Cuban COHIBA; (f) a substantial percentage of the consumers of premium cigars in the U.S. knew of the Cuban COHIBA; (g) a majority of the consumers of premium cigars in the U.S. were familiar with COHIBA as the mark of the Cuban COHIBA; (h) approximately 62% to 71% of the consumers of premium cigars in the U.S. knew of the Cuban COHIBA; (i) the Cuban COHIBA had achieved a renown among consumers of premium cigars in the U.S. consistent with secondary meaning; and (j) the Cuban COHIBA enjoyed a unique and eminent position among consumers of premium cigars in the U.S. as a cigar of international fame and prestige. In substantial part, the foregoing was a result of Cubatabaco's efforts to promote the Cuban COHIBA in the United States as alleged in paragraphs 61 through 90.

92. By the time General Cigar commenced use of a COHIBA-branded product on November 20, 1992 and filed an application to register the mark COHIBA on December 30, 1992, no goodwill, reputation or recognition remained, if any ever existed, from Culbro's prior use of the mark COHIBA.

93. After publication of *Cigar Aficionado's* premier issue, General Cigar decided to begin use of a COHIBA-labeled cigar and to file an application in the PTO to register the COHIBA mark for the purpose of capitalizing on and exploiting the renown, reputation and goodwill of the Cuban COHIBA in the United States. General Cigar plagiarized Cubatabaco's COHIBA mark and engaged in its intentional copying on account of, and in order to capitalize on and to exploit, the Cuban COHIBA's renown, reputation and goodwill in the United States.

94. As part of General Cigar's effort to capitalize on and to exploit the Cuban COHIBA's renown, reputation and goodwill in the United States immediately after the premier issue of *Cigar Aficionado*, General Cigar simply re-labeled some Temple Hall cigars, one of its

existing cigar products, as COHIBA, while it also continued to sell the identical product as Temple Hall.

95. Because it acted for the reasons alleged in paragraph 93, General Cigar's application for the Second Registration was in bad faith.

96. Prior to commencing sale of a COHIBA-branded cigar on November 20, 1992, and applying to register the COHIBA mark on December 30, 1992, General Cigar knew of the existence, use, continuous use, and employment of the mark COHIBA in Cuba for cigars, and also knew of the mark's registration in Cuba.

#### **Allegations Applicable to Both Registrations**

97. The COHIBA mark is inherently distinctive or, in the alternative, has acquired distinctiveness.

98. Contemporaneously, and at all relevant times, the mark that comprises General Cigar's Registrations so resembles the COHIBA mark used by Cubatabaco in the United States as to be likely, when used on or in connection with cigars, to cause confusion, or to cause mistake, or to deceive.

99. Cubatabaco believes that it is and will be damaged by General Cigar's Registration Nos. 1147309 and 1898273 of the mark COHIBA

100. Cubatabaco has now, and, since prior to 1978, always had the intention to sell its COHIBA-branded cigars in the United States as soon as United States law permits.

101. Cubatabaco has continued to promote the Cuban COHIBA in the United States since November 1992, including by regularly providing encouragement, support and assistance to U.S. cigar magazines, general interest U.S. newspapers and magazines, the authors of numerous U.S. books on cigars, and U.S. television programs in reporting on COHIBA.

Between November 23, 1992 and September 15, 2002, for example, approximately 1,111 stories in U.S. newspapers and magazines referenced the Cuban COHIBA, often prominently; at least 33 U.S. television programs referenced the Cuban COHIBA during approximately the same time span; *Cigar Aficionado* prominently referenced the Cuban COHIBA; and approximately 25 books on cigars for U.S. consumers prominently referenced the Cuban COHIBA.

**First Ground for Cancellation (Reg. No. 1147309)**

102. Cubatabaco repeats and realleges each and every allegation set forth in paragraphs 1 through 101 as if fully set forth herein.

103. Respondents abandoned the mark comprising Registration No. 1147309. Cancellation of Registration No. 1147309 is required pursuant to Section 14 of the Trademark Act, 15 U.S. C. § 1064, on this ground.

**Second Ground for Cancellation (Reg. No. 1147309)**

104. Cubatabaco repeats and reallages each and every allegation set forth in paragraphs 1 through 101 as if fully set forth herein.

105. Registration No. 1147309 was obtained fraudulently. Its cancellation is required pursuant to Section 14 of the Trademark Act, 15 U.S. C. § 1064, on this ground.

**Third Ground for Cancellation (Reg. No. 1147309)**

106. Cubatabaco repeats and reallages each and every allegation set forth in paragraphs 1 through 101 as if fully set forth herein.

107. Culbro's "Declaration Under Sections 8 and 15 of the Trademark Act of 1946," filed on June 23, 1986, was fraudulent. Cancellation of Registration No. 1147309 pursuant to section 14 of the Trademark Act, 15 U.S. C. § 1064, is required on this ground.

**Fourth Ground for Cancellation (Reg. No. 1147309)**



108. Cubatabaco repeats and realleges each and every allegation set forth in paragraphs 1 through 101 as if fully set forth herein.

109. Culbro applied for and obtained Registration No. 1147309 in bad faith and for impermissible reasons. Cancellation of Registration No. 1147309 pursuant to Section 14 of the Trademark Act, 15 U.S. C. § 1064, is required for this reason.

**Fifth Ground for Cancellation (Reg. No. 1147309)**

110. Cubatabaco repeats and reallages each and every allegation set forth in paragraphs 1 through 101 as if fully set forth herein.

111. Articles 7 and 8 of the General Inter-American Convention for Trade Mark and Commercial Protection, 46 Stat. 2907, and Section 17 of the Trademark Act, 15 U.S.C. § 1067, require cancellation of Registration No. 1147309.

**Sixth Ground for Cancellation (Reg. No. 1898273)**

112. Cubatabaco repeats and reallages each and every allegation set forth in paragraphs 1 through 101 as if fully set forth herein.

113. The COHIBA mark comprising Registration No. 1898273 so resembles the COHIBA mark used in the United States by Cubatabaco prior to General Cigar's application for said registration and prior to General Cigar's use of the COHIBA mark on which said application was based and granted, and not abandoned, as to be likely, when used on or in connection with the goods of General Cigar, to cause confusion, or to cause mistake, or to deceive. Cancellation of Registration No. 1898273 is required pursuant to Sections 2(d) and Section 14 of the Trademark Act, 15 U.S.C. §§ 1052, 1064, on that ground.

**Seventh Ground for Cancellation (Reg. No. 1898273)**

114. Cubatabaco repeats and realleges each and every allegation set forth in paragraphs 1 through 101 as if fully set forth herein.

115. Articles 7 and 8 of the General Inter-American Convention for Trade Mark and Commercial Protection, 46 Stat. 2907, and Section 17 of the Trademark Act, 15 U.S.C. § 1067, require cancellation of Registration No. 1898273.

**Eighth Ground for Cancellation (Reg. No. 1898273)**

116. Cubatabaco repeats and realleges each and every allegation set forth in paragraphs 1 through 101 as if fully set forth herein.

117. General Cigar applied for and obtained the Registration for the purpose of capitalizing on and exploiting the renown and reputation of the Cuban COHIBA in the United States. Cancellation of Registration No. 1898273 is required pursuant to Section 14 of the Trademark Act, 15 U.S.C. § 1064, on that ground.

**Ninth Ground for Cancellation (Reg. No. 1898273)**

118. Cubatabaco repeats and realleges each and every allegation set forth in paragraphs 1 through 101 as if fully set forth herein.

119. Cancellation of Registration No. 1898273 is required pursuant to Article 6*bis* of the Paris Convention for Protection of Industrial Property, 21 U.S.T. 1629, and Section 17 of the Trademark Act, 15 U.S.C. § 1067.

**Tenth Ground for Cancellation (Reg. No. 1898273)**

120. Cubatabaco repeats and realleges each and every allegation set forth in paragraphs 1 through 101 as if fully set forth herein.

121. Cancellation of Registration No. 1898273 is required on the basis of the “well-known” marks doctrine and Section 14 of the Trademark Act, 15 U.S.C. § 1064.

**Eleventh Ground for Cancellation (Reg. No. 1147309 and Reg. No. 1898273)**

122. Cubatabaco repeats and realleges each and every allegation set forth in paragraphs 1 through 101 as if fully set forth herein.

123. Cubatabaco used the mark COHIBA in commerce in the United States prior to General Cigar's application for registration of the mark COHIBA that matured into Reg. No. 1147309 and prior to General Cigar's first use of the COHIBA mark.

124. Cubatabaco used the mark COHIBA in commerce in the United States prior to General Cigar's application for registration of the mark COHIBA that matured into Reg. No. 1898273 and prior to General Cigar's use of the COHIBA mark commencing on November 20, 1992.

125. Cancellation of Registration Nos. 1147309 and 1898273 pursuant to Section 14 of the Trademark Act, 15 U.S.C. § 1064, is required on those grounds.

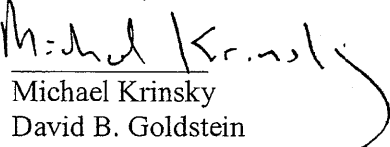
**WHEREFORE**, Petitioner Cubatabaco prays that this Petition be granted and that Registration Nos. 1147309 and 1898273 of the mark COHIBA be cancelled.

Respectfully submitted,

Dated: New York, New York  
June 23, 2011

Rabinowitz, Boudin, Standard, Krinsky &  
Lieberman, P.C.

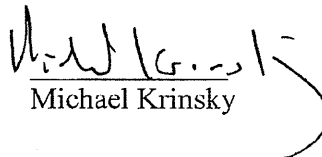
By:

  
Michael Krinsky  
David B. Goldstein  
45 Broadway, Suite 1700  
New York, NY 10006  
(212) 254-1111

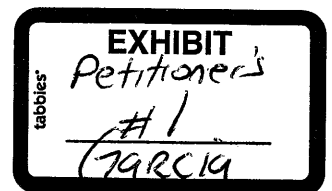
**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true copy of the attached Amended Petition for Cancellation was served by first class mail, postage prepaid, on the 23<sup>rd</sup> day of June 2011 upon the attorney of record for the Respondents at the following address:

Andrew L. Deutsch  
Airina L. Rodrigues  
DLA Piper LLP (US)  
1251 Avenue of the Americas  
New York, NY 10020

  
Michael Krinsky

# EXHIBIT 1



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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In the Matter of Trademark Application  
Serial No. 76460193  
Filed: October 22, 2002  
Published for Opposition: April 15, 2003

Empresa Cubana del Tabaco, d.b.a. Cubatabaco,  
Opposer,

v.

Kachaturian, Kris I., Applicant.

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U.S. Patent & TMO/TM Mail Rcpt Dt. #22

**NOTICE OF OPPOSITION**

Applicant, Kachaturian, Kris I., an individual located at 18438 Bryant Street, Northridge, California, 91325, is seeking to obtain registration of the design mark attached hereto as Appendix A in International Class 34 for use on cigars. The application was filed on October 22, 2002, and published for opposition on April 15, 2003.

Opposer, Empresa Cubana del Tabaco, d.b.a. Cubatabaco ("Cubatabaco"), a corporation organized under the laws of the Republic of Cuba, believes that it will be damaged by the registration that Applicant is seeking and, through its authorized attorneys, hereby opposes registration of this application. On May 22, 2003, the United States Patent and Trademark Office extended the period for Cubatabaco to oppose

Applicant's application through and including July 14, 2003.

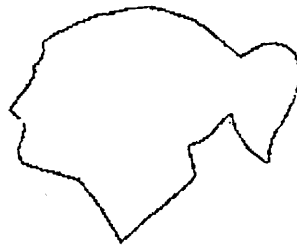
07/21/2003 SWILSON1 00000077 7640193

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The grounds for the opposition are as follows:

1. Applicant's application, Serial No. 76460193, was filed on October 22, 2002, in International Class 34, alleging an intent to use the mark shown below as a trademark on cigars. The applied-for mark consists of the silhouette of an indian head (the "Indian Head").

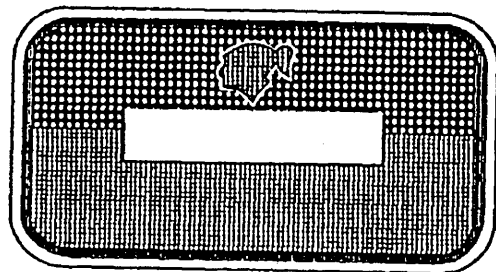


*Applicant's Proposed Mark*

2. Opposer owns the registration for BEHIKE and design, Registration No. 1,557,163, in International Class 34, and a design mark, Registration No. 2,145,804, also in International Class 34. The Indian Head features prominently in these registered marks ("Opposer's Indian Head Marks").



*Registration No. 1,557,163*



*Registration No. 2,145,804*

3. The Indian Head in Applicant's mark is a virtually identical copy of the Indian Head prominently featured in Opposer's Indian Head Marks in the same class.

4. Opposer owns the registrations for numerous other Cuban cigar marks, both in Cuba and in the United States. Although the United States Treasury Department's Cuban Assets Control Regulations, 31 C.F.R. Part 515, which implement the United States' trade and financial embargo against Cuba and Cuban nationals, prohibit, *inter alia*, the importation of goods in which Cuba or any Cuban national has an interest, they also explicitly provide that Cuban entities can register trademarks in the United States, 31 C.F.R. § 515.527(a)(1).

5. Cubatabaco's registered Indian Head trademark is one of the most famous cigar trademarks in the world. Internationally, the Indian Head is the trademark used in association with Cuba's legendary Cohiba cigars, which are widely regarded as the finest cigars in the world. Although rights in the United States to the word mark COHIBA currently are the subject of litigation involving Cubatabaco in the United States District Court for the Southern District of New York, it is undisputed that Cubatabaco is the owner of the various components of the registered Cohiba trade dress, including the Indian Head, in the United States. Cubatabaco also has registered the Cohiba trade dress, including the Indian Head, in conjunction with the word mark BEHIKE, and a § 8 affidavit of excusable nonuse was accepted for that mark on January 26, 1996.

6. Cubatabaco clearly has established indisputable priority with respect to the Indian Head mark, and intends to sell and transport goods, including cigars, using



its Indian Head Marks in the United States as soon as the legal prohibitions against doing so are lifted. That Cubatabaco is currently using the mark in trade in other countries, where there are no prohibitions on trade, demonstrates that it has the requisite intent to use the Indian Head mark in commerce in the United States.

7. Cubatabaco's Indian Head mark is widely recognized in the United States and around the world amongst cigar smokers, and it has received substantial coverage and publicity from national publications and newspapers. Even in the absence of any registration, Cubatabaco would have prior rights in the Indian Head mark because the mark is both well known and famous in the relevant market.

8. The mark proposed for registration by Applicant, namely, the Indian Head, is copied directly from Opposer's registered marks, is applied to the same goods as Opposer's Indian Head Marks (namely, cigars), in the same International Class 34, and so nearly resembles Opposer's Indian Head Marks as to be likely to be confused with Opposer's Indian Head Marks. Applicant's mark is deceptively similar to Opposer's Indian Head Marks so as to cause confusion and lead to misunderstanding as to the origin of Applicant's goods bearing the Indian Head mark.


9. If the Applicant is granted the registration herein opposed, confusion in trade resulting in damage and injury to Opposer would be caused and would result from the similarity between Applicant's mark and Opposer's Indian Head Marks. Consumers familiar with the famous Cubatabaco Indian Head Marks would be

likely to purchase Applicant's products or services mistakenly believing them to be products or services sold by Opposer or an entity affiliated with Opposer. Furthermore, any faults or objections found with Applicant's products or services would reflect poorly upon and injure the international reputation for quality that Opposer has established for its cigars and other products sold under its Indian Head Marks.

Wherefore, Opposer prays that application Serial No. 76460193 be refused registration and that this opposition be sustained.

Dated: July 11, 2003  
New York, New York

Respectfully submitted,

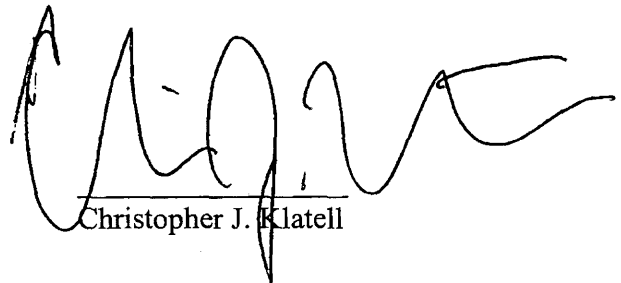


David B. Goldstein  
RABINOWITZ, BOUDIN,  
STANDARD, KRINSKY &  
LIEBERMAN, P.C.  
740 Broadway, Fifth Floor  
New York, New York 10003  
Tel: (212) 254-1111

*Attorneys for Empresa Cubana del  
Tabaco, d.b.a. Cubatabaco*

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this Notice of Opposition is being deposited today,  
July 11, 2003, with the United States Postal Service, utilizing the "Express  
Mail Post Office to Addressee" service, in an envelope addressed to:  
Commissioner for Trademarks, BOX TTAB FEE, 2900 Crystal Drive,  
Arlington, Virginia 22202-3513.



Christopher J. Klatell



## UNITED STATES PATENT AND TRADEMARK OFFICE

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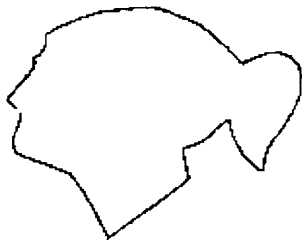
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## Record 1 out of 1

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**Goods and Services** IC 034. US 002 008 009 017. G & S: Cigars

**Mark Drawing**  
**Code** (2) DESIGN ONLY

**Design Search**  
**Code** 020301 020324

**Serial Number** 76460193

**Filing Date** October 22, 2002

**Filed ITU** FILED AS ITU

**Published for**  
**Opposition** April 15, 2003

**Owner** (APPLICANT) Kachaturian, Kris I. INDIVIDUAL UNITED STATES 18438  
Bryant Street Northridge CALIFORNIA 91325

**Attorney of Record** Kamran Fattahi, Esq.

**Type of Mark** TRADEMARK

**Register** PRINCIPAL

**Live/Dead**  
**Indicator** LIVE

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TTAB

**RABINOWITZ, BOUDIN, STANDARD, KRINSKY & LIEBERMAN, P.C.**

**ATTORNEYS AT LAW**

740 BROADWAY AT ASTOR PLACE, FIFTH FLOOR  
NEW YORK, NY 10003-9518

TELEPHONE (212) 254-1111

FACSIMILE (212) 674-4614

LEONARD B. BOUDIN (1912-1989)  
MICHAEL KRINSKY  
ERIC M. LIEBERMAN  
DAVID B. GOLDSTEIN

ROGER BEARDEN  
GREGORY SILBERT †  
JAYKUMAR A. MENON  
CHRISTOPHER J. KLATELL  
CARRIE CORCORAN

†ADMITTED IN CALIFORNIA ONLY

COUNSEL  
VICTOR RABINOWITZ  
MICHAEL B. STANDARD  
LEONARD I. WEINGLASS  
ELLEN J. WINNER  
DEBRA EVENSON  
TERRY GROSS

07-11-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

July 11, 2003

**Via Express Mail**

BOX TTAB FEE  
Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

Re: *Notice of Opposition to Application Serial No. 76460193*

Dear Trademark Trial and Appeal Board Staff:

Enclosed please find the original and two copies of a Notice of Opposition to Application Serial No. 76460193 to register a design mark in International Class 34. Also enclosed is a check for the filing fee in the amount of \$300.00

Thank you for your attention to this matter.

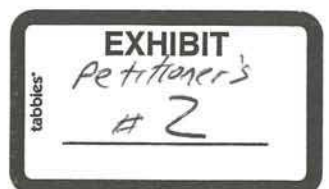
Very truly yours,

Christopher J. Klatell

Enclosures

07 JUL 23 07 5:31  
COMM-FEDERAL AND

# EXHIBIT 2



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application  
Serial No. 78169098  
Filed: September 30, 2002  
Published for Opposition: October 21, 2003  
  
Empresa Cubana del Tabaco, d.b.a. Cubatabaco,  
Opposer,  
  
v.  
  
Reel Smokers Cigar Distributors, Applicant.

X  
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12-19-2003

U.S. Patent & TMO/TM Mail Rpt Dt. #22

NOTICE OF OPPOSITION

Applicant, REEL SMOKERS CIGAR DISTRIBUTORS, a corporation located at 504 South Federal Hwy, Deerfield Beach, FL 33441, is seeking to obtain registration of the mark SIBONEY & DESIGN shown in paragraph 1, *infra*, in International Class 34 for use on cigars and cigarettes. The application was filed on September 30, 2002, and published for opposition on October 21, 2003.

12/24/2003 GTHOMAS2 00000121 78169098

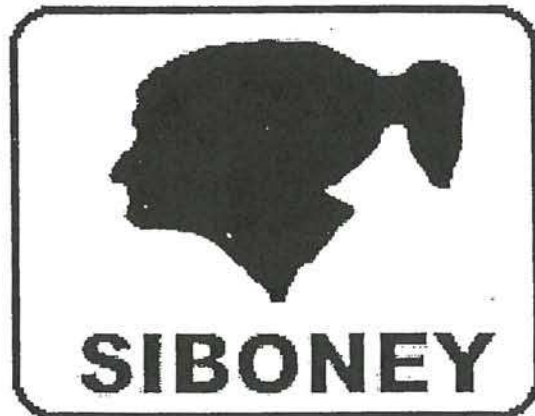
01 FC:6402

300.00 0P

Opposer, EMPRESA CUBANA DEL TABACO, d.b.a. CUBATABACO ("Cubatabaco"), a corporation organized under the laws of the Republic of Cuba, believes that it will be damaged by the registration that Applicant is seeking and, through its authorized attorneys, hereby opposes registration of this application. On November 14, 2003, the United States Patent and Trademark Office ("USPTO") extended the period for Cubatabaco to oppose Applicant's application through and including December 20, 2003.

The grounds for the opposition are as follows:

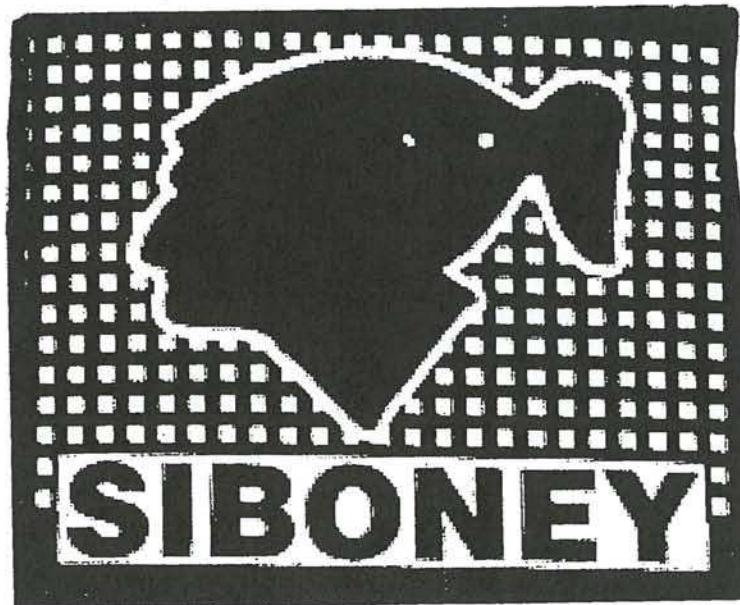
1. Applicant's application, Serial No. 78169098, was filed on September 30, 2002, in International Class 34, alleging an intent to use the mark shown below as a trademark on "tobacco products, namely cigars and cigarettes." The applied-for mark consists of the silhouette of an Indian head (the "Indian Head") and the word mark "SIBONEY" in block letters, as shown:



*Applicant's Proposed Mark*



2. Applicant's original drawing accompanying its proposed registration was deemed unacceptable by the United States Patent and Trademark Office on March 6, 2003. The drawing deemed unacceptable was virtually identical to the current drawing except that the original drawing contained a checkerboard backdrop for the Indian Head and "SIBONEY" block-letter word mark.

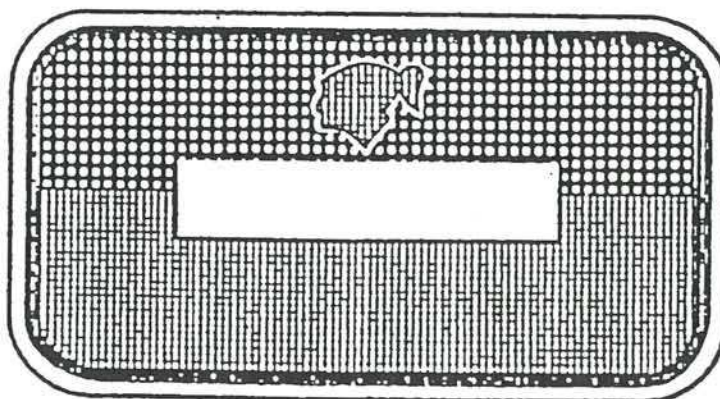


*Applicant's Original Proposed Mark*

3. Opposer owns the registration for BEHIKE and Design, Registration No. 1,557,163, in International Class 34, and a design mark, Registration No. 2,145,804, also in International Class 34. The Indian Head features prominently in these registered marks ("Opposer's Indian Head Marks").



*Registration No. 1,557,163*



*Registration No. 2,145,804*

4. The Indian Head in Applicant's mark is a virtually identical copy of the Indian Head prominently featured in Opposer's Indian Head Marks in the same International Class.

5. The checkerboard backdrop in Applicant's original proposed mark is virtually identical to the checkerboard backdrop featured in Opposer's Indian Head Marks in the same class.

6. Opposer owns the registrations for numerous other Cuban cigar marks, both in Cuba and in the United States. Although the United States Treasury Department's Cuban Assets Control Regulations, 31 C.F.R. Part 515, which implement the United States' trade and financial embargo against Cuba and Cuban nationals, prohibit, *inter alia*, the importation of goods in which Cuba or any Cuban national has an interest, they also explicitly provide that Cuban entities can register trademarks in the United States, 31 C.F.R. § 515.527(a)(1).

7. Cubatabaco's registered Indian Head trademark is one of the most famous cigar trademarks in the world. Internationally, the Indian Head is the trademark used in association with Cuba's legendary COHIBA brand cigars, which are widely regarded as the finest cigars in the world. Annexed hereto as Exhibit A are two examples of the trade dress bearing the Indian Head, as used by Cubatabaco and/or its assignee in conjunction with its COHIBA word mark in commerce internationally and as seen in U.S. publications. Although rights in the United States to the word mark COHIBA currently are the subject of litigation involving Cubatabaco in the United States District Court for the Southern District of New York, it is undisputed that Cubatabaco is the owner in the



United States of the various components of the registered COHIBA trade dress, including the Indian Head, in Registration No. 2,145,804. A Section 8 affidavit of excusable nonuse was accepted for this mark on October 17, 2003. Cubatabaco also has registered a very similar trade dress, including the Indian Head, in conjunction with the word mark BEHIKE, Registration No. 1,557,163. A Section 8 affidavit of excusable nonuse was accepted for that mark on January 26, 1996. Therefore, both Indian Head Marks are incontestible.

8. Cubatabaco clearly has established indisputable priority with respect to the Indian Head mark, and intends to sell and transport goods, including cigars, using its Indian Head Marks in the United States as soon as the legal prohibitions against doing so are lifted. That Cubatabaco is currently using the mark in trade in other countries, where there are no prohibitions on trade, demonstrates that it has the requisite intent to use the Indian Head mark in commerce in the United States.

9. Cubatabaco's Indian Head mark is widely recognized in the United States and around the world amongst cigar smokers, and it has received substantial coverage and publicity from national publications and newspapers. Even in the absence of any registration, Cubatabaco would have prior rights in the Indian Head mark because the mark is both well known and famous in the relevant market.

10. The mark proposed for registration by Applicant, namely, the Indian Head, is copied directly from Opposer's registered marks, is applied to the same goods as Opposer's Indian Head Marks (namely, cigars), in the same International Class 34, and so nearly resembles Opposer's Indian Head Marks as to be likely to cause confusion, or to cause mistake, or to deceive with respect to Opposer's Indian Head Marks. Applicant's

mark is deceptively similar to Opposer's Indian Head Marks so as to likely to cause confusion and lead to misunderstanding as to the origin of Applicant's goods bearing the Indian Head mark.

11. Applicant failed to disclose to the USPTO that Siboney is the commonly used name of a well-known, wealthy neighborhood on the outskirts of Havana, Cuba, where many foreign embassies are located. Siboney is also the name of a beach resort town in Santiago Province, Cuba, several miles east of Santiago de Cuba, Cuba's second largest city, and was a disembarkation point for American troops in the Spanish-American War. Nearby is the Granjita Siboney, a famous landmark associated with Cuban President Fidel Castro and the Cuban Revolution. Siboney is also the name of a town in Camaguey Province, Cuba. Because Applicant's products do not, and under the Cuban embargo cannot, come from Cuba, and have no connection or association with Cuba or any of the geographic locations in Cuba named Siboney, Applicant's SIBONEY word mark is primarily geographically deceptively misdescriptive, and should be refused registration on that ground.

12. In addition to the confusing and deceptive use of the nearly identical Indian Head in Applicant's mark, the use of the word mark "SIBONEY" -- correctly identified by Applicant as "Native Indian Tribe of Cuba, Cuban Indians," and which is also the name of several geographic locations in Cuba (a fact that Applicant failed to disclose) -- in conjunction with the distinctive bold-face, block-letter type identical to that used by Cubatabaco for its COHIBA word mark, will lead consumers to associate Applicant's mark with Cuba, Cubatabaco, and Cubatabaco's world-famous COHIBA mark, thereby

furthering likelihood of confusion between Applicant's mark and Cubatabaco's Indian Head Marks.

13. If the Applicant is granted the registration herein opposed, confusion in trade resulting in damage and injury to Opposer would be caused and would result from the similarity between Applicant's mark and Opposer's Indian Head Marks. Consumers familiar with the famous Cubatabaco Indian Head Marks would be likely to purchase Applicant's products or services mistakenly believing them to be products or services sold, sponsored or approved by Opposer or an entity affiliated, connected or associated with Opposer. Furthermore, any faults or objections found with Applicant's products or services would reflect poorly upon and injure the international reputation for quality that Opposer has established for its cigars and other products sold under its Indian Head Marks.

Wherefore, for the reasons stated herein, Opposer prays that application Serial No. 78169098 be refused registration and that this Opposition be sustained.

Dated: December 18, 2003  
New York, New York

Respectfully submitted,



David B. Goldstein  
RABINOWITZ, BOUDIN,  
STANDARD, KRINSKY &  
LIEBERMAN, P.C.  
740 Broadway, Fifth Floor  
New York, New York 10003  
Tel: (212) 254-1111

*Attorneys for Empresa Cubana del  
Tabaco, d.b.a. Cubatabaco*





# Cohiba Espléndidos



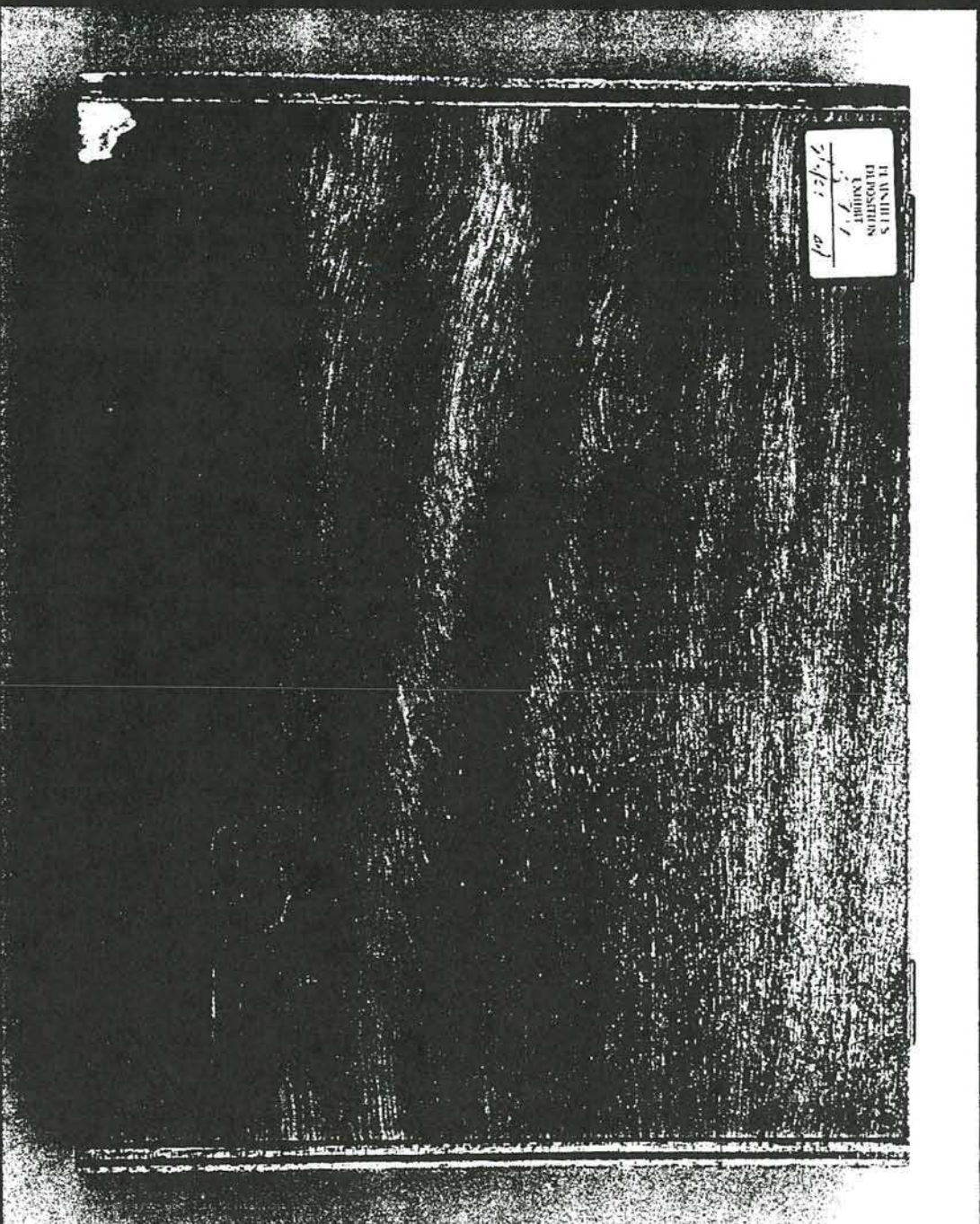
Inside Cover

La Habana, Cuba

PX927



# Cohiba Espléndidos




La Habana, Cuba

Top

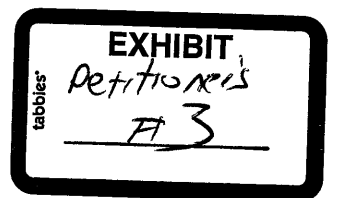
PX927

CERTIFICATE OF FILING

I hereby certify that this Notice of Opposition is being deposited today, December 18, 2003, with the United States Postal Service, utilizing the "Express Mail Post Office to Addressee" service, in an envelope addressed to: Commissioner for Trademarks, BOX TTAB FEE, 2900 Crystal Drive, Arlington, Virginia 22202-3513.

  
David B. Goldstein

# EXHIBIT 3



ESTTA Tracking number: **ESTTA25548**

Filing date: **02/09/2005**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

### Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

#### Opposer Information

<b>Name</b>	Empresa Cubana del Tabaco d.b.a. Cubatabaco		
<b>Entity</b>	Corporation	<b>Citizenship</b>	Cuba
<b>Address</b>	O'Reilly No. 104 Ciudad La Habana, CUBA		

<b>Attorney information</b>	David B. Goldstein Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C. 740 BroadwayFifth Floor New York, NY 10003-9518 UNITED STATES dgoldstein@rbskl.com Phone:(212) 254-1111
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#### Applicant Information

<b>Application No</b>	78295600	<b>Publication date</b>	01/11/2005
<b>Opposition Filing Date</b>	02/09/2005	<b>Opposition Period Ends</b>	02/10/2005
<b>Applicant</b>	Serino, Anthony P. 5105 Mallards Place Coconut Creek, FL 33073 UNITED STATES		

#### Goods/Services Affected by Opposition

Class 034. First Use: 20000101First Use In Commerce: 20000101 All goods and sevicees in the class are opposed, namely: CIGARS
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<b>Attachments</b>	Taino Opposition.pdf ( 12 pages )
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<b>Signature</b>	/David B. Goldstein/
------------------	----------------------

<b>Name</b>	David B. Goldstein
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<b>Date</b>	02/09/2005
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

	X
	X
In the Matter of Trademark Application	X
Serial No. 78295600	X
Filed: September 3, 2003	X
Published for Opposition: January 11, 2005	X
	X
Empresa Cubana del Tabaco, d.b.a. Cubatabaco,	X
Opposer,	X
	X
v.	X
	X
Anthony P. Serino, Applicant.	X
	X
	X
	X

**NOTICE OF OPPOSITION**

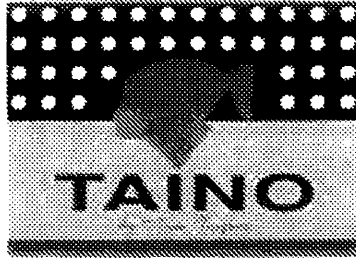
Applicant, ANTHONY P. SERINO, an individual located at 5105 Mallards Place, Coconut Creek, FL 33073, is seeking to obtain registration of the mark TAINO & Design shown in paragraph 2, *infra*, in International Class 34 for use on cigars. The application was filed on September 3, 2003, and published for opposition on January 11, 2005.

Opposer, EMPRESA CUBANA DEL TABACO, d.b.a. CUBATABACO ("Cubatabaco"), a legal entity organized under the laws of the Republic of Cuba, believes that it will be damaged by the registration that Applicant is seeking and, through its authorized attorneys, hereby opposes registration of this application.

The grounds for the opposition are as follows:

1. Applicant's application, Serial No. 78295600, was filed on September 3, 2003, in International Class 34, under § 1(a) of the Lanham Act, alleging that it had been first used in commerce on January 1, 2000 for cigars.

2. The applied-for mark consists of the silhouette of an Indian head and the word mark "TAINO" in block letters over "by Nino Vasquez" in stylized lettering, against the split backdrop of a black-and-white-checkerboard and a yellow/gold rectangle, as shown:



*Applicant's Proposed Mark*

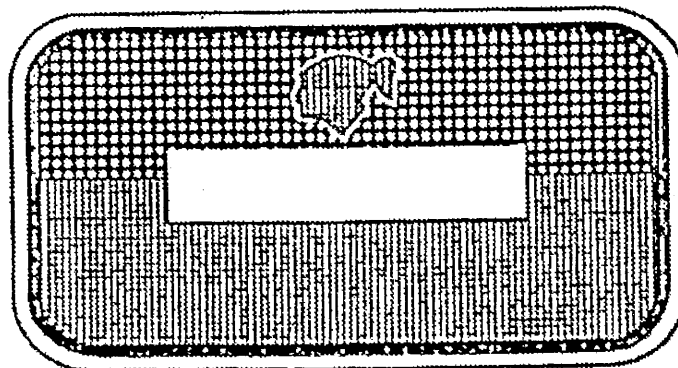
3. Opposer owns the registration for BEHIKE & Design, Registration No. 1,557,163, annexed hereto as Exhibit A, and a design mark, Registration No. 2,145,804, annexed hereto as Exhibit B, both in International Class 34 ("Opposer's Design Marks"). Opposer filed its application for BEHIKE & Design on July 29, 1988 and for its design mark on August 16, 1996. Section 8 affidavits for these marks were accepted on January 26, 1996 and on October 17, 2003, respectively. Therefore, both of Opposer's Design Marks are incontestible.

4. The graphical design and color scheme of Applicant's proposed mark is nearly indistinguishable from Opposer's Design Marks. Opposer's Design Marks feature prominently the silhouette of an Indian head, identical to that found in Applicant's proposed mark, against a split backdrop of a black-and-white-checkerboard and a yellow/gold rectangle. The black-and-white-checkerboard in the upper half of Applicant's proposed mark is a virtually identical copy of the black-and-white-

checkerboard featured in the upper portion of Opposer's Design Marks in the same class. The overall color scheme of Applicant's proposed mark, including the yellow/gold color in the bottom half, the gold Indian Head, and the black-and-white top half, is nearly identical to the color scheme and design of Opposer's Design Marks, used by Opposer and/or its assignee in commerce internationally and seen and advertised in U.S. publications, as more fully set forth in paragraph 7, *infra*.



*Registration No. 1,557,163*



*Registration No. 2,145,804*



5. Applicant's mark is a virtually identical copy of Opposer's Design Marks in the same International Class.

6. Opposer owns the registrations for numerous other Cuban cigar marks, both in Cuba and in the United States. Although the United States Treasury Department's Cuban Assets Control Regulations, 31 C.F.R. Part 515, which implement the United States' trade and financial embargo against Cuba and Cuban nationals, prohibit, *inter alia*, the importation of goods in which Cuba or any Cuban national has an interest, they also explicitly provide that Cuban entities can register trademarks in the United States, 31 C.F.R. § 515.527(a)(1).

7. The design in Cubatabaco's registered Design Marks is one of the most famous and well-known cigar trademarks in the world, including in the United States. Internationally, it is the trademark used in association with Cuba's legendary COHIBA brand cigars, which are widely regarded as among the finest cigars in the world. Annexed hereto as Exhibit C is an example of the trade dress bearing Opposer's Design Marks, as used by Cubatabaco and/or its assignee in conjunction with its COHIBA word mark in commerce internationally and as seen in numerous U.S. publications. These registered Design Marks are also featured in advertisements run in U.S. publications by Cubatabaco and/or its assignee.

8. Opposer's Design Marks were well-known and famous in the United States prior to Applicant's application or claimed first use of its mark. In 2004, the United States District Court for the Southern District of New York held that, pursuant to the well-known marks doctrine, Cubatabaco owned the COHIBA word mark in the United States since at least November 1992 as a result of the fame the mark had acquired in this

country by that point. *See Empresa Cubana del Tabaco v. Culbro Corp.*, 2004 WL 602295, at \*52 (S.D.N.Y. Mar. 26, 2004) (appeal pending in the United States Court of Appeals for the Second Circuit, No. 04-2527-cv(L)). In that decision, made after a trial, the district court also found that the COHIBA cigar band, which employs the identical checkerboard and coloring of Opposer's Design Marks, was "inherently distinctive because of its arbitrary graphical design." *Id.* at \*56. The court further found that, at least since 1997, "awareness of the COHIBA band was high" among premium cigar smokers in the United States, noting the testimony of Defendant's President, admitting that, in May 1997, "[i]t was impossible not to acknowledge . . . a strong awareness among cigar smokers that Cohiba existed . . . [and] there was great interest, among new smokers, especially, to walk around . . . *showing off the Cuban Cohiba label.*" *Id.* (emphasis added).

9. Cubatabaco has incontestible priority with respect to Opposer's registered Design Marks, and intends to sell and transport goods, including cigars, using its trademarks, including its Design Marks, in the United States as soon as the legal prohibitions against doing so are lifted.

10. Opposer's Design Marks are inherently distinctive and arbitrary and are widely recognized in the United States and around the world amongst cigar smokers. They have received substantial coverage and publicity from national publications and newspapers in the United States. Even in the absence of any registration, Cubatabaco would have prior rights in Opposer's Design Marks because the marks are both well known and famous in the relevant market.

11. This is at least the third applicant within approximately two years that has sought to exploit the fame of Opposer's registered Design Marks by copying them. The applicants on the prior two occasions -- Serial Nos. 78169098 and 76460193 -- unsuccessfully attempted to register a prominent element of Opposer's Design Marks, namely, the silhouette of the Indian Head. Cubatabaco opposed both of these applications, Opposition Nos. 91158932 and 91157163. In one instance, the applicant defaulted and the mark was abandoned. In the other, the applicant abandoned its application pursuant to a stipulation with the Opposer.

12. The design element of Applicant's mark is blatantly copied directly from Opposer's registered Design Marks, is applied to the same goods as Opposer's Design Marks (namely, cigars), in the same International Class 34, and so resembles Opposer's Design Marks as to be likely to cause confusion, or to cause mistake, or to deceive with respect to Opposer's Design Marks. Applicant's application for registration must be refused under § 2(d) of the Lanham Act.

13. Applicant failed to disclose to the USPTO that the term "TAINO" refers to a now-extinct Indian tribe that occupied the Greater Antilles, including Cuba, at the time of Christopher Columbus' arrival in North America. "COHIBA" is the Taino word for "tobacco," a fact widely promoted in connection with Cubatabaco's famous COHIBA mark. Applicant's use of the word mark "TAINO," in conjunction with the distinctive bold-face, block-letter type virtually identical to that used by Cubatabaco for its COHIBA word mark, coupled with its blatant copying of Opposer's Design Marks, will further lead consumers to associate Applicant's mark with Cuba, Cubatabaco, and Cubatabaco's

world-famous COHIBA mark, thereby enhancing the likelihood of confusion between Applicant's mark and Cubatabaco's Design Marks.

14. Applicant was aware of the existence and continuous use of Opposer's Design Marks in Cuba upon goods in the same class prior to his application for registration, or use, of its mark. Pursuant to Article 7 of the General Inter-American Convention for Trademark and Commerical Protection, of which the United States and Cuba are signatories, and Section 44 of the Lanham Act, Cubatabaco has priority to use and to register its Design Marks as against Applicant, and applicant is prohibited from obtaining registration of his mark in the United States.

15. Pursuant to Article *6bis* of the Paris Convention for the Protection of Industrial Property, of which the United States and Cuba are signatories, and § 44 of the Lanham Act, registration of Applicant's mark must be refused because it is a reproduction and/or imitation that is liable to create confusion with Cubatabaco's well-known Design Marks, used for the identical product for which Applicant seeks to register his mark.

16. Because use of Applicant's mark would cause dilution of the distinctive quality of Opposer's famous Design Marks under Section 43(c) of the Act, registration of Applicant's mark must be refused pursuant to Section 2 (last para.) of the Act.

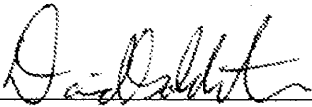
17. If the Applicant is granted the registration herein opposed, confusion and dilution in trade resulting in damage and injury to Opposer would be caused and would result from the similarity between Applicant's mark and Opposer's Design Marks. Consumers familiar with the famous Cubatabaco Design Marks would be likely to purchase Applicant's products or services mistakenly believing them to be products or services sold, sponsored or approved by Opposer or an entity affiliated, connected or associated

with Opposer. Furthermore, any faults or objections found with Applicant's products or services would reflect poorly upon, injure and dilute the international reputation for quality that Opposer has established for its cigars and other products sold under Opposer's Design Marks.

Wherefore, for the reasons stated herein, Opposer prays that application Serial No. 78295600 be refused registration and that this Opposition be sustained.

Dated: February 9, 2005  
New York, New York


Respectfully submitted,

  
David B. Goldstein  
RABINOWITZ, BOUDIN,  
STANDARD, KRINSKY &  
LIEBERMAN, P.C.  
740 Broadway, Fifth Floor  
New York, New York 10003  
Tel: (212) 254-1111

*Attorneys for Empresa Cubana del  
Tabaco, d.b.a. Cubatabaco*

CERTIFICATE OF FILING

I hereby certify that this Notice of Opposition is being filed electronically today, February 9, 2005, on the Electronic System for Trademark Trials and Appeals for the United States Patent and Trademark Office.

  
David B. Goldstein

Int. Cl.: 34

Prior U.S. Cls.: 8, 9 and 17

**United States Patent and Trademark Office**

**Reg. No. 1,557,163**

Registered Sep. 19, 1989

**TRADEMARK  
PRINCIPAL REGISTER**



EMPRESA CUBANA DEL TABACO (CUBA  
CORPORATION)  
O'REILLY 104 STREET  
HAVANA CITY, CUBA

FOR: RAW TOBACCO, CIGARS, CIGARETTES, CUT TOBACCO, RAPEE, MANUFACTURED TOBACCO OF ALL KINDS, MATCHES, TOBACCO-PIPES, PIPE HOLDERS, ASHTRAYS, MATCH BOXES, CIGAR CASES, HUMIDORS, IN CLASS 34 (U.S. CLS. 8, 9 AND 17).

OWNER OF CUBA REG. NO. 36987, DATED 12-24-1987, EXPIRES 12-24-1997.

OWNER OF U.S. REG. NO. 1,441,404.

THE DRAWING OF THE MARK IS LINED FOR THE COLORS YELLOW AND GOLD.

THE ENGLISH TRANSLATION OF THE WORD "BEHIKE" IN THE MARK IS "INDO-CUBAN WITCH DOCTOR".

SER. NO. 742,915, FILED 7-29-1988.

ALICE SUE CARRUTHERS, EXAMINING ATTORNEY

Int. Cl.: 34

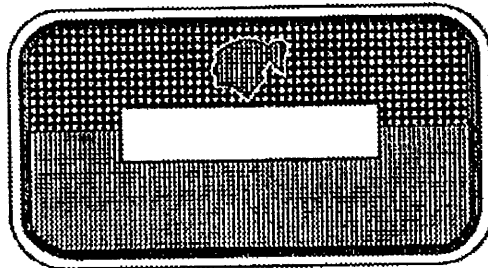
Prior U.S. Cls.: 2, 8, 9 and 17

Reg. No. 2,145,804

**United States Patent and Trademark Office**

Registered Mar. 24, 1998

**TRADEMARK  
PRINCIPAL REGISTER**



EMPRESA CUBANA DEL TABACO (CUBA CORPORATION), DBA CUBATABACO  
O'REILLY NO. 104  
CIUDAD LA HABANA, CUBA

FOR: RAW TOBACCO, CIGARS, CIGARETTES, CUT TOBACCO, RAPPEE, MATCHES, TOBACCO, TOBACCO PIPES, PIPE-HOLDERS, ASHTRAYS NOT OF PRECIOUS METAL, MATCH BOXES, CIGAR CASES NOT OF PRECIOUS METAL, AND HUMIDORS, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

OWNER OF CUBA REG. NO. 123125, DATED 2-6-1996, EXPIRES 1-10-2005.

THE MARK IS LINED FOR THE COLOR GOLD. THE BOLDLY LINED SECTION OF

THE DRAWING, HOWEVER, DOES NOT INDICATE COLOR, BUT IS A FEATURE OF THE MARK.

THE MARK CONSISTS OF A RECTANGULAR DESIGN WITH ROUNDED CORNERS, A GOLD OUTLINE, THE SILHOUETTE OF A HEAD OF AN INDIAN AGAINST A BLACK AND WHITE DOTTED BACKGROUND, A WHITE RECTANGLE, AND A GOLD RECTANGLE.

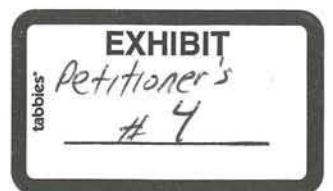
SER. NO. 75-151,226, FILED 8-16-1996.

DAVID C. REIHNER, EXAMINING ATTORNEY





# EXHIBIT 4



ESTTA Tracking number: **ESTTA859843**

Filing date: **11/21/2017**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

**Notice of Opposition**

Notice is hereby given that the following parties oppose registration of the indicated application.

**Opposers Information**

Name	Corporacion Habanos, SA
Granted to Date of previous extension	11/22/2017
Address	Centro de Negocios Miramar Edificio Habana 3er Piso Ave. 3ra esq 78 Playa, La Habana, 0 CUBA

Name	Empresa Cubana del Tabaco
Granted to Date of previous extension	11/22/2017
Address	Calle Nueva No. 75 Municipio Cerro, 0 CUBA

Attorney information	David B. Goldstein Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C. 61 Broadway, 18th Floor New York, NY 10006 UNITED STATES Email: dgoldstein@rbskl.com Phone: 212-254-1111
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**Applicant Information**

Application No	87346080	Publication date	07/25/2017
Opposition Filing Date	11/21/2017	Opposition Period Ends	11/22/2017
Applicant	Kretek International, Inc. 5449 Endeavour Court Moorpark, CA 93021 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 034. First Use: 2005/09/14 First Use In Commerce: 2005/09/14  
All goods and services in the class are opposed, namely: Cigar accessories, namely, cigar cutters, cigar lighters, cigar boxes not precious metal, ashtrays and cigar trays

**Applicant Information**

Application No	87346097	Publication date	07/25/2017
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Opposition Filing Date	11/21/2017	Opposition Period Ends	
Applicant	Kretek International, Inc. 5449 Endeavour Court Moorpark, CA 93021 UNITED STATES		


## Goods/Services Affected by Opposition

Class 034. First Use: 2005/09/14 First Use In Commerce: 2005/09/14  
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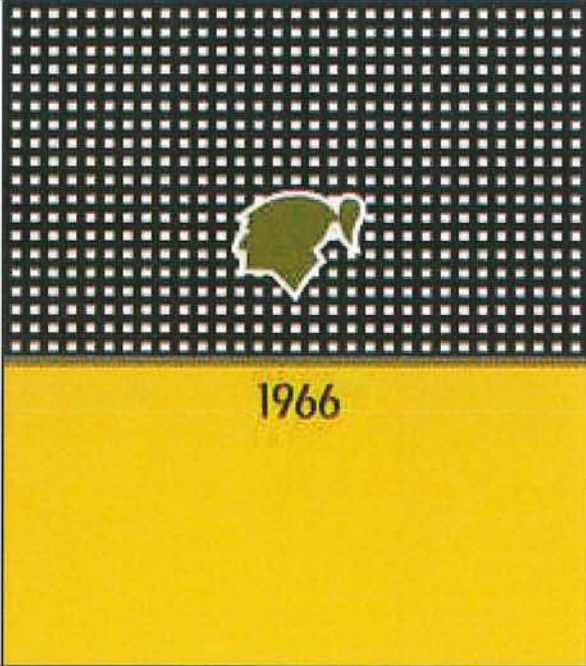
## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
The mark is primarily geographically deceptively misdescriptive	Trademark Act Section 2(e)(3)
No use of mark in commerce before application or amendment to allege use was filed	Trademark Act Sections 1(a) and (c)
Deceptiveness	Trademark Act Section 2(a)

## Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	3402158	Application Date	12/18/2006
Registration Date	03/25/2008	Foreign Priority Date	07/17/2006
Word Mark	ESPLÁNDIDOS		
Design Mark			
Description of Mark	The mark consists of a rectangular shape with curved corners, outlined in gold. The top half is black with white dots, and contains the silhouette of a head of an Indian in gold, outlined in white. The bottom half is in yellowish orange, and contains the word ESPLÉNDIDOS in black. The rectangle is divided in half with a gold line, and a white rectangle in the center of the mark. "		
Goods/Services	Class 034. First use: First Use: 0 First Use In Commerce: 0 Raw tobacco, processed tobacco for smoking, chewing or as snuff, cigarette, small cigars, fine-cut tobacco, smokers' articles, namely, ashtrays, cigar cutters, match boxes, cigar cases, and matches		

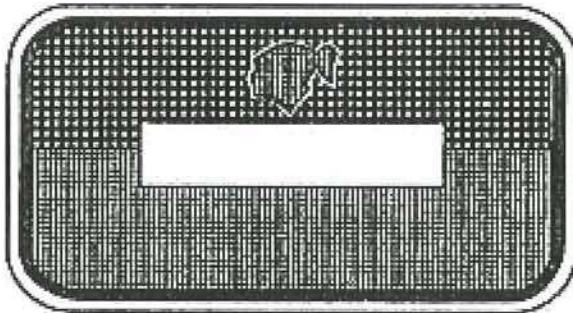


U.S. Registration No.	4244461	Application Date	09/06/2011
Registration Date	11/20/2012	Foreign Priority Date	07/07/2011
Word Mark	1966		
Design Mark			
Description of Mark	The mark consists of a rectangle the top half of which is black with white dots, and contains the silhouette of a head of an Indian in gold, outlined in white. The bottom half is in yellowish orange, and contains the number "1966" in black. The rectangle is divided in half with a gold line.		
Goods/Services	Class 034. First use: First Use: 0 First Use In Commerce: 0 Ashtrays; Cigar cases; Cigar cutters; Match boxes; Matches; Pipe tobacco; Tobacco, cigars and cigarettes		

U.S. Registration No.	1557163	Application Date	07/29/1988
Registration Date	09/19/1989	Foreign Priority Date	NONE
Word Mark	BEHIKE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 034. First use: First Use: 0 First Use In Commerce: 0 RAW TOBACCO; CIGARS, CIGARETTES, CUT TOBACCO, RAPPEE, MANUFACTURED TOBACCO OF ALL KINDS, MATCHES, TOBACCO-PIPES, PIPE HOLDERS, ASHTRAYS, MATCH BOXES, CIGAR CASES, HUMIDORS

U.S. Registration No.	2145804	Application Date	08/16/1996
Registration Date	03/24/1998	Foreign Priority Date	NONE
Word Mark	NONE		
Design Mark			
Description of Mark	The mark consists of a rectangular design with rounded corners, a gold outline, the silhouette of a head of an Indian against a black and white dotted background, a white rectangle, and a gold rectangle.		
Goods/Services	Class 034. First use: First Use: 0 First Use In Commerce: 0		

	raw tobacco, cigars, cigarettes, cut tobacco, rappee, matches, tobacco, tobacco-pipes, pipe-holders, ashtrays not of precious metal, match boxes, cigar cases not of precious metal, and humidors
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Attachments	79041168#TMSN.png( bytes ) 85415744#TMSN.png( bytes ) 73742915#TMSN.png( bytes ) 75151226#TMSN.png( bytes ) Cuban Rounds.NOA.pdf(307367 bytes )
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Signature	/David Goldstein/
Name	David B. Goldstein
Date	11/21/2017

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEALS BOARD**

In the matter of trademark applications  
Serial Nos. 87346080, 87346097  
Filed February 22, 2017  
Mark CUBAN ROUNDS  
Published in the *Official Gazette* on July 25, 2017

CORPORACION HABANOS, S.A. and EMPRESA	)	
CUBANA DEL TABACO, d.b.a. CUBATABACO,	)	
	)	
Opposers,	)	
	)	
v.	)	
	)	
KRETEK INTERNATIONAL, INC.,	)	
	)	
Applicant.	)	
	)	

Opposition No. \_\_\_\_\_

**NOTICE OF OPPOSITION**

Opposers CORPORACION HABANOS, S.A. (hereinafter "Habanos, S.A.") and EMPRESA CUBANA DEL TABACO (hereinafter "Cubatabaco") (together "Opposers") believe that they will be damaged by registration on the principal register of the marks CUBAN ROUNDS (stylized design), Serial No. 87346080, and CUBAN ROUNDS (standard characters), Serial No. 87346097, both published for opposition on July 25, 2017 (the "Applications"), and, by and through their undersigned attorneys, hereby oppose registration of said Applications, and aver as follows:

**THE PARTIES**

1. Applicant Kretek International, Inc. ("Applicant") is a corporation located and incorporated in California.
2. Opposer Habanos, S.A. is a corporation organized under the laws of Cuba, with its principal place of business in Havana, Cuba.



3. Habanos, S.A. is engaged, *inter alia*, in the trade, marketing, and advertising of Cuban cigars and related products, including cigar accessories, throughout the world, including in Cuba, and the export of Cuban cigars and related products throughout the world (with the exception of the United States due to the U.S. trade embargo).

4. Habanos, S.A. emphasizes that its cigars are made in Cuba from 100% Cuban-grown tobacco in its promotion, marketing and advertising, including in the U.S.

5. Opposer Cubatabaco is a state corporation with independent juridical personality and independent property established by Law No. 1191, dated April 25, 1966, of the Republic of Cuba, with its principal place of business in Havana, Cuba.

6. One of the world's most famous and iconic cigar marks is the design mark used by Opposers in connection with the world-famous COHIBA mark ("Design Mark"), owned, controlled and sold by Opposers throughout the world for decades, except in the United States, and used in advertising and other promotions and in print and on-line media in the United States.<sup>1</sup> Examples of the Design Mark include the following packaging and bands:



7. Cubatabaco has owned registrations in the United States for the Design Mark for several decades. These registrations include the following:

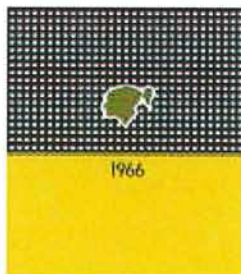
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<sup>1</sup> Rights to register the COHIBA word mark in IC 34 in the USPTO is the subject of a pending cancellation proceeding, *Empresa Cubana del Tabaco v. General Cigar Co., Inc.*, Canc. No. 92025859 (TTAB). Nothing in that cancellation proceeding concerns the design that Opposers use in connection with the COHIBA mark, and nothing in the instant proceeding concerns rights in the COHIBA word mark.

8. Cubatabaco currently owns in the United States the federal registration for the mark ESPLENDIDOS (stylized/design), U.S. Reg. No. 3402158, in International Class (“IC”) 34 for “Raw tobacco, processed tobacco for smoking, chewing or as snuff, cigarette, small cigars, fine-cut tobacco, smokers' articles, namely, ashtrays, cigar cutters, match boxes, cigar cases, and matches,” filed December 18, 2006, and registered on March 25, 2008, and with a priority date of July 17, 2006, pursuant to section 66A of the Act, 15 U.S.C. § 1141A. The mark appears as follows:

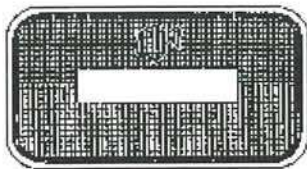


9. Cubatabaco currently owns in the United States the federal registration for the mark 1966 (stylized/design), U.S. Reg. No. 4244461, in IC 34 for “Ashtrays; Cigar cases; Cigar cutters; Match boxes; Matches; Pipe tobacco; Tobacco, cigars and cigarettes,” filed September 6, 2011, and registered on November 20, 2012, with a priority date pursuant to section 44(d) of the Act, 15 U.S.C. § 1126(d), of July 7, 2011. The mark appears as follows:



10. Cubatabaco currently owns in the United States, among others, the federal registration for the Design only mark, U.S. Reg. No. 2145804, in IC 34 for “raw tobacco, cigars, cigarettes, cut tobacco, rappee, matches, tobacco, tobacco pipes, pipe-holders, ashtrays not of

precious metal, match boxes, cigar cases not of precious metal, and humidors,” filed August 16, 1996, and registered on March 24, 1998. The mark is described as: “The mark consists of a rectangular design with rounded corners, a gold outline, the silhouette of a head of an Indian against a black and white dotted background, a white rectangle, and a gold rectangle. The mark is lined for the color gold. The boldly lined section of the drawing, however, does not indicate color, but is a feature of the mark.” The mark appears as follows:



11. Cubatabaco currently owns in the United States, among others, the federal registration for the mark BEHIKE (stylized/design), U.S. Reg. No. 1557163, in IC 34 for “raw tobacco; cigars, cigarettes, cut tobacco, rappee, manufactured tobacco of all kinds, matches, tobacco-pipes, pipe holders, ashtrays, match boxes, cigar cases, humidors,” filed July 29, 1988, and registered on September 19, 1989. The mark appears as:



12. The Board has held in proceedings brought by Opposers that both cigar marks and cigar accessory marks referring to Cuba, or known locations in Cuba are primarily geographically deceptively misdescriptive under section 2(e)(3) of the Act, 15 U.S.C. § 1052(e)(3), including under the related goods doctrine. *See, e.g., Corporacion Habanos, S.A. v.*



*Xikar, Inc.*, Opp. No. 91186534, 2012 WL 5902079 (TTAB Nov. 13, 2012) (non-precedential) (mark HAVANA COLLECTION for cigar accessories, specifically “cigar cutters; non-electric cigar lighters not of precious metal; humidors; and cigar carrying cases not of precious metal” unregistrable under section 2(e)(3), pursuant to the related goods doctrine); *In re Jonathan Drew, Inc.*, 97 USPQ2d 1640 (TTAB 2011) (refusing registration of the mark KUBA KUBA for “cigars, tobacco, and related products, namely, cigarettes, cigar boxes, lighters, holders, ashtrays, cigar bands, cigar cutters, humidors, and cigar tubes” under section 2(e)(3)); *In re Santa Cruz Tobacco Co., Inc.*, Serial No. 77129912, 2015 WL 6746542 (TTAB Oct. 13, 2015) (refusing registration of GRAN HABANO for cigars under section 2(e)(3); finding “the primary significance of the mark is ..., of a geographic location,” namely Havana, Cuba) (nonprecedential), *app. dismissed*, No. 16-1454 (Fed. Cir. Jan. 29, 2016); *Corporacion Habanos, S.A. v. Annas, Inc.*, 88 U.S.P.Q.2d 1785 (TTAB 2008) (refusing registration of the mark HAVANA CLUB for cigars under section 2(e)(3)); *Corporacion Habanos, S.A. v. Guantanamera Cigar Co.*, 86 USPQ2d 1473 (TTAB 2008), *aff’d in part, remanded in part*, *Guantanamera Cigar Co. v. Corporacion Habanos, S.A.*, 729 F.Supp.2d 246 (D.D.C. 2010), *opp. sustained*, 102 USPQ2d 1085 (TTAB 2012) (refusing registration of mark GUANTANAMERA for cigars under section 2(e)(3), as referring to Guantanamo, Cuba).

13. Opposers are authorized by 31 C.F.R. § 515.527, and the Ruling of the Office of Foreign Assets Control, dated August 19, 1996, annexed hereto as an Addendum, to commence and to prosecute this Opposition proceeding to protect their interests by opposing the registration of Applicant’s CUBAN ROUNDS marks in the USPTO.

#### **THE APPLICATION PROCEEDINGS**

14. On February 22, 2017, Applicant filed an application in the USPTO pursuant to

section 1(a) of the Act, 15 U.S.C. § 1051(a), to register the mark CUBAN ROUNDS (standard characters) in IC 34 for “Cigar accessories, namely, cigar cutters, cigar lighters, cigar boxes not precious metal, ashtrays and cigar trays” (“Cigar accessories”), which was assigned Serial No. 87346097.

15. By Office Action dated March 9, 2017, the Examiner required disclaimer of “rounds,” but did not require a disclaimer of “Cuban.” On June 14, 2017, Applicant agreed to disclaim “rounds.”

16. Also on February 22, 2017, Applicant filed an application in the USPTO pursuant to section 1(a) of the Act, 15 U.S.C. § 1051(a), to register the mark CUBAN ROUNDS (stylized/design) in IC 34 for “Cigars” and for the identical Cigar accessories as in Serial No. 87346097: “Cigar accessories, namely, cigar cutters, cigar lighters, cigar boxes not precious metal, ashtrays and cigar trays,” which was assigned Serial No. 87346080 (“Design Application”). The applied-for mark appears as follows:



17. The specimens that Applicant submitted with both Applications appears as:



18. By Office Action dated March 9, 2017, the PTO issued an initial refusal of the Design Application on the ground that the mark for “cigars” was “geographically deceptive and geographically misdescriptive” under section 2(a), (e)(3) of the Act, 15 U.S.C. § 1052(a), (e)(3), which included findings, based on citations to extensive evidence, that “‘Cuba’ is a known geographical area”; and “Cuba is Famous for its Cigars & Tobacco.”

19. The Examiner stated that the refusal “does not bar registration for the other goods,” *i.e.*, “Cigar accessories, namely, cigar cutters, cigar lighters, cigar boxes not precious metal, ashtrays and cigar trays,” without addressing whether the additional identified goods in IC 34 were “geographically deceptive and primarily geographically deceptively misdescriptive” under sections 2(a), (e)(3) of the Act, and without addressing the Board’s above-cited decisions, including the Board’s reliance on the related goods doctrine to refuse registration of the mark HAVANA COLLECTION for cigar accessories under section 2(e)(3).

20. The Examiner also issued a refusal on the ground of “No Lawful Use in Commerce – Cuban Cigars – Based on Identification,” “because applicant does not have lawful use for the applied-for mark in commerce with regard to cigars from Cuba.” Again, the Examiner stated that the refusal does not bar registration for the other goods,” *i.e.*, the Cigar accessories.

21. Again, the Examiner required a disclaimer of “rounds” but did not require a disclaimer of “Cuban.”

22. On June 14, 2017, Applicant deleted “Cigars” from the identified goods and disclaimed “rounds.”

23. The Applications were published for opposition on July 25, 2017. On August 18, 2017, Opposers filed timely requests for 90-day extensions of time, to November 22, 2017, to oppose the Applications, which the PTO granted.



24. The Examiner never analyzed the Cigar accessories goods under the related goods doctrine, and never addressed the Board's HAVANA COLLECTION decision finding that cigar accessories for that mark were unregistrable under section 2(e)(3) under the related goods test.

25. Applicant's marks are, *inter alia*, primarily geographically deceptively misdescriptive and geographically deceptive; the Design Application is confusingly similar to Cubatabaco's above-identified registered trademarks; and void as to each of those identified Cigar accessories for which the marks were not in use at the time the Applications were filed.

**THE MEANING OF "CUBAN" AND THE ASSOCIATION OF CIGARS AND TOBACCO WITH CUBA**

26. The word "Cuban" primarily refers to the country of Cuba, and is the adjectival form of "Cuba," referring to someone or something of, from or related to the country of Cuba.

27. Cuba, the largest nation in the Caribbean, is a known geographical location.

28. The primary significance of the applied-for marks, CUBAN ROUNDS, is a generally known geographic location – Cuba.

29. The addition of the common word "rounds," which, as the Examiner found and without dispute by Applicant, refers to a type of cigar, does not alter the mark's primary geographic significance.

30. In addition to its primary meaning as of, from, or related to the country of Cuba, the word "Cuban" is used, recognized, and understood throughout the world, including in the United States, by both cigar consumers and within the cigar industry, and by common parlance, to denote Cuba's most famous export – cigars that are of 100% Cuban origin, made exclusively from tobacco grown in Cuba and manufactured in Cuba.

31. For decades prior to Applicant's February 22, 2017 Applications, the term "Cuban" has been used to mean a cigar from Cuba, that is, a 100% Cuban-origin cigar.

32. Cigar accessories, including at least some of the goods identified in the Applications, are produced in Cuba, and are known to be produced there by consumers in the United States.

33. It is common for manufacturers or distributors of cigars and other tobacco products in the United States and elsewhere also to produce, to sell, and/or to distribute cigar accessories, including using the same marks as their cigar and tobacco marks, in connection with the sale and promotion of their tobacco products, and to market their cigar accessories as related to their tobacco products.

34. For example, in its Design Application, Applicant declared under oath that it was using in commerce both cigars and cigar accessories under the same CUBAN ROUNDS mark.

35. Applicant's goods, identified by Applicant as "Cigar accessories," have no purpose or function other than for use with cigars (cigar cutters, cigar lighters, cigar boxes not precious metal, and cigar trays) or with cigars and other tobacco products (ashtrays).

36. Cigar and tobacco consumers are also consumers of cigar accessories, and commonly associate cigars and tobacco products with cigar and tobacco accessories, including as to the source and location of the cigar products and accessories.

37. Cigars and cigar accessories are closely related and complementary goods.

38. Cuba is famous for its cigars and cigar tobacco, and is internationally recognized, including in the United States, as the most renowned country in the world for the growth of tobacco for cigars, and for the production and manufacture of cigars, including cigars of the highest quality.

39. Consumers in the United States and elsewhere in the world strongly associate cigars and high-quality cigar tobacco with Cuba.



40. Because of the powerful goods/place association between cigars, tobacco and Cuba, and the common consumer association of cigars and tobacco with cigar accessories, consumers are likely to believe that Applicant's goods come from Cuba, when they do not.

41. Applicant has no reason to select a mark using the term "CUBAN" for cigar-related accessories not from Cuba, other than to seek to capitalize on the powerful consumer association of cigars with Cuba.

42. Applicant's CUBAN ROUNDS marks denote, are, and will be understood by United States consumers as denoting, that the cigar accessories bearing the mark CUBAN ROUNDS are manufactured or have their origin in Cuba.

43. Applicant's goods do not come from, or otherwise originate in Cuba.

44. Applicant's marks are not used, nor can they be used, in connection with the distribution of Cuban-origin cigars, tobacco products, or related cigar accessories.

45. Applicant, a United States corporation, has no lawful means of obtaining cigars or cigar accessories from Cuba for sale in the United States, or selling cigars or cigar accessories that are made anywhere in the world if they are made or derived in whole or in part of any article which is the growth, produce or manufacture of Cuba. Without limitation, the United States' Cuban Assets Control Regulations, including specifically 31 C.F.R. § 515.201, 515.204, prohibit such activity.

46. The cigar-consuming public is likely to believe that the place identified by Applicant's marks – Cuba – describes Applicant's goods, and their geographic origin, when the goods in fact do not come from Cuba.

47. Consumers' mistaken belief that Applicant's goods come from Cuba would be a material factor for a substantial proportion of consumers in their purchasing decision.

48. Applicant, which did not disclaim “CUBAN,” has no exclusive right to use that term in connection with the sale of cigar accessories, particularly as Applicant’s goods do not originate in, and have no connection or association with, Cuba.

### **INJURY TO OPPOSERS**

49. Opposers believe that they will be damaged by registration of the CUBAN ROUNDS marks upon the Principal Register, including by Applicant’s use of those marks on cigar accessories of non-Cuban origin. Such registration and use will deceive consumers into believing that Cuban-origin cigar-related products are presently available for purchase in the U.S.

50. Applicant’s Design Application, when used on or in connection with Applicant’s cigar accessories, so resembles Cubatabaco’s above-identified Design Marks for the same, similar, and related goods as to be likely to cause confusion, or to cause mistake, or to deceive.

51. Opposers’ ability and success in marketing 100% Cuban-origin cigars, other tobacco products, and related cigar accessories to U.S. consumers as soon as U.S. law permits, including through the above-cited registered Design Marks, will be damaged and diminished if Applicant is permitted to register marks that include the term “Cuban” for cigar-and tobacco-related accessories, which deceptively suggests that Applicant’s goods are of Cuban origin.

### **FIRST GROUND FOR OPPOSITION**

52. Opposers repeat and reallege each and every allegation set forth in paragraphs 1 through 51 of this Notice of Opposition as if fully set forth herein.

53. Applicant’s marks, as used on or in connection with Applicant’s identified goods, are geographically deceptive and primarily geographically deceptively misdescriptive within the meaning of section 2(a), (e)(3) of the Lanham Act, 15 U.S.C. § 1052(a), (e)(3), for lack of the requisite nexus with Cuba, and, therefore, registration of the marks should be refused.

### **SECOND GROUND FOR OPPOSITION**

54. Opposers repeat and reallege each and every allegation set forth in paragraphs 1 through 51 of this Notice of Opposition as if fully set forth herein.

55. Applicant's CUBAN ROUNDS Design Application, Serial No. 87346080, so resembles Cubatabaco's registered Design Marks for the same, similar, and related goods as to be likely, when used on or in connection with Applicant's goods, to cause confusion, or to cause mistake, or to deceive, within the meaning of section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), and, therefore, registration of Serial No. 87346080 should be refused.

### **THIRD GROUND FOR OPPOSITION**

56. Opposers repeat and reallege each and every allegation set forth in paragraphs 1 through 51 of this Notice of Opposition as if fully set forth herein.

57. Upon information and belief, Applicant was not using in commerce the CUBAN ROUNDS marks on or in connection with the identified goods – "Cigar Accessories, namely cigar cutters, cigar lighters; cigar boxes not of precious metal, ashtrays and cigar trays" – when it filed its Applications on February 22, 2017.

58. Upon information and belief, Applicant was not using in commerce the CUBAN ROUNDS marks on or in connection with each of the identified goods when it filed its Applications.

59. Upon information and belief, the specimens submitted by Applicant for the Applications are not actual specimens of the marks as used in commerce on the identified goods. The specimens consist of an image of a cigar lighter, but the specimens, as show in paragraph 17, *supra*, identify the goods as "Premium Handmade Cigars," and further state, "Hand made in the Havana tradition/Taste of Havana."



60. The CUBAN ROUNDS marks were and are void *ab initio* as to each of those identified goods that were not in use in commerce under the marks at the time the Applications were filed and, therefore, registration of the marks should be refused for each of said goods.

61. The CUBAN ROUNDS Applications are and were void *ab initio* in their entirety to the extent that the marks were not in use in commerce on any of the identified goods at the time the Applications were filed and, therefore, registration of the marks should be refused.

WHEREFORE, Opposers Corporacion Habanos, S.A. and Empresa Cubana del Tabaco pray that registration of the marks in Application Serial Nos. 87346080 and 87346097 be refused, and that this Opposition be sustained in favor of the Opposers.

Dated: November 21, 2017

Respectfully submitted,

By: /David Goldstein/  
DAVID B. GOLDSTEIN  
RABINOWITZ, BOUDIN, STANDARD,  
KRINSKY & LIEBERMAN, P.C.  
61 Broadway – 18<sup>th</sup> Floor  
New York, New York 10006-2708  
212-254-1111  
[dgoldstein@rbskl.com](mailto:dgoldstein@rbskl.com)

*Attorneys for Opposers Corporacion Habanos, S.A.  
and Empresa Cubana del Tabaco*

#### **CERTIFICATE OF ELECTRONIC FILING**

I hereby certify that this Notice of Opposition to Application Serial Nos. 87346080 and 87346097 is being filed electronically today, November 21, 2017, through the ESTTA database, and that service upon the Applicant shall be effected pursuant to Trademark Rule 2.105.

/David Goldstein/  
David B. Goldstein

## **ADDENDUM**

DEPARTMENT OF THE TREASURY  
WASHINGTON, D.C. 20220

AUG 19 1996

FAC Nos. C-152409, C-152468

Dear Mr. Krinsky:

This is in response to your letters of July 3 and July 22, 1996, addressed to Serena Mos, Deputy Chief Counsel of the Office of Foreign Assets Control. In your letters you ask two questions concerning the authorization contained in § 515.527 of the Cuban Assets Control Regulations, 31 C.F.R. Part 515 (the "Regulations"). First, you ask whether this section authorizes Cuba to file an opposition to the registration of a new trademark on the grounds that the new trademark interferes with Cuba's right in its registered trademark based on likely consumer confusion. Second, you ask whether Cuba may bring a petition to cancel the prior registration of a trademark related to its efforts to register a trademark.

The authorization contained in § 515.527 and the parallel provisions of § 515.528 are intended to provide reciprocal protection for the intellectual property of Cuba and the United States. Both of the processes you describe in your correspondence concern available legal means to protect trademarks in the United States. For this reason, the authorization contained in § 515.527 may be relied on to file an opposition to the registration of a new trademark or to petition to cancel a prior registration of a trademark where these actions relate to the protection of a trademark in which Cuba or a Cuban national general licensee has an interest.

If you have any further questions concerning this matter, please call me (202/622-2510) or Ms. Mos (202/622-2410).

Sincerely,

R. Richard Newcomb  
Director  
Office of Foreign Assets Control

Michael Krinsky, Esq.  
Rabinowitz, Boudin, Standard, Krinsky & Lieberman, P.C.  
740 Broadway at Astor Place  
New York, New York 10003-9518

# EXHIBIT 5



ELF case

UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

EMPRESA CUBANA DEL TABACO,  
d/b/a CUBATABACO,

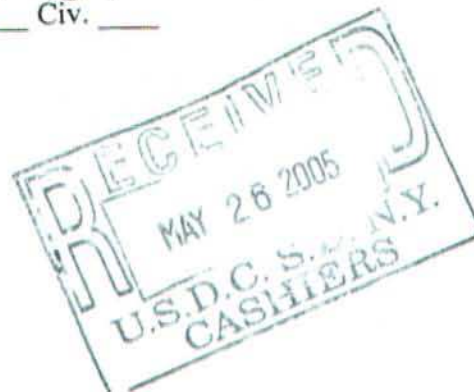
Plaintiff,

- against -

SANTA CLARA CIGAR  
MANUFACTURER, INC.,  
a/k/a/ STC CIGAR MANUFACTURERS,  
INC.,

Defendant.

COMPLAINT  
05 CV 5041  
Civ.



Plaintiff Empresa Cubana del Tabaco d/b/a/ Cubatabaco (hereinafter "Cubatabaco")  
alleges for its complaint against defendant Santa Clara Cigar Manufacturer, Inc., a/k/a Stc Cigar  
Manufacturers, Inc., as follows:

**Nature of the Action**

1. This is an action seeking declaratory and equitable, including injunctive, relief for,  
*inter alia*, defendant's acts of trademark infringement of two of plaintiff's registered design  
trademarks. Defendant's infringing conduct has been willful, deliberate, and in bad faith.

**Jurisdiction and Venue**

2. This Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a),  
and 15 U.S.C. § 1121(a) for claims arising out of alleged violations of 15 U.S.C. §§ 1114,  
1125(a) and 1126; under 28 U.S.C. §§ 1331 and 1338(a), for claims arising under the Paris  
Convention for the Protection of Industrial Property ("Paris Convention"), 21 UST 1583; 24



UST 2140, and under the General Inter-American Convention for Trade Mark and Commercial Protection (“Inter-American Convention”), 46 Stat. 2907; and under 28 U.S.C. §§ 1338(b) and 1367 for claims arising under state law. Jurisdiction over all claims also arises under 28 U.S.C. § 1332(a)(4), as plaintiff is a “foreign state” as defined in 28 U.S.C. § 1603(a), in that it is an “agency or instrumentality” of a foreign state within the meaning of 28 U.S.C. § 1603, and defendant is a citizen of the State of Florida.

3. This Court has personal jurisdiction over defendants.
4. Venue is proper in this district under 28 U.S.C. § 1391(b)(2),(c).

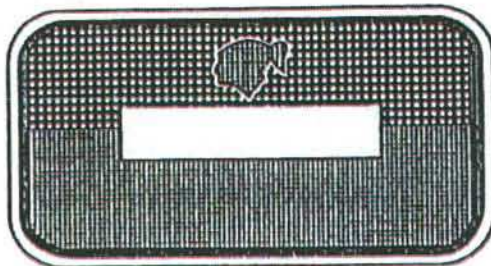
#### **The Parties**

5. Cubatabaco is a company with legal personality organized under the laws of Cuba. Cubatabaco has its principal place of business in Havana, Cuba. Defendant Santa Clara Cigar Manufacturer, Inc., a/k/a Stc Cigar Manufacturers, Inc. (hereinafter “STC”), is a Florida corporation with its principal place of business at 8553 N.W. 68 Street, Miami, Florida 33166, having been incorporated on March 9, 1998.

#### **Cubatabaco’s Registered Design Marks**

6. Plaintiff Cubatabaco owns the trademark registrations in the United States for a design mark, Registration No. 2,145,804, and for BEHIKE & DESIGN, Registration No. 1,557,163, set forth herein as Figures A and B, below, respectively (hereinafter collectively referred to as the “Design Mark” or “Cubatabaco’s Design Marks”). Both registrations are in International Class 34 (tobacco products, including cigars and related accessories). Cubatabaco filed its application with the United States Patent and Trademark Office (“USPTO”) for the design mark Registration No. 2,145,804 on August 16, 1996, and the registration issued on March 24, 1998 (annexed hereto as Exhibit A and incorporated herein by reference). Cubatabaco

filed its application with the USPTO for BEHIKE & DESIGN on July 29, 1988, and the registration issued on September 19, 1989 (annexed hereto as Exhibit B and incorporated herein by reference). The USPTO accepted Section 8 declarations for these marks on October 17, 2003 and January 26, 1996, respectively. Both registrations are in full force and effect.



**Figure A, Registration No. 2,145,804**



**Figure B, Registration No. 1,557,163**



7. Cubatabaco's Design Marks feature a split backdrop of a black-and-white checkerboard in the upper half and a yellow/gold rectangle on the lower half. Since at least the late 1980's, Cubatabaco has used this registered design on cigar bands placed on COHIBA-branded Cuban cigars, widely regarded in the United States and internationally as the finest or among the finest cigars in the world, and on other packaging in connection with the use, promotion and marketing of COHIBA-branded cigars and related products. An example of the cigar band used in connection with COHIBA-branded cigars is shown in Figures C and D in paragraph 13, below.

8. Cubatabaco's registered Design Marks, including as they are used on COHIBA-branded cigar bands, are well-known among consumers of cigars in the United States and internationally. Particularly as used on the COHIBA cigar band, the Design Marks are ubiquitous in the leading United States cigar magazines, *Cigar Aficionado* and *Smoke*, including in advertisements, articles and on magazine covers, and on United States cigar-related websites, including on *Cigar Aficionado*'s home page. For example, the COHIBA cigar band appears on the cover of the February 2005 issue of *Cigar Aficionado*, and the Spring 2005 issue of *Smoke* includes a photograph of the cigar band in an article reporting on "20 Great Cigar Bands," which lists the COHIBA band third, and describes it thus: "COHIBA: Big blocky logo on simple, black-white-yellow, straight-sided band. A groundbreaking visual, iconic mainly because of the mystique of the cigar inside it." Annexed hereto as Exhibit C and incorporated by reference are examples of images of the Design Mark, including on the COHIBA-labeled cigar band, from *Cigar Aficionado* and *Smoke* magazines.

9. Although Cubatabaco cannot sell its COHIBA-branded cigars, with the registered Design Marks, in the United States because of the Cuban Assets Control Regulations ("CACR"),

31 C.F. R. Part 515, visitors to Cuba from the United States could, until June 2004 when the CACR were amended, lawfully import up to \$100 worth of cigars for their own use or for gifts. Under this authority, United States visitors imported COHIBA cigars with the registered Design Marks from before the time of defendants' first use.

10. Cubatabaco intends to use its Design Marks in connection with its sale, promotion and advertising of cigars in the United States as soon as it is permitted to do so by United States law.

11. Cubatabaco's registered Design Marks, including as used on COHIBA-labeled cigar bands, had become well-known among cigar consumers in the United States before defendant's first use of its infringing design. Prior to defendant's first use, the Design Mark had acquired substantial commercial value and goodwill as identifying COHIBA cigars.

12. Prior to defendant's first use of its infringing design, Cubatabaco had registered, and used, its Design Marks in Cuba. Cubatabaco has continuously used its Design Marks in Cuba since before defendant's first use of its infringing design.

#### **Defendant's Activities**

13. STC sells cigars in the United States, including within the State of New York and this judicial district, with a band that bears the word "HABANO" and a graphical design and color scheme that is a virtually indistinguishable copy of Cubatabaco's Design Mark as used on cigar bands in connection with COHIBA-branded cigars. Figures C and D show, respectively, front and back images of the registered Cubatabaco Design Mark as used on COHIBA-labeled cigar bands, and the virtually identical STC cigar band as used on STC's HABANO-labeled cigar bands, placed on STC's cigar products.



**Figure C**

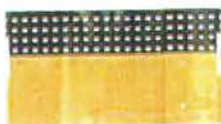


**Front of Cubatabaco' Registered Design Marks As Used On COHIBA cigar band**

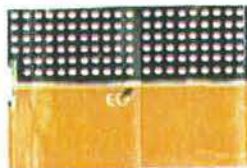


**Front of STC's Habano Cigar Band**

**Figure D**



**Back of Cubatabaco' Registered Design Marks As Used On COHIBA cigar band**



**Back of STC's Habano Cigar Band**

14. STC does not own an application for registration or a registration for its infringing design.

15. The word HABANO, used in connection with cigars, means a cigar made in Cuba from Cuban tobacco. STC's HABANO labeled cigars are not manufactured in Cuba or made from Cuban tobacco.

16. The conduct of defendant in using its infringing design in connection with cigar products has been willful, deliberate, and in bad faith. Defendant adopted and uses its design in

a deliberate attempt to exploit and to capitalize on the renown and goodwill of the Cuban COHIBA cigar, and Cubatabaco's Design Marks.

17. Prior to its adoption and use of its infringing design, defendant had actual and/or constructive notice of plaintiff Cubatabaco's Design Mark registrations in the United States. In addition, defendant had actual notice and knowledge of plaintiff's Design Mark, and actual notice and knowledge that plaintiff's Design Mark was well-known among United States cigar consumers.

18. Defendant's use in commerce of its reproduction, counterfeit, copy and/or colorable imitation of plaintiff's registered Design Marks in connection with defendant's sale, offering for sale, distribution or advertising of its cigar products is likely to cause confusion and/or mistake, and/or to deceive United States cigar consumers.

19. Defendant's use in commerce of the infringing design in connection with the sale or promotion of its cigar products creates a likelihood of confusion, mistake and/or deception among United States consumers of cigars in that consumers are likely to believe that defendant's cigars originate from, or are sponsored or approved by, the plaintiff or that defendant is affiliated with, or connected to or associated with, the plaintiff.

20. United States consumers of cigars are motivated to purchase cigars sold with, or in connection with, defendant's infringing design by their mistaken belief that the design means that such cigars originate from, or are sponsored or approved by, the plaintiff, or that defendant is affiliated with, or connected to or associated with, plaintiff.

21. Prior to defendant's first use of its infringing design in connection with cigars, it had knowledge of the existence and continuous use in Cuba of Cubatabaco's Design Marks upon goods of the same class.

22. Defendant's use of its design misappropriates and unfairly trades upon the valuable goodwill and reputation of Cubatabaco and of the valuable goodwill and reputation of Cuban COHIBA cigars and the Design Mark, and will subject that goodwill and reputation to the hazards and perils attendant upon defendant's business activities, over which Cubatabaco has no control.

23. Unless enjoined, defendant will continue to infringe upon, and misappropriate and unfairly trade upon, the aforesaid rights, goodwill, and reputation, and its conduct will irreparably injure plaintiff.

24. Cubatabaco reasonably believes that it is or is likely to be damaged by defendant's conduct.

**FIRST CLAIM FOR RELIEF**  
**15 U.S.C. § 1114**  
**(Infringement of Federally Registered Trademark)**

25. Plaintiff hereby incorporates by reference paragraphs 1 through 24 of this Complaint as if fully set forth herein.

26. Defendant's above alleged acts have infringed and, unless enjoined will continue to infringe, upon plaintiff's federally registered Design Marks in violation of 15 U.S.C. § 1114.

27. Plaintiff will be irreparably harmed as a result of such violations, for which there is no adequate remedy at law. Plaintiff is entitled to injunctive relief against defendant's continued use of its design in connection with cigars.

28. Pursuant to 15 U.S.C. § 1117(a), plaintiff is entitled to defendant's profits from the sale of cigars bearing defendant's infringing design, or marketed, advertised and promoted through use of that infringing design, and is entitled to the costs of this action, including its attorneys' fees.



**SECOND CLAIM FOR RELIEF**  
**15 U.S.C. § 1125(a)**  
**(Trademark Infringement, Unfair Competition, Well-Known Marks)**

29. Plaintiff hereby incorporates by reference paragraphs 1 through 24 of this Complaint as if fully set forth herein.

30. Defendant is liable to plaintiff under 15 U.S.C. § 1125(a).

31. Plaintiff will be irreparably harmed as a result of defendant's violations of 15 U.S.C. § 1125(a), for which there is no adequate remedy at law. Plaintiff is entitled to injunctive relief against defendant's continued use of its design in connection with cigars.

32. Pursuant to 15 U.S.C. § 1117(a), plaintiff is entitled to defendant's profits from the sale of cigars bearing defendant's infringing design, or marketed, advertised and promoted through use of that infringing design, and is entitled to the costs of this action, including its attorneys' fees.

**THIRD CLAIM FOR RELIEF**  
**Article 6bis, Paris Convention and 15 U.S.C. § 1126**  
**(Well-Known Marks)**

33. Plaintiff hereby incorporates by reference paragraphs 1 through 24 of this Complaint as if fully set forth herein.

34. At all relevant times, the United States and Cuba have been parties to the Paris Convention, 21 U.S.T. 1629.

35. Article 6bis of the Paris Convention prohibits the use in a Contracting State of a trademark which constitutes a reproduction, an imitation, or a translation, liable to create confusion, of a mark that is well known in that country as being already the mark of a person entitled to the benefits of the Paris Convention and used for identical or similar goods.



36. Article 6*bis* of the Paris Convention is a self-executing treaty provision and, as such, is enforceable in the United States. Additionally, Article 6*bis* is incorporated by, and enforceable under, Section 44 of the Lanham Act, 15 U.S.C. § 1126.

37. Defendants' conduct is in violation of Article 6*bis* and Section 44 of the Lanham Act.

38. Plaintiff will be irreparably harmed as a result of defendant's violations of Article 6*bis* of the Paris Convention and Section 44 of the Lanham Act, for which there is no adequate remedy at law.

39. Pursuant to Article 6*bis* of the Paris Convention, and Section 44 of the Lanham Act, plaintiff is entitled to an injunction against defendant's continued use of its design in connection with cigars.

40. Plaintiff is entitled to defendant's profits from the sale of cigars bearing defendant's infringing design, or marketed, advertised and promoted through use of that infringing design, and is entitled to the costs of this action, including its attorneys' fees.

**FOURTH CLAIM FOR RELIEF**  
**Article 7 of the General Inter-American Convention**  
**(Knowledge of Prior Use or Registration in Treaty Country)**

41. Plaintiff hereby incorporates by reference paragraphs 1 through 24 of this Complaint as if fully set forth herein.

42. At all relevant times, the United States and Cuba have been parties to the General Inter-American Convention, 46 Stat. 2907. Article 7 thereof entitles the owner of a mark protected in Cuba to an injunction against another's use of an interfering mark in the United States upon proof that the person who is using the mark had prior knowledge of the existence and continuous use in Cuba of the mark upon goods of the same class.

43. Article 7 of the General Inter-American Convention is a self-executing treaty provision and is enforceable as such. In addition, Article 7 is incorporated by and enforceable under Section 44 of the Lanham Act, 15 U.S.C. § 1126.

44. Plaintiff will be irreparably harmed as a result of defendant's conduct, for which there is no adequate remedy at law.

45. Pursuant to Article 7 of the General Inter-American Convention and Section 44 of the Lanham Act, plaintiff is entitled to an injunction against defendant's use of its design in connection with cigars.

46. Plaintiff is entitled to defendant's profits from the sale of cigars bearing defendant's infringing design, or marketed, advertised and promoted through use of that infringing design, and is entitled to the costs of this action, including its attorneys' fees.

**FIFTH CLAIM FOR RELIEF**  
**N.Y. Gen. Bus. Law § 349 and Common Law**  
**(Unlawful and Deceptive Business Acts or Practices; Unfair Competition)**

47. Plaintiff hereby incorporates by reference paragraphs 1 through 24 of this Complaint as if fully set forth herein.

48. Defendant has engaged, and continues to engage, in unlawful and deceptive business acts or practices, and unfair competition, in violation of N.Y. General Business Law § 349, and the common law.

49. Plaintiff will be irreparably harmed as a result of such violations, for which there is no adequate remedy at law. Plaintiff is entitled to injunctive relief against defendant's continued use of its design in connection with cigars.

50. Plaintiff is entitled to defendant's profits from the sale of cigars bearing defendant's infringing design, or marketed, advertised and promoted through use of that



infringing design, and is entitled to the costs of this action, including its reasonable attorneys' fees.

**SIXTH CLAIM FOR RELIEF**  
**Common Law Misappropriation**

51. Plaintiff hereby incorporates by reference paragraphs 1 through 24 of this Complaint as if fully set forth herein.

52. Plaintiff has devoted considerable effort and sums of money in establishing the goodwill of the Cuban COHIBA cigar, and of Cubatabaco's Design Marks for the COHIBA cigar, including goodwill in the United States.

53. Defendant has willfully and in bad faith misappropriated plaintiff's fruits and labors by using its infringing design in connection with cigars, entitling plaintiff to relief under the common law of the State of New York and each state in which defendants have engaged in the offending conduct, including injunctive relief against defendant's continued use of its design in connection with cigars, defendant's profits from the sale of cigars bearing defendant's design, or marketed, advertised and promoted through use of that design, and the costs of this action, including its reasonable attorneys' fees.

**SEVENTH CLAIM FOR RELIEF**  
**Common Law Passing Off, Palming Off**

54. Plaintiff hereby incorporates by reference paragraphs 1 through 24 of this Complaint as if fully set forth herein.

55. Defendant has passed off and/or palmed off, and attempted to pass off and/or palm off, its HABANO-labeled cigar products as those of Cubatabaco, entitling plaintiff to relief under the common law of the State of New York and each state in which defendants have

engaged in the offending conduct, including for injunctive relief against defendant's continued use of its design in connection with cigars, and for defendant's profits from the sale of cigars bearing defendant's infringing design, or marketed, advertised and promoted through use of that infringing design, and is entitled to the costs of this action, including its reasonable attorneys' fees.

**EIGHTH CLAIM FOR RELIEF**  
**28 U.S.C. §§ 2201, 2202**  
**(Declaratory Judgment )**

56. Plaintiff hereby incorporates by reference paragraphs 1 through 55 of this Complaint as if fully set forth herein.

57. Pursuant to 28 U.S.C. §§ 2201 and 2202, plaintiff is entitled to a declaration that defendant has no right to use its complained of design in connection with cigars, and that it has infringed upon, and otherwise unlawfully violated and misappropriated, plaintiff's rights and interests, by such use.

**WHEREFORE**, plaintiff Cubatabaco respectfully prays for judgment as follows:

1. For a declaration that defendant has no right to use its complained of design in connection with cigars, and that it has infringed upon, and otherwise unlawfully violated and misappropriated, plaintiff's rights and interests, by such use;

2. For a preliminary and permanent injunction, restraining and enjoining defendant, its officers, agents, servants, employees, and attorneys, and those in active concert or participation with them who receive actual notice of the Order from using its complained of design in connection with cigars, or any other design, trademark, or trade dress which colorably imitates or is confusingly similar to plaintiff's registered Design Marks;

3. That defendants be ordered to recall any and all of their products bearing the complained of design;

4. That defendant be ordered to destroy, within thirty (30) days of entry of any injunction herein, any and all merchandise, packaging, package inserts, labels, signs, prints, wrappers, receptacles, advertising, plates and other mechanical means of reproduction or other materials in their possession, custody or control, now or hereafter, which bear the complained of design, or any reproduction, copy or colorable imitation thereof; and

5. That defendant be required to account for and to remit to Cubatabaco all profits from the sale of cigars bearing its complained of design, or marketed, advertised and promoted through use of that design;


6. That plaintiff be awarded its reasonable attorneys' fees and costs incurred in this action.

7. For such other and further relief as the Court may deem proper.

Dated: New York, New York  
May 26, 2005

Respectfully submitted,

By:

  
David B. Goldstein (DG 8291)  
Michael Krinsky (MK 4503)  
Thomas C. Viles (TV 5283)  
RABINOWITZ, BOUDIN, STANDARD,  
KRINSKY & LIEBERMAN, P.C.  
740 Broadway, 5<sup>th</sup> Floor  
New York, New York 10003  
(212) 254-1111

*Attorneys for Plaintiff  
Empresa Cubana del Tabaco  
d/b/a Cubatabaco*



EXHIBIT A

**Int. Cl.: 34**

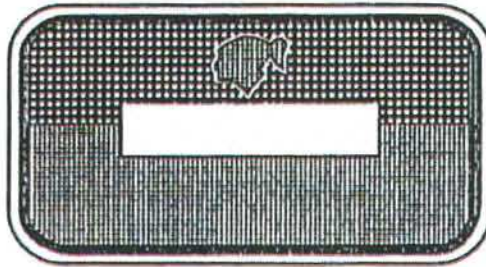
**Prior U.S. Cls.: 2, 8, 9 and 17**

**Reg. No. 2,145,804**

**United States Patent and Trademark Office**

**Registered Mar. 24, 1998**

**TRADEMARK  
PRINCIPAL REGISTER**



EMPRESA CUBANA DEL TABACO (CUBA  
CORPORATION), DBA CUBATABACO  
O'REILLY NO. 104  
CIUDAD LA HABANA, CUBA

FOR: RAW TOBACCO, CIGARS, CIGARETTES, CUT TOBACCO, RAPPEE, MATCHES, TOBACCO, TOBACCO PIPES, PIPE-HOLDERS, ASHTRAYS NOT OF PRECIOUS METAL, MATCH BOXES, CIGAR CASES NOT OF PRECIOUS METAL, AND HUMIDORS, IN CLASS 34 (U.S. CLS. 2, 8, 9 AND 17).

OWNER OF CUBA REG. NO. 123125, DATED 2-6-1996, EXPIRES 1-10-2003.

THE MARK IS LINED FOR THE COLOR GOLD. THE BOLDLY LINED SECTION OF

THE DRAWING, HOWEVER, DOES NOT INDICATE COLOR, BUT IS A FEATURE OF THE MARK.

THE MARK CONSISTS OF A RECTANGULAR DESIGN WITH ROUNDED CORNERS, A GOLD OUTLINE, THE SILHOUETTE OF A HEAD OF AN INDIAN AGAINST A BLACK AND WHITE DOTTED BACKGROUND, A WHITE RECTANGLE, AND A GOLD RECTANGLE.

SER. NO. 75-151,226, FILED 8-16-1996.

DAVID C. REIHNER, EXAMINING ATTORNEY

**EXHIBIT B**



Int. Cl.: 34

Prior U.S. Cls.: 8, 9 and 17

**United States Patent and Trademark Office**

**Reg. No. 1,557,163**

**Registered Sep. 19, 1989**

**TRADEMARK  
PRINCIPAL REGISTER**



EMPRESA CUBANA DEL TABACO (CUBA  
CORPORATION)  
O'REILLY 104 STREET  
HAVANA CITY, CUBA

FOR: RAW TOBACCO; CIGARS, CIGARETTES, CUT TOBACCO, RAPPEE, MANUFACTURED TOBACCO OF ALL KINDS, MATCHES, TOBACCO-PIPES, PIPE HOLDERS, ASHTRAYS, MATCH BOXES, CIGAR CASES, HUMIDORS, IN CLASS 34 (U.S. CLS. 8, 9 AND 17).

OWNER OF CUBA REG. NO. 36987, DATED 12-24-1987, EXPIRES 12-24-1997.

OWNER OF U.S. REG. NO. 1,441,404.

THE DRAWING OF THE MARK IS LINED FOR THE COLORS YELLOW AND GOLD.

THE ENGLISH TRANSLATION OF THE WORD "BEHIKE" IN THE MARK IS "INDO-CUBAN WITCH DOCTOR".

SER. NO. 742,915, FILED 7-29-1988.

ALICE SUE CARRUTHERS, EXAMINING ATTORNEY



# STRIKE UP THE

Creating cigar bands has become not only an outlet for artistry, but also a vital component in the process of establishing new brands and revitalizing old ones. **BY MARK BERNARDO**

**T**he origin of the cigar band as we know it today can be traced back to 1854 and an enterprising cigar maker named Gustave Antoine Bock. As the legend goes, upon one day inspecting a box of cigars from his factory, Bock was beside himself when he discovered that someone had replaced a cigar within with one of inferior quality. Then and there, he decided that identifying each cigar with a personalized band was the only way to ensure brand identification and hence, commercial success. The idea was quickly adopted throughout Cuba's cigar factories, and by 1884 was considered an essential component of the cigar making business.

The period between the 1890s and World War I was widely considered to be the Golden Age of cigar band production, with advances in printing, color, and lithography turned to the task of creating ornate, artistic masterpieces suited to the popular vanity that cigar smoking had become. Bands featured portraits of kings, presidents,

popes, and other personages of grandeur, as well as animals, plants, coats of arms, and nationalist symbols like the American bald eagle and British lion. Fast-forward about 100 years, and many collectors of this unique art form will notice a change — and the beginning of a new era of cigar band design.

One of those collectors, it turns out, is also one of the pioneers of this new age. "There was something about the old labels and packaging that really fascinated me," recalls Carlos Fuente, Jr., describing the thought processes that led him to commission the now-famous band for his now-legendary Fuente Fuente Opus X cigar. "I was very frustrated that that look had been lost; by the 1970s it seemed impossible to print bands with gold bronze and those great designs. Everything was simple. I wanted to recapture the past." The Opus X band is indeed a nod to the gilded, festive bands of yesteryear, with its blazing red "X," gold adornments, die-cut shapes, and sheer width that makes an Opus

## 20 GREAT CIGAR BANDS



### Fuente Fuente Opus X

One of cigardom's favorite bands on one of its favorite sticks. The "X" comes from Carlos Fuente's secretive name for his much-doubted experiment with Dominican-grown wrapper: Project X.

1



### Avo

A-U for Avo Uvezian — not, as many believe, A-V-O. A classy, lyrical design befitting the master musician behind the cigar.

2



### Cohiba

Big blocky logo on simple, black-white-yellow, straight-sided band. A groundbreaking visual, iconic mainly because of the mystique of the cigar inside it.

3

### La Gloria Cubana

Ernesto Perez-Carillo inherited from his father the illustrative Cuban artwork that adorned the band of the original Cuban LGC. The elegant woman smoking on the band is a nod to yesteryear.



4



### Padron Anniversary

Emphasizing warm brown and gold, classic tobacco colors, this band is notable for pioneering the concept of the numbered band to combat counterfeiting.

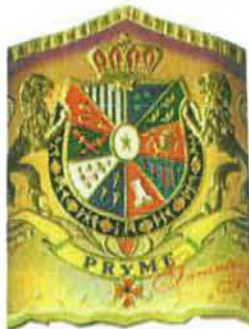
5



# BANDS

X smoker visible across the room. It also became, as Fuente puts it, "the godfather of all these new bands" — that is to say, the inspiration for the burst of creativity that hit the industry almost simultaneously with the 1990s cigar boom and continues today. And while the idea behind the band could be considered retro, even historical, the technical expertise it displays also marks it as decidedly a product of the modern era. "These bands took almost two years," Fuente proudly reports. "People in the 1800s did not spend that amount of time to make a band. It was designed based on the past, but it's so different people think it's modern."

Extremely retro, ultra-modern, and retro-mixed-with-modern are the three major categories in which most of today's best cigar bands fall. And for every cigar maker, like Fuente, whose mission is to celebrate the past and tradition, there is also one who views breaking the long-established rules and flouting conventions as his main inspiration. "Blue is not a color that is traditionally associated with cigar bands," reveals Brian Ganton, Jr. of Brian J. Ganton &



**HIGH STYLE:**  
Pryme by Alec Bradley,  
taking traditional design  
cues with a modern edge.

Associates, the design firm responsible for the look of one of the most successful cigar launches in recent years, Helix. Ganton refers to the long-standing, unwritten law (confirmed in a separate interview with Helix's new corporate parents, General Cigar, Inc.) that blue bands simply could not look good on cigar wrappers. But the Helix brand was itself such a gamble — a defiantly mild cigar trying to crack into a market filled with full-bodied powerhouses, and going up against mighty Macanudo, the mild category's unquestioned leader — that Ganton figured, why not roll the dice? "It was a risky strategy," he admits, "but we knew the type of person

we were speaking to with this brand. The metallic quality, the fade, the thrusting character of that 'H' monogram — it had a modern, almost 'virtual' look — like those cool colors that Apple uses in their [iMac] computers." Helix has since pushed the color envelope even further, using a bright purple version of the band for their maduro line.

In the case of Helix, the cigar's name determined the direction of the design. Sometimes, albeit rarely, it works the

**"By the 1970s it seemed impossible to print bands with gold, bronze and those great [old] designs. Everything was simple. I wanted to recapture the past."**

— Carlos Fuente, Jr.,  
on creating the Fuente  
Fuente OpusX band



**Davidoff**  
Elegant gold script on ivory white identifies a brand whose stock-in-trade is luxury and elegance.



**CAO Brazilia**  
Bright green, yellow, and blue, like the Brazilian flag. The wide band assures that a Brazilia smoker can be pointed out across a crowded room.



**La Aurora Cien Años**  
The lion symbolizes the Leon family, creators of the La Aurora brand, which celebrates 100 years with this extremely rare all-Dominican cigar.



**Perdomo Edición de Silvio**  
Golden tobacco leaves arranged like a medallion; a trophy-like emblem for an award-winning limited edition cigar.



**Bahia**  
The orange-fading-to-white band color was inspired by a sunset over Havana. Critics told creator Tony Borhani this big, simple band would never sell; instead, it became a modern trendsetter.

6

7

8

9

10



## EDITORS' PICKS FOR 2005

cigar **aficionado**  
THE GOOD LIFE MAGAZINE FOR MEN [www.cigaraficionado.com](http://www.cigaraficionado.com)

# BEST CIGARS OF THE YEAR

Our 25 favorite smokes rated  
and reviewed—from bargain  
finds to the best of the best

### PLUS

THE NBA'S **BIG TROUBLES**

**CRAIG STADLER**

TODAY'S BEST GOLFER OVER 50

**HDTV** COMES OF AGE

HOW TO

**BEAT THE ODDS**

ROLLING DICE

